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THE LAW
OF
TRADEMARKS, TRADENAMES
AND
UNFAIR COMPETITION

INCLUDING

TRADE SECRETS; GOODWILL; THE FEDERAL TRADE-
MARK ACTS OF 1870, 1881 AND 1905; THE TRADE-
MARK REGISTRATION ACTS OF THE STATES
AND TERRITORIES; AND THE CANADIAN
TRADEMARK AND DESIGN ACT; WITH
FORMS.

BY

JAMES LOVE HOPKINS

SECOND EDITION

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1905

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AUTHOR'S NOTE.

Froude, in his essay on the Science of History, said, "Opinions alter, manners change, creeds rise and fall, but the moral law is written on the tablets of eternity."

In the law of trademarks is contained the first recognition by the courts of the principle that no man should be permitted to pass off his goods as those of another. Does the fact that this department of our law is of so recent origin import that, in the past, English speaking traders were more honest in their dealings? The answer to that question must be looked for in the pages of history. Even if Napoleon was correct in his assertion that history was "but a fiction agreed upon," it contains the only evidence available for our purpose. Furthermore, Buckle's theory that history, though conflicting as to the character and achievements of individuals, is still harmonious as to the manners of a given period, leads us to believe that the authors to whom we purpose to briefly refer may, for the purpose of our inquiry, be deemed authoritative.

Writing of the conditions existing in England during the Anglo-Saxon period, Hume says "Whatever we may imagine concerning the usual truth and sincerity of men who live in a rude and barbarous state, there is much more falsehood, and even perjury among them, than among civilized nations; virtue, which is nothing but a more enlarged and more cultivated reason, never flourishes to any degree, nor is founded on steady principles of honour, except where a good education becomes general; and where men are taught the pernicious consequences of vice, treachery, and immorality. Even super-

stition, though more prevalent among ignorant nations, is but a poor supply for the defects in knowledge and education; our European ancestors, who employed every moment the expedient of swearing on extraordinary crosses, and relics, were less honourable in all engagements than their posterity, who, from experience, have omitted those ineffectual securities. This general proneness to perjury was much increased by the usual want of discernment in judges, who could not discuss an intricate evidence, and were obliged to number, not weigh, the testimony of the witnesses."

Daniel De Foe (whom Taine describes as "one of those indefatigable labourers and obstinate combatants, who, ill-treated, caluminated, imprisoned, succeeded by their uprightness, common sense, and energy in gaining England over to their side") published in 1725 and 1727 his book, "The Complete English Tradesman," in which he treats of the ethics of English trade. In that work he refers to the "shop rhetoric" and "flux of falsehoods" used by tradesmen in disposing of their wares, and the common practice of keeping on hand a bag of spurious or debased coin from which to make change. Charles Lamb said this work was "of a vile and debasing tendency." The French critic is probably the better judge of De Foe.

In 1859 Herbert Spencer in his essay on "The Morals of Trade," treats of the ethics of the same tradesmen more than a century later. He refers to "the often-told tale of adulterations," and says "It is not true, as many suppose, that only the lower classes of the commercial world are guilty of fraudulent dealing. Those above them are a great extent blameworthy. On the average, men who deal in bales and tons differ but little in morality from men who deal in yards and pounds. Illicit practices of every form and shade, from venial deception up to all but direct theft, may be brought home to the higher

grades of our commercial world. Tricks innumerable, lies acted or uttered, elaborately-devised frauds, are prevalent; many of them established as 'customs of the trade'; nay, not only established, but defended. * * *

We cannot here enlarge on the not uncommon trick of using false trademarks, or of imitating another maker's wrappers. * * *

Omitting the highest mercantile classes, a few of the less common trades, and those exceptional cases where an entire command of the market has been obtained, the uniform testimony of competent judges is, that success is incompatible with strict integrity. To live in the commercial world it appears necessary to adopt its ethical code; neither exceeding nor falling short of it—neither being less honest nor more honest. Those who sink below its standard are expelled; while those who rise above it are either pulled down to it or ruined. As, in self-defense, the civilized man becomes savage among savages; so it seems that in self-defense, the scrupulous trader is obliged to become as little scrupulous as his competitors. It has been said that the law of the animal creation is—'Eat and be eaten'; and of our trading community it may similarly be said that its law is—cheat and be cheated. A system of keen competition, carried on, as it is, without adequate moral restraint, is very much a system of commercial cannibalism. Its alternatives are--Use the same weapons as your antagonists or be conquered and devoured."

If the statements of those three writers are to be accepted as evidence, and they would seem to be the best evidence, as to the ethics of trade in England at the several periods referred to, it would appear that the present condition of trade as to fairness in competition is far more wholesome. That bettered condition must be attributed largely to the judicial evolution of the principles treated in this book.

In this conclusion, the author is supported by Sir Fred-

erick Pollock. In his First Book of Jurisprudence he says, "Rules of law may well have, in particular circumstances, an effective influence in maintaining, reinforcing, and even elevating the standard of current morality. The moral ideal present to lawgivers and judges, if it does not always come up to the highest that has been conceived, will at least be, generally speaking, above the common average of practice; it will represent the standard of the best sort of citizens. This is especially the case in matters of good faith, whether we look to commercial honesty or to relations of personal confidence. With few exceptions, the law has, in such matters, been constantly ahead not only of the practice but of the ordinary professions of business men."

Ethical evolution and organic evolution alike are accomplished slowly, and the possibilities of each are alike limitless. From the days when the Anglo-Saxon judges numbered the witnesses because of inability to weigh their testimony, to the era when the requirement of fairness in trade was established, the English-speaking people have made immeasurable ethical progress. To that progress, the science of law has made many contributions, and has been indispensable.

We are dealing in the subjects comprised in this book with the highest ethical development of that which we term the common law. The standard set for the regulation of competition by the modern decisions evidences the high degree of ethical development of the modern judiciary. It is not to be expected that all of the decisions should reach the same altitude as the foremost. To say this, is merely to say that the judges who wrote the opinions were not of equal ability and learning. It is impossible that they should be. But on the whole, the body of cases with which we here deal, forms the most convincing proof which we have of the steady improvement of the morals of trade, and the gradual extinction

of that "commercial cannibalism" of which Spencer wrote less than fifty years ago. It is doubtful whether jurisprudence has, during any corresponding period in the world's history, been of greater value to the advancement of civilization than it has in dealing with the subjects here considered, during the past half century.

It is a remarkable fact that in this department of the law which has, less than any other, been hampered by statutes and precedents, and which, more than any other, rests upon a foundation purely ethical, there should be found so great harmony between so many independent jurisdictions, English and American. Such legislation as has been effected in the United States has been desultory and comparatively ineffective. Its most admirable quality is its non-interference with common-law trademark rights.

In submitting this more comprehensive work to the profession, it is a subject of gratification to the author that his former book entitled "The Law of Unfair Trade" has been so generally accepted, and used as a working tool. The present work, it is hoped, will be found more adequate. The late cases have been exhaustively dealt with. The addition of the statutes and forms for registration employed in the several states and territories, and the Dominion of Canada, is intended to facilitate the business of the practitioner, in registration and litigation outside of the state in which he resides. The forms of pleading have been added to from the best sources. The recently enacted federal trademark act, together with the rules and forms prescribed by the Commissioner of Patents for the registration of trademarks and patent office practice under the act, is reproduced in the appendix, while the acts of 1870 and 1881 have been preserved, with their annotations.

JAMES LOVE HOPKINS.

St. Louis, October 1st, 1905.



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HOPKINS ON TRADEMARKS

CHAPTER I.

PREFATORY.

§ 1. **The need of legal restraint of unfair trade.**—It is not the spirit of our laws to interfere with fair competition. It is for the best interests of society that prices should be adjusted by the economical laws of supply and demand. With limitations that have been imposed by varying local conditions, tempered by the caprices of legislation and the idiosyncrasies of judges, our common and statutory law alike condemn contracts in restraint of trade, and monopolies, complete or partial. But, on the other hand, there are recognized property rights which are of necessity monopolistic in their character. The most notable are those created by the patent and copyright laws, which grant, for a limited time, a monopoly in the production of the brain of the author or inventor. The value of these laws in the advancement of science, manufacture and art is universally recognized. Closely allied to these rights is the right of those engaged in commerce to be subjected to none but fair competition.

Unfair competition consists in passing off one's goods as the goods of another, or in otherwise securing patronage that should go to another, by false representations that lead the patron to believe that he is patronizing the other person. It is of vital importance to healthy business conditions that such competition should be suppressed. It is equally important however, that fair competition shall not be interfered with. Whether the com-

petitive acts complained of are fair or unfair is the vital point in each litigated case.

It is apparent that the simplest means of depriving another of the trade he has built up is to copy the marks he places on his merchandise. This is the easiest method of stealing his trade, and most universal because of the general use of marks or brands upon personal property. The use of such marks runs far back into the shadows of history, and to the period when a knowledge of written language was unusual among tradesmen. It is only natural that these marks used in trade, or trademarks, should have first become the subjects of judicial consideration, and that the law concerning them should have reached a state of comparatively complete development before infringers began to employ other and more obscure means to divert trade.

It is true, as well, that the development of the law of the technical trademark tended to encourage the buccaneers of commerce to invent new and subtler means of stealing another's trade without trespassing upon his trademark rights. But the law, steadily though slowly, extended its bulwark of protection about the legitimate trader, until at length he was afforded legal redress in some form, not always adequate or complete, against the fraudulent diversion of his trade, in whatever form it might appear.

In the light of these facts it is self evident that the law of the technical trademark must first be mastered before the student can with understanding study the gradual evolution, from this protoplasm, of the larger law regulating all unfair competition in trade.

From the early days of commerce, probably from its beginning, the keen rivalry of competing merchants has led to the use of unfair and dishonest methods of diverting custom. With the growth of commerce has come a corresponding increase of fraudulent competition and its attendant evils. The English-speaking people were slow

to realize that some legal restraint should be imposed upon the dealer who seeks to secure patronage by dressing his goods in a manner calculated to deceive the public into a belief that they are the goods of another. There are a few unimportant unfair trade cases in the English reports of the eighteenth century; the first reported American decision was rendered in 1825.¹ The law as it is administered by the courts of the United States to-day is almost wholly the product of the last half-century.

The purpose of this treatise is to discuss the law of unfair trade in its broadest sense, including not only the law of trademarks, but also the principles applicable to the restraint of fraudulent competition in cases where no trademark is involved. "The law of trademarks is but part of the law of unfair competition in trade."²

§ 2. Trademark defined.³—A trademark is a distine-

1—Snowden v. Noah, Hopkins' Ch. 347.

2—Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651, 659.

3—*Judicial definitions.* — "A trademark may consist of a name, symbol, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity." Mr. Justice Clifford in McLean v. Fleming, 96 U. S. 245, 254, and in Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51, 60.

"A trademark, properly so called, may be described as a particular mark or symbol, used by a person for the purpose of denoting

that the article to which it is affixed is sold or manufactured by him or by his authority, or that he carries on business at a particular place." Lord Cranworth in Leather Cloth Co. v. American Leather Cloth Co., 35 L. J. Ch. 61.

"A trademark is a mere notice, an arbitrary mark or sign put on an artificial product, whereby any person interested in the information may be assured as to the origin of said product." Showalter, J., in Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376, 380.

"A trademark is a peculiar name or device, by which a person dealing in an article designates it as of a peculiar kind, character or quality, or as manufactured by or for him, or dealt in by him, and of which he is entitled to the exclusive use." Devens, J., in Weener v. Brayton, 152 Mass. 101, 102.

"It is a mode of designating

goods as being the goods which have been, in some way or other, dealt with by A. B., the person who owns the trademark." Kay, J., in *Re The Australian Wine Importers, (Ltd.)*, L. R. 41 Ch. D. 278, 281.

"Symbols or devices used by a manufacturer or merchant to distinguish the products, manufactures, or merchandise which he produces, manufactures or sells, from that of others, are called and known by the name of trademarks. They are used in order that such products, manufactures or merchandise may be known as belonging to the owner of the symbol or device, and that he may secure the profits from its reputation or superiority." Mr. Justice Clifford in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 56.

"Any name, symbol, letter, figure or device adopted by the persons manufacturing or selling goods, and used and put upon such goods to distinguish them from those manufactured or sold by others, and employed so often and for such a length of time, as to raise the presumption that the public would know that it was used to indicate ownership of the goods in the person manufacturing or selling them, constitutes his trademark." Rhodes, J., in *Derringer v. Plate*, 29 Cal. 292; Cox, 324.

"A trademark is a symbol arbitrarily selected by a manufacturer or dealer, and attached to his wares to indicate that they are his wares." Douglas, J., in *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763, 765.

"It is a sign or mark by which the manufactured articles pro-

duced by one person, or firm, or maker are distinguishable from those produced by rival manufacturers." Williams, J., in *Hoyt v. Hoyt*, 143 Pa. St. 623; 24 Am. St. Rep. 575.

"A trademark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his productions from other productions of the same article." Gilfillan, C. J., in *Cigar-makers' Protective Union v. Conhaim*, 40 Minn. 243; 12 Am. St. Rep. 726.

"A trademark is a name, sign, symbol, mark, brand, or device of any kind, used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods." Beck, J., in *Shaver v. Shaver*, 54 Iowa, 208; Price & Steuart, 395.

"A trademark may consist of anything, marks, forms, symbols, which designate the true origin or ownership of the article." Monell, J., in *Godillot v. Hazard*, 44 N. Y. Sup. Ct. 427.

"A trademark is . . . the name, symbol, figure, letter, form, or device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry or enterprise." Crawford, J., in *Larrabee v. Lewis*, 67 Ga. 562.

"A trademark is an arbitrary character or characters without special meaning, adopted by persons, firms or corporations for the purpose of identifying the goods

manufactured by them or of which they have the sale." Marble, Commissioner, in *Ex parte Frieberg & Workum*, 20 Off. Gaz. 1164.

"Broadly defined, a trademark is a mark by which the wares of the owner are known in trade. Its object is two-fold: First, to protect the party using it from competition with inferior articles; and second, to protect the public from imposition. . . . Anything which can serve to distinguish one man's productions from those of another may be used. The trademark brands the goods as genuine, just as the signature to a letter stamps it as authentic." Coxe, J., in *Shaw Stocking Co. v. Mack*, 12 Fed. Rep. 707, 710.

"A trademark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade. Courts of equity have two objects in view in granting injunctions against their imitation: 1. To secure to the individual adopting one the profits of his skill, industry, and enterprise; 2. To protect the public against fraud." Nixon, J., in *Humphreys' Specific Med. Co. v. Wenz*, 14 Fed. Rep. 250, 252.

"A trademark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these, which will serve the sole purpose of a trademark, and which no other person can adopt or use with equal truth." Hargis, J., in *Avery v. Meikle*, 81 Ky. 73.

"A trademark consists of a

word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article." Wallace, J., in *Hostetter v. Fries*, 17 Fed. Rep. 620, 622.

"A trademark, as defined by Bouvier, is a sign, writing or ticket put on manufactured goods, to distinguish them from others. It has, by a commentator on trademarks, been more fully explained as a name, symbol, figure, letter, form, or device, adopted and used by a manufacturer or merchant to designate the goods he manufactures or sells to distinguish them from the goods of another." Allison, P. J., in *Ferguson v. Davol Mills*, 2 Brewst. 314.

"A trademark is some arbitrary or representative device attached to or sold with merchandise and serving to designate the origin or manufacture of that merchandise." Carpenter, J., in *Davis v. Davis*, 27 Fed. Rep. 490, 491.

"What is a trademark? A 'mark' means to make a visible sign upon something; to affix a significant mark to; to draw, cut, fasten, brand; a token upon, indicating or intimating something; to affix an indication to; to attach one's name or initials to. A trade-mark, therefore, consists of the use in trade of such a mark, placed upon goods manufactured by a particular person and placed in market with such marks, for sale and trade." Welker, J., in *Adams v. Heisel*, 31 Fed. Rep. 279, 280.

"A trademark is properly defined by Upton (*Upton's Trademarks*, 9) as 'the name, symbol, figure, letter, form or device adopted and used by a manufac-

turer or merchant, in order to designate the goods that he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise.' The trademark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, symbol, word or words, which others have not an equal right to employ for the same purpose." Earl, Commissioner of Appeals, in *Newman v. Alvord*, 51 N. Y. 189, 193.

"Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trademark, and the courts will protect him in its exclusive use." Mr. Justice Field in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 53.

"*Trademark*. — An arbitrary symbol affixed by a manufacturer

or merchant to a vendible commodity. The principal purpose of a trademark is to guarantee the genuineness of a product. It is, in fact, the commercial substitute for one's autograph. In all ages it has been used to denote origin, and thus protect the purchaser as well as the vendor. All countries protect the integrity of trade-marks, and nearly all civilized nations have treaties or conventions securing reciprocity of protection. The tests of a trademark are: 1. Universality; that is, commonly recognized as such. 2. Exclusiveness; in the possession of the owner. 3. Individuality; must indicate origin and ownership. 4. Must be for merchandise. 5. Must be in a lawful business. 6. Must be distinct and invariable." Knight's Mechanical Dictionary, title "Trademark," p. 2609.

"Our word 'trademark' comprehends both the *marque de fabrique* and *marque de commerce* of France." Townsend, J., in *La Republique Francaise v. Schultz*, 57 Fed. Rep. 37, 41.

"A distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others." Mr. Chief Justice Fuller in *Elgin Nat. Watch Co. v. Illinois Watch Case Co.* (2), 179 U. S. 665, 673.

"A trademark—is a name or a mark or a device which it attached to the article to point out its origin." Shipman, J., in *Adee v. Peck Bros. & Co.*, 39 Fed. Rep. 209, 210.

"A trademark is a word, a symbol or device by which the wares of the owner are known in trade."

tive⁴ name, word, mark, emblem, design, symbol or device, used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed, the chattel upon or to which it is applied or affixed.⁵

§ 3. **Tradename defined.**—The word “tradename” as used in the decisions has two different meanings. Stand-

Coxe, J., in *Kipling v. G. P. Putnam's Sons*, 120 Fed. Rep. 631, 57 C. C. A. 295.

“A trademark is an arbitrary, distinctive name, symbol, or device, to indicate or authenticate the origin of the product to which it is attached.” Deemer, C. J., in *Sartor v. Schaden*, Iowa, 101 N. W. Rep. 511.

“A trademark is a notice, a medium of information touching origin or ownership.” Showalter, J., in *Beadleston & Woerz v. Cooke Brewing Co.*, 20 C. C. A. 405, 74 Fed. Rep. 229, 234.

“A trademark is a means of authenticating or indicating the origin of an article.” Billings, J., in *Johnson v. Schenck*, Fed. Case No. 7,412.

4—By the word “distinctive,” as used in our definition, is meant that the mark must be something which “shall be capable of distinguishing the particular goods in relation to which it is to be used from other goods of a like character belonging to other people.” Lord Chief Justice Russell, in *Rowland v. Mitchell*, L. R. (1897) 1 Ch. D. 71, 74. *Wood v. Lambert*, L. R. 32 Ch. D. 247; 54 L. T. N. S. 314; 3 P. R. 81; (Court of Appeals) L. R. 32 Ch. D. 257; 55 L. J. Ch. 277; 54 L. T. N. S. 317; 3 P. R. 88; *Re Perry Davis & Son*, 58 L. T. N. S. 695; 5 P. R. 333, and

many similar English cases treat of the word “distinctive” as used in the English Patents, Designs and Trademarks Act of 1883, section 64, sub-section 1, c. But the word is used with the same significance by our own leading jurists, as for example, by Mr. Chief Justice Fuller, in *Elgin National Watch Co. v. Illinois Watch Case Co.* (2), 179 U. S. 665, 673; by Justice Holmes, in *North-Eastern Awl Co. v. Marlborough Awl Co.*, 168 Mass. 147; 60 Am. St. Rep. 373; and by Judge Lacombe in *National Biscuit Co. v. Baker*, 95 Fed. Rep. 136. For this reason the word is incorporated in the definition given in the text.

5—The mode in which the mark is applied or affixed is immaterial. It may be water-marked in translucent fabrics. *Price v. Goodall*, L. R. (1891) 1 Ch. D. 35. It has been held to be a sufficient method of affixing the mark, to use it in advertising, and to place a lithographed fac-simile of it on a card, in a box containing a quantity of the goods. *Hay & Todd Mfg. Co. v. Querns Brothers*, 86 Off. Gaz. 1323. It has been held that to display the mark on a show-card placed on lots of candy in a show window, is not sufficient to establish a trademark right therein. *Oakes v. St. Louis Candy Co.*, 146 Mo. 391, 48 S. W. Rep. 467.

ing alone, and separate from the word "trademark" it includes all business names; while in the expression "trademarks and tradenames" it means all business names which are not technical trademarks.⁶

Mr. Browne, in his valuable treatise on trademarks (sec. 91) uses the following language; "the distinction will be readily comprehended, when it is remembered that a trademark owes its existence to the fact that it is actually affixed to a vendible commodity. A tradename is more properly allied to the goodwill of a business." This distinction is of itself decidedly misleading. Many tradenames are "actually affixed to a vendible commodity," and as both trademarks and other tradenames are a constituent part of the goodwill of the business in which they are used, it is not possible for one class of names to be more properly allied to the goodwill than the other, nor is it proper to say of either that it is "allied" to something of which it is a component part.

A name is frequently referred to as a "trademark" and as a "tradename" in the same opinion.⁸ Some of our ablest judges treat the words "tradename" and "trademark" as synonymous.⁹

Some of the cases dealing with tradenames are fairly bewildering to one who endeavors to reconcile them or deduce a general definition of "tradename" from them. In a Massachusetts case, for example, the court found that the defendant had acquired the right to the use of the name "John G. Loring & Co." as a "trademark" on goods, but had no right to use it as a tradename.¹⁰

6—N. K. Fairbank Co. v. Luckel, Mass., 85, 53 N. E. Rep. 141.

King & Cake Soap Co., 102 Fed. Rep. 327, 331, 42 C. C. A. 376, 92 Off. Gaz. 1437.

8—Opinion of Seaman, J., in Postum Cereal Co. v. American Health Food Co., 109 Fed. Rep. 898.

7—As "Minnesota Patent," in Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608, 30 C. C. A. 386; and "Waltham," in American Waltham Watch Co. v. United States Watch Co., 173

9—Thomas G. Plant Co. v. May Co., 44 C. C. A. 534, 105 Fed. Rep. 375.

10—Bowman v. Floyd, 85 Mass. 76.

As a proper name cannot be a trademark, under principles discussed elsewhere in this book, while the meaning of the word as used by the court is clear, the opinion lends no assistance to the distinction between "trademark" and "tradenname."

Historically, this confusion probably arose in the English decisions. In one of the leading cases we find that Lord Chancellor Westbury said "a name or the style of a firm may by long usage become a mere trademark,"¹¹ and in the same case, in the House of Lords, Lord Cranworth referred to the difficulties which "may arise where the trademark consists merely of the name of the manufacturer."¹²

Lord Romilly said in another case "the name or style of the firm of 'Banks & Co.' was an asset of the partnership, and if the whole concern and the good will of a business have been sold, the name, as a trademark, would have been sold with it."¹³

With this loose use of the word trademark by such eminent judges some forty years since, it is not remarkable that the bench and the profession have not yet drawn the line separating trademarks from tradenames with any degree of lucidity. The question of mere definition is nearly always a matter of secondary importance in the progress of any science. The want of an accurate distinction between trademarks and tradenames has not hampered the growth of this branch of the law; if it had, the distinction would long since have been drawn by the courts. The principles involved in trademark cases and tradename cases have been substantially identical. But with their development it has been necessary to sharply define the technical trademark, and if it were possible to draft as accurate a definition of tradename the result

11—Leather Cloth Co. v. American Leather Cloth Co., 11 H. L. C. 523, 533.

144.

13—Banks v. Gibson, 34 Beav.

12—Leather Cloth Co. v. Ameri- 566.

would be to measure the metes and bounds of the field of cases in which relief will be granted against the fraudulent use of a word or phrase used as the distinguishing identification mark of a commercial enterprise or article of trade.

It is clear that words of common right ought not to be called tradenames. Thus, the word "cracker" imprinted on a soda cracker indicates merely that it is a soda-cracker. As the article itself conveys that knowledge, the word is superfluous. Mark the cracker "Uneeda," and an entirely different result follows. The word is a trademark.¹⁴ The word, so affixed, meets the requirements of all the definitions given herein. It is a distinguishing indication of origin and ownership. But take an example of another kind of word applied to a common staple article of merchandise. "Flour" stamped on a sack of flour is meaningless. "Patent Flour" means something more. "Minnesota Patent Flour" means patent flour made in Minnesota. Clearly the word "flour" alone, and the words "Patent Flour" together, cannot be called tradenames, though they are names used in trade. They are of common right. They can be truthfully applied to flour regardless of the place where, or the person by whom, it is produced. "Minnesota Patent Flour" is not a trademark. It is of common right to all persons producing patent flour in Minnesota. But it is a tradename, because it will be a medium of fraud if persons producing flour elsewhere than in Minnesota are permitted to apply it to their flour.¹⁵

To use another example of a very common class. Any one can make soap and mark it "Soap." Any soap manufacturer can call his soap "Best Soap." A particular manufacturer adds his name to this mark and produces "Babbitt's Best Soap." He has not made a trade-

14—National Biscuit Co. v. Mills Co. v. Eagle, 30 C. C. A. 386, Baker, 95 Fed. Rep. 135. 86 Fed. Rep. 608.

15—Pillsbury - Washburn Flour

mark but he has made a tradename.¹⁶ Another person named Babbitt entering the market subsequently must clearly distinguish his soap from that of the other Babbitt.

An example of a descriptive of the composition of the article itself is "Cellular Cloth," a cloth fabric having cells in its texture. This is not a tradename,¹⁷ while "Camel's Hair" belting is.¹⁸

The reason for the distinction lies solely in the fact that the latter words became established in the trade as designating the goods of the first introducer. While the two marks on their face are in identically the same category, the circumstances surrounding their commercial use have rendered the first strictly of common right, and the second that sort of quasi-trademark which for convenience, and because of the inadequacy of our vocabulary, we are constrained to call a tradename.

With all of these distinctions before us, and having regard solely to the meaning which should attach to the word "tradename" if it is to be accurately differentiated from the technical trademark, on the one hand, and the names completely *publici juris* employed in commerce on the other, the author submits the following definition: A tradename is a word or phrase by which a business enterprise or business location or specific articles of merchandise from a specific source are known to the public, and which when applied to merchandise is generic or descriptive and hence not susceptible of appropriation as a technical trademark.

This definition, the author confidently believes, will aid the reader in properly classifying and distinguishing the "trademark" and "tradename" cases, and that it properly includes not only commercial names other than those applied to merchandise, but those names applied

16—Babbitt v. Brown, 68 Hun ton, L. R. (1899) App. Cas. 326.
515.

18—Reddaway v. Banham, L. R.

17—Cellular Clothing Co. v. Max- (1896) App. Cas. 199.

to merchandise which though they are not trademarks have acquired a secondary meaning in the trade and hence are protected in equity against their use by another in fraudulent competition.

The English text-writer, Mr. Kerly, has included this class of words in his treatment of "tradenames." He says: "A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trademark. And if it is within any of the classes enumerated in sec. 64 (of the British Patents, Designs and Trademarks Acts), it may be registered as a trademark. But whether or not the name is applied or attached to the goods, so as to conform to the definition just stated, or registered as a trademark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same class as those in connection with which it has acquired its distinctive significance. * * * The qualified right in the tradename—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends."¹⁹

§ 4. **Earliest recognition of trademarks.**—While the reports of the first English trademark case are not harmonious, it is probable that the report of Popham is substantially correct. It is as follows: "An action upon the case was brought into the common pleas by a clothier that whereas he had gained great reputation for his making of his cloth by reason of which he had great ut-

19—Kerly on Trademarks, 2nd Ed., London 1901, p. 475.

terance to his great benefit and profit, and that he used to set his mark to his cloth whereby it should be known to be his cloth; and another clothier perceiving it used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie.”²⁰

§ 5. **The evolution of the law of trademarks.**—This decision, rendered in 1590, was the first legal recognition of trademarks. The growth of that recognition was very gradual, however, for as late as 1742 we find Lord Hardwicke saying that he “knew no instance of restraining one trader from making use of the same mark with another,”²¹ although the learned chancellor takes judicial cognizance of the wide-spread use of trademarks, observing that “every particular trader had some particular mark or stamp.” And a century later Lord Langdale said: “It does not seem to me that a man can acquire property merely in a name or mark.”²²

§ 6. **The relative protection given by patents and trademarks.**—“Usually the protection given by the patent is far greater, though of less duration in time, than that obtained by the use of a trademark, because if an

20—Southern (or Southerne) v. How, 2 Popham, 144; Cro. Jac. 471; 2 Rolle, 28; Cox, 633; Seb. Dig. 1.

21—Blanchard v. Hill, 2 Atk. 484; Cox, 633; Seb. Dig. 2. Mr. Sebastian observes of this decision: “The decision seems in a great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trademark and a patent not being clearly present to his lordship’s mind.” Sebastian, *Trademarks* (4th ed.), p. 6.

22—1842. Perry v. Truefitt, 6 Beav. 66; 1 L. T. O. S. 384; Seb. 73; Cox, 644, 646. It is now clearly established that the right to a

trademark is a property right. Hall v. Barrows, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; Cox, Manual, Case No. 215. Opinion of Westbury, L. C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 141; Lord Cranworth, in House of Lords, S. C., 11 H. L. C. 533; Lord Kingsdown, in House of Lords, S. C., 11 H. L. C. 544; Messerole v. Tynberg, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; Gilman v. Hunnewell, 122 Mass. 139; Cox, Manual, Case No. 541; Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 95 Fed. Rep. 457, 461, 37 C. C. A. 146.

article is patented, nobody but the owner of the patent can without his consent make or sell anything embodying the same principles or elements, while a trademark only secures one in the use of the name or emblem adopted by him and applied to the article."²²

§ 7. **Trademarks distinguished from patents and copyrights.**—While trademarks to a degree partake of the nature of both patents and copyrights, and the three have many governing legal principles in common, there are wide differences separating each from the others. As stated by Mr. Justice Miller in *Trademark Cases*,²³ "the ordinary trademark has no necessary relation to invention or discovery. The trademark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of congress it is sought to establish it by registration, neither originality, invention, discovery, science or art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original*, and are founded in the creative powers of the mind." And in the House of Lords, in 1882, Lord Black-

22—Allen, J., in *Dover Stamping Co. v. Fellows*, 163 Mass. 191, 40 N. E. Rep. 105, 47 Am. St. Rep. 448, 28 L. R. A. 448.

23—100 U. S. 82, 94. See also *Taylor v. Carpenter*, 2 Sandf. Ch. 603; 11 Paige, 292; Cox, 45; Cox, Manual, Case No. 84; *Levy v. Waitt*, 21 U. S. App. 394, 61 Fed. Rep. 1008, 10 C. C. A. 227; *Hoyt v. Hoyt*, 143 Pa. St. 623; 24 Am. St.

Rep. 575; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624, 626, 35 C. C. A. 496. A trademark "may be, and usually is, wholly destitute of originality." Mr. Justice Brown in *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, 223. To the same effect, see *Wm. J. Moxley Co. v. Braun & Fitts Co.*, 93 Ill. App. 183.

burn said,²⁴ "trademarks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects. And I think, to borrow a phrase used by Lord Ellenborough in *Waring v. Cox*,²⁵ with reference to a different branch of the law, 'much confusion has arisen from similitudinary reasoning on the subject.' "

§ 8. Function —The function of a trademark is to convey to the purchaser knowledge of the origin, source, ownership or manufacture of the article to which it is applied.²⁶ As will be shown hereinafter, the trademark need neither indicate the manufacturer or the place of the article's manufacture, but may indicate either the

24—*Johnston v. Orr Ewing*, 7 App. Cas. 219, 228.

25—1 Camp. 369.

26—"The function of a trademark is to indicate to the public the origin, manufacture or ownership of articles to which it is applied, and thereby secure to its owner all benefit resulting from his identification by the public with the articles bearing it. No person other than the owner of a trademark has a right, without the consent of such owner, to use the same on like articles, because by so doing he would in substance falsely represent to the public that his goods were of the manufacture or selection of the owner of the trademark, and thereby would or might deprive the latter of the profit he otherwise might make by the sale of the goods which the purchaser intended to buy. Where a trademark is infringed the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and it is on this ground that a court of equity protects trade-

marks. It is not necessary that a trademark should on its face show the origin, manufacture or ownership of the articles to which it is applied. It is sufficient that by association with such articles in trade it has acquired with the public an understood reference to such origin, etc." *Bradford, J.*, in *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651, 656.

"The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source." *Lurton, J.*, in *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.*, 91 Fed. Rep. 376, 380.

"It is not essential to property in a trademark that it should indicate any particular person as the maker of the article to which it is attached." *Danforth, J.*, in *Godillot v. Harris*, 81 N. Y. 263.

natural product of the earth, or the handling or selection of the goods, or some labor that has been performed in connection therewith. It serves solely to guide the public to the goods it wants to buy, acting as a perpetual means of identification and advertisement of goods of repute.

§ 9. **Nature of the right to a trademark.**—The right to a trademark is a right of property,²⁷ which the state may, in the exercise of its police power, protect by appropriate penal legislation. This right of property is, in the United States, treated as a common-law right, and in no wise dependent upon written law for its inception.²⁸

Lord Cranworth referred to this right as “a right which can be said to exist only and can be tested only by its violation.”²⁹ While it is true that the right can only be tested after it has been violated, or its violation has been threatened, it is certainly untrue that it exists “only by its violation,” because there is no violation of a right not pre-existing. Judge Folger, speaking for the New York Court of Appeals, criticised this dictum, saying, “but its violation is when one adopts or imitates, and applies to an article of his manufacture the name or mark previously used by another as a designation for his production. * * * It is a matter of property, and the profitable use of property.”³⁰

27—Derringer v. Plate, 29 Cal. 292; 87 Amer. Dec. 170; R. Cox, 324; Seb. 249; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206, 212; Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537, 548; Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883; G. G. White Co. v. Miller, 50 Fed. Rep. 277, 279.

28—Trademark Cases, 100 U. S. 82; Derringer v. Plate, *supra*;

Moorman v. Hodge, 2 Sawyer, 78, 85, Fed. Case No. 9783; L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624, 626; Battle v. Finlay, 50 Fed. Rep. 106; Hennessy v. Braunschweiger, 89 Fed. Rep. 664; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 627, 35 C. C. A. 496.

29—Farina v. Silverlock, 6 DeG., M. & G. 214, 217.

30—Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291.

Much legislation has taken place tending to aid the common-law remedies and afford more effective redress against trademark piracy, but with the solitary exception of California ³¹ it has nowhere been held in the United States that compliance with a statute is a prerequisite to the acquisition of a trademark. The contrary rule obtains in England; registration being necessary to entitle the owner to sue for infringement.³² A peculiar element of the trademark right is that it must be used as an entirety.³³ The owner of a trademark cannot convey to others territorial rights to its use,³⁴ and a partner's interest in the trademarks owned by the partnership cannot be levied upon by or subjected to the payment of claims of his personal creditors.³⁵

§ 10. The test of exclusiveness.—The trademark right must be exclusive; by this test it stands or falls. As Judge Cochran has said, "what makes a mark affixed by a seller to goods produced or selected by him a technical trademark (i. e., one whose exclusive use by him in marking goods of the same or like character will be protected) is that when it is affixed to goods of that character it amounts to a representation that they are the goods of the person who has adopted it as his trademark. If it does not amount to such a representation, it is not a technical trademark."³⁶

31—Whittier v. Dietz, 66 Cal. 78. The evil effect of this decision has since been obviated by the enactment of the present section 3199 of the Political Code of California, which provides that "any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner."

32—The Merchandise Marks Acts, 1887-1894 (50 and 51 Vict., c. 28).

33—Manhattan Med. Co. v.

Wood, Fed. Case No. 9026; 4 Cliff. 461.

34—Snodgrass v. Wells, 11 Mo. App. 590. Per *contra* as to the title of a periodical publication (not a technical trademark), see Estes v. Williams, 21 Fed. Rep. 189.

35—Taylor v. Bemis, 4 Biss. 406; Cox, Manual, 132; Fed. Case No. 13779.

36—Bissell Chilled Plow Works v. T. M. Bissell Plow Co., 121 Fed. Rep. 357, 364.

§ 11. **Requisites of a valid trademark.**—As seen in our definition, a trademark must

(a) Be used in lawful commerce;

(b) Be in some way applied or affixed to a subject of lawful commerce;

(c) Be distinctive, identifying the character of the article to which it is so affixed.

As comprehensive and concise a statement of the requisites of a valid trademark as can be found in the books is as follows: “The trademark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, symbol, word or words, which others have not an equal right to employ for the same purpose.”³⁷

These are fundamental conditions which are never varied, and to which there can be no exception. There are further conditions which we will examine in detail in a subsequent chapter.

§ 12. **Perpetual existence.**—The life of a trademark is as long as its continuous use by the owner or his assignees. It is only terminated by abandonment, which we will deal with later

“A trademark may increase in value to its owners by use, and the law could not put a time limit on the owner’s right to it any more than it could put a limit upon his right to use any other article of property.”³⁸

The act of 1881 provided (§ 5) that a certificate of registry shall in the case of articles manufactured in this country remain in force for thirty years from its date, subject to renewal for a like period at any time during the six months prior to the expiration of the term of thirty years; so that all protection and benefit of that act will be lost by failure to renew within the period stated.

37—Earl, Commissioner of Ap. 38—Hoyt v. Hoyt, 143 Pa. 623, peals, in Newman v. Alvord, 51 N. 22 Atl. Rep. 755.
Y. 189, 193.

But congress was careful to provide further (§ 11 act of 1881) that nothing in the act shall be construed as unfavorably affecting a claim to a trademark after the term of registration shall have expired.

By the Act of 1905 (§ 12), the force of the certificate is limited to twenty years' duration with renewal privileges, and § 23 provides that nothing in the act "shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this Act had not been passed."

§ 13. Territorial limitation.—Unlike a patent, a trademark knows no territorial limitation. The courts of the United States, and those of the several states, are open to the owners of trademarks of whatever citizenship or nationality who may seek to protect their trademarks against piracy.³⁹ The act of congress of 1881 provided for the registration of trademarks owned by aliens located in any foreign country or tribe, which, by treaty, convention or law, affords similar privileges to citizens of the United States" (Act of 1881, sec. 1), and substantially the same provision is contained in the Act of 1905, Sec. 1. The acquisition of a valid trademark in any place carries with it the right to use the mark everywhere.⁴⁰ This is subject to the exception that a foreigner doing business

39—State v. Gibbs, 56 Mo. 133; J. 423; 2 Jur. N. S. 929; 30 L. T. Taylor v. Carpenter (1), 3 Story, 62; Seb. 151; Collins Co. v. Co-458; Cox, 14; Seb. 78; Coats v. hen, 3 K. & J. 428; 3 Jur. N. S. Holbrook, 2 Sandf. 586; Cox, 20; 929; 29 L. T. 245; 30 L. T. 62; Seb. 79; Taylor v. Carpenter (2), 5 W. R. 676; Seb. 152; Collins Co. 2 Wood. & M. 1; Cox, 32; 9 L. T. v. Reeves, 28 L. J. Ch. 56; 4 Jur. 514; Seb. 83; Taylor v. Carpen- N. S. 865; 33 L. T. 101; 6 W. R. ter (3), 2 Sandf. 603; 11 Paige. 717; Seb. 164; Collins Co. v. 292; Cox, 45; Seb. 84; Lemoine Walker, 7 W. R. 22; Seb. 171. v. Ganton, 2 E. D. Smith, 343; 40—Except that an alien who Cox, 142; Seb. 125; Derringer v. abandons his trademark in this Plate, 29 Cal. 292; Cox, 324; Seb. country is not re-vested with the 249; Collins Co. v. Brown, 3 K. & right to use it, by the force of

in his own country under the trademark has no common-law right to that trademark in the United States, as against a domestic firm which had established business under a similar trademark, adopted in good faith, before the alien had sold any goods in this country.⁴¹

In a recent case, an assignment of a trademark limited to certain specified states has been sustained and an infringer enjoined as to those states. The doctrine of this section was not invoked, however, as far as the opinion discloses.⁴² As to a corporate name, the injunction has been limited in its operation, to exclude a defendant from doing business in the state of New York.⁴³

In a case involving the use of the word "Liliputian" in a mail-order business, a Chicago defendant was enjoined at the instance of a New York complainant because of the occupancy by each through the mails of a common business territory.⁴⁴

§ 14. **The necessity of user.**—There can, finally, be no right in or to a trademark apart from its use. "The mere sale of a trademark apart from the business in which it has been used confers no right of ownership, because no one can claim the right to sell his goods as goods manufactured by another. To permit this to be done would be a fraud upon the public."⁴⁵ To quote from a New York court, "There is no such thing as a trademark 'in gross,' to use that term of analogy. It must be 'appendant' of some particular business in which it is actually used upon, or in regard to specified arti-

subsequent legislation in his own country. *Saxlehner v. Eisner & Mendelson Co.*, 91 Fed. Rep. 536, 539. *Saxlehner v. Eisner & Mendelson Co.* (3), 179 U. S. 19, 36.

41—*Richter v. Anchor Remedy Co.*, 52 Fed. Rep. 455; affirmed in *Richter v. Reynolds*, 59 Fed. Rep. 577, 8 C. C. A. 220.

42—*Griggs, Cooper & Co. v. Erie*

Preserving Co., 131 Fed. Rep. 359.

43—*Employers' Liability Assur. Corp., Ltd., v. Employers' Liability Ins. Co.*, 16 N. Y. Supp. 397, 400.

44—*Ball v. Best*, 135 Fed. Rep. 434.

45—*Witthaus v. Braun*, 44 Md. 303; 22 Amer. Rep. 44.

cles."⁴⁶ It follows, therefore, that the owner of a trademark can not sell territorial rights in a trademark to different persons, so as to enable them to make and sell goods as being made by him.⁴⁷ "It goes without saying that a trademark or tradename can only be acquired by adoption accompanied with actual use."⁴⁸ The inventor of a system of manufacturing garments, who has never engaged in their actual manufacture and sale, has no trademark right in a mark to be applied to such garments.⁴⁹

A mere casual use, interrupted, or for a brief period, will not suffice to establish a trademark right in the mark;⁵⁰ there must be such a user, as to its length and publicity, as will show an intention to adopt the mark as a trademark for a specific article.⁵¹

46—*Weston v. Ketcham* (2), 51 How. Pr. 455; *Seb.* 487; *Pinto v. Badman*, 8 R. P. C. 181; *Cartmell*, 270; *Dixon Crucible Co. v. Gugenheim*, 7 Phila. 408; 2 *Brewst.* 321; 3 *Am. L. T.* 288; *Cox*, 559; *Seb.* 331; *Cotton v. Gillard*, 44 *L. J. Ch.* 90; *Seb.* 447; *McAndrew v. Bassett*, 4 *DeG. J. & S.* 380; 33 *L. J. Ch.* 566; 10 *Jur. N. S.* 550; 10 *L. T. N. S.* 442; 12 *W. R.* 777; 4 *N. R.* 123; *Seb.* 234; *Kidd v. Johnston*, 100 *U. S.* 617; *Weston v. Ketcham* (1), 39 *N. Y.* 54; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 *DeG. J. & S.* 137; 11 *H. L. C.* 523. *The Fair v Jose Morales & Co.*, 82 *Ill. App.* 499.

47—*Snodgrass v. Wells*, 11 *Mo. App.* 590. But in another case the assignment by the English publisher of "Chatterbox" of the right to publish a "Chatterbox" in the United States was sustained. *Estes v. Williams*, 21 *Fed. Rep.* 189. The name, being that of a periodi-

cal publication, was not a technical trademark.

48—*Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co.*, 82 *Fed. Rep.* 321, 325, per *Jenkins, J.*

49—*Jaeger's Sanitary W. S. Co. v. Le Boutillier*, 47 *Hun.* 521. Thus under the English statutes a registrant is not entitled to register a mark for goods in which he does not deal and in which he does not actually intend to deal. *John Batt & Co. v. Dunnett*, *L. R.* (1899) *A. C.* 428.

50—*Menendez v. Holt*, 128 *U. S.* 514; *Levy v. Waitt* (1), 56 *Fed. Rep.* 1016; *Levy v. Waitt* (2), 61 *Fed. Rep.* 1008, 10 *C. C. A.* 227; *Brower v. Boulton* (1), 53 *Fed. Rep.* 389; *Brower v. Boulton* (2), 7 *C. C. A.* 567, 58 *Fed. Rep.* 888; *Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co.*, 113 *Fed. Rep.* 468, 51 *C. C. A.* 302. *Tetlow v. Tappan*, 85 *Fed. Rep.* 774; *Heublein v. Adams*, 125 *Fed. Rep.* 782.

51—*Kohler Mfg. Co. v. Beeshore*,

§ 15. **Trademarks as subjects of sale, assignment or bequest.**—In the early adjudications the assignability of trademarks was not clearly established.⁵²

It can now be said, however, that trademarks are generally assignable during the life-time of the owner of the mark, and capable of transmission at his death. Indeed, this rule is the necessary and indispensable correlative of the rule that trademarks have perpetual existence. But there is the necessary qualification that with the trademark must go the good-will of the business, the right to select or manufacture the article to which the former owner has been in the habit of affixing the trademark in use.⁵³ Any other course would tend to mislead

59 Fed. Rep. 572, 576, 8 C. C. A. 215; *Richter v. Reynolds*, 59 Fed. Rep. 577, 579; 8 C. C. A. 220.

52—See *Corwin v. Daly*, 7 Bos. 222; *Cox*, 265, where the court says, referring to a name used as a trademark: "The employer of it can neither give any special right to another, nor abandon it to the community so as forever to take away the right of employing it to designate his wares." In another case it has been held that one can "so sell his name as to deprive himself of the right to use it for his own manufacture, and give the right to another." *Probasco v. Bouyon*, 1 Mo. App. 241. In a later case before the same court, however, the court said: "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public," and concluded that if the public would be led to believe the assignor was still manufacturing the goods, when they were the manufacture of another, the transaction would be a fraud upon the

public and the use of the assigned name would not be protected. *Skinner v. Oakes*, 10 Mo. App. 45; *Cox*, Manual, 680. This dictum was quoted with approval in *Oakes v. Tonsmierre*, 4 Woods, 547; *Price & Steuart*, 817, 49 Fed. Rep. 447.

53—*Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217; *Massam v. Cattle Food Co.*, L. R. 14 Ch. D. 748; *Ex parte Lawrence*, 44 L. T. N. S. 98; *Seb.* 630; *Re Wellcome*, L. R. 32 Ch. D. 213; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 137; 33 L. J. Ch. 199; *Seb.* 223; *Goodman v. Meriden Britannia Co.*, 50 Conn. 139; *Witthaus v. Braun*, 44 Md. 303; 22 Am. Rep. 44; *Seb.* 492; *Skinner v. Oakes*, 10 Mo. App. 45; *Taylor v. Bemis*, 4 Biss. 406, Fed. Case 13779; *McVeagh v. Valencia Cigar Factory*, 32 Off. Gaz. 1124; *Price & Steuart*, 970; *Oakes v. Tonsmierre*, 4 Woods, 547, 49 Fed. Rep. 447; *Price & Steuart*, 817; *Baldwin v. Von Micheroux*, 25 N. Y. Supp. 857; *Morgan v. Rogers*, 19 Fed. Rep. 596; 12 Off. Gaz. 1113; *Smith v. Imus*, 32 Alb. L. J. 455; *Cotton v. Gillard*, 44 L. J.

the public. It is provided by section 70 of the English Patents, Designs and Trademarks Act of 1883 that "A trademark, when registered, shall be assigned and transmitted only in connection with the good-will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with the good-will." No corresponding provision existed in the act of congress of 1881. The act of 1905, § 10, provides "that every registered trademark . . . shall be assignable in connection with the good-will of the business in which the mark is used."

Inasmuch as there can be no title in a trademark apart from the good-will of the business in which it is used, it follows that, in an assignment of the business and good-will of the owner of the mark, the title to the trademark, without being specially mentioned, passes to the assignee.⁵⁴ It is not so clear, however, that the purchaser acquires the right to use the name of the vendor, this

Ch. 90; *Smith v. Fair*, 14 Ont. Rep. 303; 22 Amer. Rep. 44; Seb. 492; 729; *Burton v. Stratton*, 12 Fed. Rep. 696; *Price & Steuart*, 668; 596; 26 Off. Gaz. 1113; *Cox, Manual*, 692; *Merry v. Hoopes*, 111 N. Y. 420; *Churton v. Douglas, Johns*, 23 N. E. Rep. 1068; *Cox, Manual*, 716; *Cooper v. Hood*, 26 Beav. 293; *Churton v. Douglas, Johns*, 114; *Shipwright v. Clements*, 19 W. R. 599; *Sohier v. Johnson*, 111 Mass. 238; *Gegg v. Bassett*, 3 Ont. L. Rep. 263; *Dant v. Head*, 90 Ky. 255, 13 S. W. Rep. 1073; *J. G. Mattingly Co. v. Mattingly*, 96 Ky. 430, 31 S. W. Rep. 985.

54—*Shipwright v. Clements*, 19 W. R. 599; Seb. 350; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 57 Barb., 526; *Cox*, 599; 45 N. Y. 291; 10 Abb. Pr. N. S. 348; 6 Amer. Rep. 82; 4 Am. L. T. 168; *Cox*, 624; Seb. 354; *Witthaus v. Braun*, 44 Md. 303; 22 Amer. Rep. 44; Seb. 492; *Morgan v. Rogers*, 19 Fed. Rep. 596; 26 Off. Gaz. 1113; *Cox, Manual*, 692; *Merry v. Hoopes*, 111 N. Y. 420; *Churton v. Douglas, Johns*, 23 N. E. Rep. 1068; *Cox, Manual*, 716; *Cooper v. Hood*, 26 Beav. 293; *Churton v. Douglas, Johns*, 114; *Shipwright v. Clements*, 19 W. R. 599; *Sohier v. Johnson*, 111 Mass. 238; *Gegg v. Bassett*, 3 Ont. L. Rep. 263; *Dant v. Head*, 90 Ky. 255, 13 S. W. Rep. 1073; *J. G. Mattingly Co. v. Mattingly*, 96 Ky. 430, 31 S. W. Rep. 985; *Hegeman v. Hegeman*, 8 Daly, 1; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624, 35 C. C. A. 496; *Allegretti v. Allegretti Chocolate Cream Co.*, 177 Ill. 129, 53 N. E. Rep. 487, affirming s. c. 76 Ill. App. 581; *Snyder Mfg. Co. v. Snyder*, 54 Ohio St. 86, 43 N. E. Rep. 325.

right being affirmed in some cases⁵⁵ and negatived in others.⁵⁶ It would seem to be the law that a territorial right to use a trademark cannot be assigned⁵⁷ though in the case of the name of a periodical publication the contrary rule has been announced.⁵⁸

The fact of a trademark containing the name or initials of a former owner of a business will not disentitle an assignee of the business from its use, because the proper name is treated as indicative of the business rather than the present owner of the business.⁵⁹ But the courts of the United States are inclined to insist that the public be notified of the change of ownership, and

55—*Banks v. Gibson*, 34 Beav. 566; *Levy v. Walker*, L. R. 10 Ch. D. 463; *Webster v. Webster*, 3 Swanst. 490; *Clark v. Leach*, 32 Beav. 14; *Bond v. Milbourn*, 20 W. R. 197; *Tussaud v. Tussaud*, 38 W. R. 440; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Hoff v. Tarrant & Co.*, 71 Fed. Rep. 163; affirmed in *Tarrant & Co. v. Hoff*, 76 Fed. Rep. 959, 22 C. C. A. 644; *J. G. Mattingly Co. v. Mattingly*, 96 Ky. 420.

56—*Scott v. Rowland*, 20 W. R. 208; *Lewis v. Langdon*, 7 Sim. 421; *Turner v. Major*, 3 Giff. 442; *Dence v. Mason*, 41 L. T. N. S. 573; *Dickson v. McMaster*, 18 Ir. Jur. 202; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; *Howe v. Searing*, 10 Abb. Pr. 264; *Cox*, 244; *Petersen v. Humphrey*, 4 Abb. Pr. 394; *Cox*, 212; *Thynne v. Shove*, 89 L. T. Jour. 84; *Mayer v. Flanagan*, 12 Tex. Civ. App. 405; *Sherwood v. Andrews*, 5 Am. L. Reg. N. S. 588; Seb. 263.

57—*Snodgrass v. Wells*, 11 Mo. App. 590.

58—*Estes v. Williams*, 21 Fed. Rep. 189.

59—*Pepper v. Labrot*, 8 Fed. Rep. 29; *LePage Co. v. Russia Cement Co.*, 2 C. C. A. 555, 51 Fed. Rep. 941; *Jennings v. Johnson*, 37 Fed. Rep. 364; *Frazer v. Frazer Lubricator Co.*, 121 Ill. 147, 13 N. E. Rep. 639; *McLean v. Fleming*, 96 U. S. 245; *Symonds v. Jones*, 82 Me. 302, 8 L. R. A. 570; *Filkins v. Blackman*, 13 Blatchf. 440, Fed. Case No. 4786; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178; *Young v. Jones*, 3 Hughes, 274, Fed. Case No. 18,159; *Fulton v. Sellers*, 4 Brewst. 42; *Weston v. Ketcham* (1), 39 N. Y. 54; *Clark v. Ins. Co.*, 7 Mo. App. 71; *Frank v. Sleeper*, 150 Mass. 583, 23 N. E. Rep. 213; *Hoxie v. Chaney*, 143 Mass. 592; *Russia Cement Co. v. LePage*, 147 Mass. 206, 17 N. E. Rep. 304; *Brown Chemical Co. v. Meyer*, 139 U. S. 540; *Bulte v. Ingleheart Bros.*, — C. C. A. —; 137 Fed. Rep. 492, 499. The fact that a trademark includes the name and portrait of the first owner does not render it unassignable to another. *Richmond Nervine Co. v. Richmond*, 159 U. S. 293, 302.

this is now the safer rule,⁶⁰ particularly where the trademark is a mark of special qualities, due to superior material, processes, care and skill exercised by the originator thereof, or the mark bearing his name "would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trademark should be used by other persons, and for this reason such a trademark would be held to be unassignable. . . . But, on the other hand, the usages of trade may be such that no such inference would naturally be drawn from the use of a trademark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trademark are of a certain standard, kind or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is on the trademark."⁶¹ In the sale of a business, then, the general rule is that the trademarks connected with the business will pass to the purchaser without being specified in the bill of sale,⁶² and in case of a general assignment or bankruptcy the trademarks also pass, to inure to the benefit of the creditors.⁶³ The ex-

60—*Manhattan Med. Co. v. Wood*, 108 U. S. 218; *Horton Mfg. Co. v. Horton Mfg. Co.*, 18 Fed. Rep. 816; *Alaska Packers' Ass'n v. Alaska Imp. Co.*, 60 Fed. Rep. 103; *Siebert v. Abbott* (1), 61 Md. 276; *Sherwood v. Andrews*, 5 Am. L. Reg. N. S. 588; Seb. 263; *Carmichael v. Latimer*, 11 R. I. 395; Seb. 521; *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841; 12 C. C. A. 432; *People v. Molins*, 10 N. Y. Supp. 130.

61—*Charles Allen, J., in Hoxie v. Chaney*, 143 Mass. 592, 10 N. E. Rep. 713.

62—*Shipwright v. Clements*, 19

W. R. 599; *Wilmer v. Thomas*, 74 Md. 485; 13 L. R. A. 380; *Solis Cigar Co. v. Pozo*, 16 Colo. 388; 25 Am. St. Rep. 279; *Laughman's Appeal*, 128 Pa. 1, 18 Atl. Rep. 415, 5 L. R. A. 599; *Morgan v. Rogers*, 19 Fed. Rep. 596. Trademarks "pass under a sale of the 'assets and goodwill' of the business, whether specially mentioned or not." *Holland, J., in Kronthal Waters v. Becker*, 137 Fed. Rep. 649, 652.

63—*Hegeman v. Hegeman*, 8 Daly, 1; *Rogers v. Taintor*, 97 Mass. 291; *Warren v. Warren Thread Co.*, 134 Mass. 247; *Hud-*

ception to each of these rules arises where the trademark depends upon the secret processes or individual skill of its owner for its value.⁶⁴

Trademarks may, in connection with the good-will of the business wherewith they are connected, be transmitted by bequest.⁶⁵ This naturally leads to the result that several persons may by bequest (as they may upon dissolution of copartnership) become possessed of the right to use the same trademark. As where a decedent, a watchmaker using "Dent, London" as a mark on watches which he manufactured at three several shops in London, bequeathed the business of two of these shops to one person and the third shop to another. It appears to have been held here that each legatee had a several right to the use of the trademark.⁶⁶ The rights of the partners in the use of the firm trademarks upon dissolution have been thus defined by Judge Hughes: "Rights in trademark are analagous to rights in the good-will of a partnership. In the absence of express stipulation at the time of dissolution, each partner may go on and use the trademark of the firm."⁶⁷ It is

son v. Osborne, 39 L. J. Ch. 79; Cotton v. Gillard, 44 L. J. Ch. 90; *Ex parte Foss*, 2 DeG. & J. 230; Bury v. Bedford, 4 DeG. J. & S. 352; *Ex parte Young*, Seb. 537; Longman v. Tripp, 2 Bos. & P. N. R. 67; Hammond v. Brunker, 9 R. P. C. 301; Cartmell, 142; Lippiu-cott v. Hubbard, 28 Pitts. L. J. 303; Burkhardt v. Buckhardt Co., 4 Ohio N. P. 358; Batchellor v. Thomson, 86 Fed. Rep., 630; Sar-razin v. W. R. Irby Cigar Co., 35 C. C. A. 496, 93 Fed. Rep. 624, 626. The Bankruptcy Act of 1898, § 70a, provides that the trustee in bankruptcy shall be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, to all "inter-ests in patents, patent rights, copy- rights, and trademarks." 64—Re Swezey, 62 How. Pr. 215. 65—McLean v. Fleming, 96 U. S. 245; Huwer v. Dannenhoffer, 82 N. Y. 499, 502. 66—Dent v. Turpin, 2 J. & H. 139; 30 L. J. Ch. 495; 7 Jur. N. S. 673; 4 L. T. N. S. 673; 9 W. R. 548. Mr. Cox observes, "This case is to be taken as of an exceptional character; it is not in accord with settled principles." Cox, Manual, 196. 67—Young v. Jones, Fed. Case No. 18,159, 3 Hughes, 274; Price & Steuart, 150. And to the same effect, see Caswell v. Hazard, 121 N. Y. 484, 24 N. E. Rep. 707; Hazard v. Caswell (2), 93 N. Y. 259-

clear, however, that where a mark is a common design for the purpose of a common adventure used by several independent dealers or manufacturers in a joint enterprise, a mark belonging to neither individually, but representing the enterprise of all concerned, for the purposes of their joint adventure, the trademark can be used only so long as all the parties remain interested in the enterprise; when it terminates, the function and life of the trademark also terminate.⁶⁸ If the business and good-will of a partnership are sold upon dissolution the trademark goes with the other assets.⁶⁹ Another question is presented where one partner retires from the firm. If the retiring partner re-engages in business and continues to use the trademark, it has been held that that fact, even if the mark is applied by him to a spurious article, is evidence of his intention to retain his interest

262; *Huwer v. Dannenhoffer*, 82 N. Y. 499, 502; *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591; 6 N. R. 373; 13 W. R. 1012; 11 Jur. N. S. 680; Seb. 248; *Condy v. Mitchell*, 37 L. T. N. S. 268; 37 L. T. N. S. 766; 26 W. R. 269; Seb. 561; *Taylor v. Bothin*, Fed. Case No. 13,780, 5 Sawy. 584; *Wright v. Simpson*, 15 Off. Gaz. 968; *Price & Steuart*, 165. In this connection Mr. Justice Bradley said: "In holding that it is necessary to the validity of a trademark that the claimant of it must be entitled to an exclusive right to it, or property in it, we do not mean to say that it may not belong to more than one person, to be enjoyed jointly or severally. Copartners, upon a dissolution of partnership, may stipulate that each of them may use the trademarks of the firm, and there may be many other cases of joint and several ownership; but such co-owners will together be entitled to the exclusive

use of the trademark, and perhaps each of them will be entitled to such exclusive use as to all other persons except their associates in ownership." *New York Cement Co. v. Copley Cement Co.*, 45 Fed. Rep. 212.

68—*Re Jones* 53 L. T. 1, *Cartmell*, 189; *Robinson v. Finlay*, and *Ward v. Robinson*, L. R. 9 Ch. D. 487; 39 L. T. 398; 27 W. R. 294; *Cartmell*, 295. These cases arose between merchants in Manchester and corresponding houses in Manilla and Rangoon. The trademarks were composite marks, containing crests, names of the individuals written in Chinese characters, coats of arms, and other personal *indicia* of the parties interested.

69—*Armistead v. Blackwell*, 1 Off. Gaz. 603; Seb. 399; *Rogers v. Taintor*, 97 Mass. 291; Seb. 283; *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54; Seb. 173; *Banks v. Gibson*, 34 Beav. 566; 11 Jur. N. S. 680, 34 L. J.

in the trademark.⁷⁰ If upon dissolution one partner takes the whole business by agreement, the valuation of the retiring partner's interest must include his interest in the trademarks of the partnership, which pass with the good-will.⁷¹

Trademarks upon the death of their owner pass with his other personalty to his personal representatives.⁷² There should, of course, be a conveyance of the decedent's title by administration; and where, as in *Hovenden v. Lloyd*, there is no administration, and a relation simply continues business and uses the trademark, he probably acquires no title to the trademark thereby. At all events, in that case, where the deceased's son so used the trademark and subsequently sold his business with its good-will to a third party, it was held that the son had acquired no title capable of being transferred to such third party.⁷³ The supreme court of Pennsylvania, however, has distinctly held that where a man's sons continued to use his trademark after his death (there having been no evidence of administration upon his estate) and subsequently separated, each continuing in business and using the trademark, they were entitled to an injunction against a stranger imitating that trademark, upon a bill in equity in which they joined as complainants. The subject is not as fully discussed by the court as it should have been. The language of Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*⁷⁴ is quoted in the opinion, as follows: "Difficulties, however, may arise where the trademark con-

Ch. 591; 13 W. R. 1012; 6 N. R. 273.

70—Wright v. Simpson, 15 Off. Gaz. 968; Price & Steuart, 165.

71—Banks v. Gibson, 34 Beav. 566; 11 Jur. N. S. 680; 34 L. J. Ch. 591; 13 W. R. 1012; 6 N. R. 373; Seb. 248; Gage v. Canada Pub. Co., 11 Can. S. C. R. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

72—Croft v. Day, 7 Beav. 84; Re Farina, 44 L. T. N. S. 99; Giblett v. Read, 9 Mod. 459.

73—Hovenden v. Lloyd, 18 W. R. 1132; Seb. 337. There was substantially the same state of facts and the same holding in *Singleton v. Bolton*, 3 Doug. 293; Cox, 634; Seb. 4.

74—11 H. L. C. 523.

sists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trademark, and they would be protected against any infringement of the exclusive right to that name. They would be so protected, because according to the usage of trade they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him." In the course of its opinion the Pennsylvania court observes: "It was urged, however, that conceding this symbol to have been a valid trademark in the hands of Jesse Darlington (grandfather of complainants), or even of Jared (his son), that upon the death of the latter it ceased to be the property of any one, and that its use by several members of the family of the latter destroyed its distinctive features and left it open to the public to appropriate it. We cannot assent to this proposition."⁷⁵ It might be suggested that in cases of this character (i. e., where no administration is had upon the estate of a deceased owner of a trademark) its use by relatives in a similar business is practically an adoption *de novo* of the mark, left open to the world for appropriation by its owner's death.

Where the owner of a trademark takes partners into

75—Paxon, J., in Pratt's Appeal, 117 Pa. St. 401, 412. "The reason why a trademark may pass 'without administration,' as suggested by Paxon, J., in Pratt's Appeal, 117 Pa. St. 401, seems to be that a trademark can have no value except in connection with the business to which it attaches; and as creditors are not usually in condition to realize the value of the trademark, either by carrying on

the business themselves or by selling to one who will, its chief element as an asset is wanting. But it seems, also, that cases may arise in which the trademark of a deceased testator or intestate is of value to creditors, or a subject of contention among heirs, when administration may become necessary." Woerner, *Administration*, 635, note 8.

the business in which it is employed, the title to the trademark ordinarily is merged into the partnership assets.⁷⁶ The supreme court of the United States has apparently held to the contrary,⁷⁷ but the facts were that the owner of the mark owned the premises in which the business was conducted, and took two of his clerks into partnership. He did not convey the realty to the firm, and upon dissolution there was correspondence between him and the withdrawing partners which, in the language of Mr. Justice Field, "discloses beyond question their knowledge of the transfer and recognition of his power to make it;" referring to his subsequent sale of his business and his trademark to another. It would seem from this decision, then, that the partner who originally owns the mark may by agreement permit the use of the trademark by the firm during its existence, reserving the title to the trademark to himself in the event of dissolution.

In a recent case it has been held that "When a trademark or tradename is owned by one who enters into a partnership with another for the manufacture of the article designated, the title of the trademark does not pass to the partnership except by express agreement."⁷⁸ A like ruling has been made as to the trademark of one of the incorporators of a corporation.⁷⁹ In each case the title of the mark is a question of fact, and title to personalty usually follows possession. Use by a partnership is *prima facie* evidence of ownership by the partnership.

The federal supreme court has held that when a part-

76—Weston v. Ketcham (2), 51 264, 70 N. E. Rep. 64.
How. Pr. 455; Filkins v. Black-
man, 13 Blatchf. 440, 446, Fed. 77—Kidd v. Johnson, 100 U. S.
Case No. 4,786; Sohler v. John- 617, 619.
son, 111 Mass. 238, 242; Bury 78—Kirkpatrick, J., in Greacen
v. Bedford, 4 DeG. J. & S. 352-371; v. Bell, 115 Fed. Rep. 553, 554.
Condy v. Mitchell, 37 L. T. N. S. 79—Cutter v. Gudebrod Bros. Co.
(2), 61 N. Y. Supp. 225,
268; Moore v. Rawson, 185 Mass.

ner retires from a firm, assenting to or acquiescing in the retention by the other partners of the old place of business and the future conduct of the business by them under the old name, the good-will (including the title to the firm's trademarks) remains with the latter as a matter of course.⁸⁰

It is important to note, in considering the assignability of trademarks, the doctrine first announced by Judge Shipman, that "The right to use a trademark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached."⁸¹ And where the trademark involved the use of the assignor's name, it was said: "Where an individual parts with a right to the use of his own name in any given connection, the courts should not extend the contract by which he does so beyond its necessary scope. It certainly will not be held that a man has tied himself up so as to prevent the use of his own name any further than the clear terms of the agreement show his intention to do so."⁸²

One who has assigned either his trademark⁸³ or trade-name⁸⁴ will be enjoined from again using the mark or name himself; if he makes such an assignment to a corporation with a reversion to him if the corporation ceases to exist, he cannot make a valid assignment of the mark to another during the life of the corporation.⁸⁵

The assignee of a trademark does not, merely by vir-

80—Menendez v. Holt, 128 U. S. 514, 522.

81—Filkins v. Blackman, 13 Blatchf. 440, 444, Fed. Case No. 4,786. This rule is again laid down in *Chattanooga Medicine Co. v. Thedford* (1), 49 Fed. Rep. 949, 952; *Chattanooga Medicine Co. v. Thedford* (2), 58 Fed. Rep. 347.

82—Newman, J., in *Chattanooga*

Medicine Co. v. Thedford (2), 58 Fed. Rep. 347, 349.

83—Bury v. Bedford, 4 DeG. J. & S. 352; *Burkhardt v. Burkhardt Co.*, 4 Ohio N. P. 358.

84—*Churton v. Douglas, Johnson* (Eng.), 174.

85—*Petrolia Mfg. Co. v. Bell & Bogart Soap Co.*, 97 Fed. Rep. 781, 784.

tue of the assignment, obtain a right to enjoin infringers of the mark. He must show that he has actually applied it, commercially, to goods of the class for which it is claimed as a trademark.⁸⁶

While, as we have seen, a trademark is assignable only in connection with the good-will of the business in which it is used, it does not follow that both must be conveyed by the same instrument or at the same time; and under the English Patents, Trademarks and Copyright Act of 1883 it has been held that the registration of an assignment of a trademark need not be contemporaneous with the assignment of the goodwill.⁸⁷ It is possible that the originator of a manufacturing business and the person who purchases that business may each thereafter have a right to the limited use of the tradename and trademark used in connection with that business.⁸⁸ Where such a state of facts arises, either the vendor or purchaser can assign his right to the use of the tradename and trademark, and either will be enjoined upon the application of the other from using the words "only genuine" in connection with the name or mark.⁸⁹

In a case where a trademark was used by a manufacturer in England and also by a firm in the United States in which he was a partner, the use of the trademark having begun in both places about the same time, and it having become a distinctive mark, identifying the article manufactured in the United States, the English manufacturer retired from the American house. Upon his subsequently attempting to use it in a separate business of the same kind in this country, it was held that his successors

86—Walton v. Crowley, Fed. Belle Wagon Works, 82 Wis. 546; Case No. 17,133, 3 Blatchf. 440, 448; Fish Bros Wagon Co. v. Fish Bros. Filkins v. Blackman, 13 Blatchf. Mfg. Co., 87 Fed. Rep. 201; affirmed, 95 Fed. Rep. 457, 37 C. C. 440, 445, Fed. Case No. 4786.

87—Re Wellcome, L. R. 32 Ch. A. 146.
D. 213; 3 R. P. C. 76; 55 L. J. Ch. 89—Fish Bros. Wagon Co. v. 542; 54 L. T. 493; 34 W. R. 453; Fish Bros. Mfg. Co., 87 Fed. Rep. Cartmell, 342. 203.

88—Fish Bros. Wagon Co. v. La

in the old firm had, upon his retirement, succeeded to the exclusive right to use the trademark, as part of the business, and he was enjoined from using the mark in his new establishment in the United States.⁹⁰ This case is but a practical application of the doctrines we have just considered, to an unusual state of facts.

Whenever the alien owner of a trademark has abandoned its use in the United States by neglecting to assert his rights as against infringers in this country, the public has a right to use that mark, of which it will not be divested by the operation of a law subsequently enacted by the country of which the former owner is a citizen.⁹¹ A trademark applied to mineral paint produced from a deposit on a particular piece of land will pass to a purchaser of the land as an incident to the realty,⁹² as will a trademark applied to the wafer of a particular spring,⁹³ or the right to use words designating a particular building rather than the business conducted therein,⁹⁴ or the right to use a mark which has come to designate the product of a mill or factory rather than of the proprietor.⁹⁵

In a case where the plaintiff had assigned the right to use his trademark to the defendant for a term of years, for a share of the profits of defendant's business, and during the term re-engaged in the use of the mark, in an action by the plaintiff upon the contract it was held that the plaintiff could recover the profits due him under the contract, and the defendant was allowed damages for the breach of the contract. The validity of the assignment appears not to have been questioned.⁹⁶

90—Batchelor v. Thompson, 86 Fed. Rep. 630.

91—Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536; Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19, 36.

92—Prince Mfg. Co. v. Prince's Metallic Paint Co. 15 N. Y. Supp. 249; Cox, Manual, 721.

93—Hill v. Lockwood, 32 Fed. Rep. 389.

94—Armstrong v. Kleinhaus, 82 Ky. 303.

95—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217.

96—Coe v. Bradley, 9 Off. Gaz. 541, Fed. Case No. 2,941.

There is an exception to the general rule that a trademark cannot be assigned save in connection with a business; where the mark is associated with the product of a secret process, the mark necessarily goes with an assignment of the process.⁹⁷ Thus the Court of Appeals of New York, speaking through O'Brien, J., has said, "There are doubtless some trademarks that consist of words that identify an article produced by some secret process and without the use of which the article could not be described. In other words the name used may be inherent in the article itself and is not used as in this case to distinguish one cigar from another. The celebrated cordial, which is in use the world over, known as 'Chartreuse' is a sample of a trademark, the bare assignment of which might confer upon the assignee the right to manufacture and sell that article."⁹⁸

§ 16. Assignability of distillery brands and the like.—Trademarks used at a particular producing establishment upon the articles produced at the establishment may be lawfully assigned and transferred with the establishment. Of such a mark it has been said that "its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place and are of the same character as those to which the mark was attached by its original designer."⁹⁹ This rule has been applied to brands consisting in whole or in part of proper names. Thus, in the leading case, the brand was "S. N. Pike's Magnolia Whiskey,"¹⁰⁰ and in another case the brands were "J. G. Mattingly & Sons, Standard Bourbon" and "J. G. Mattingly & Sons, Pure Rye."¹⁰¹

97—Tuttle v. Blow, 176 Mo. 158, 173; Falk v. American West Indies Trading Co., 180 N. Y. 445; Baldwin v. VonMicheroux, 25 N. Y. Supp. 857, 859.

98—Falk v. American West In-

dies Trading Co., 180 N. Y. 445.

1—Mr. Justice Field in Kidd v. Johnson, 100 U. S. 617.

2—Kidd v. Johnson, 100 U. S. 617.

3—J. G. Mattingly Co. v. Mat-

§ 17. **Unfair competition.**—In 1877, the American writer, Mr. Charles E. Coddington, in his excellent digest of trademark cases, remarked that “The interference of courts of equity, instead of being founded upon the theory of protection to the owner of trademarks, is now supported mainly to prevent frauds upon the public.⁴ If the use of any words, numerals or symbols is adopted for the purpose of defrauding the public, the courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the court may not have the exclusive right to the use of these words, numerals or symbols.”⁵ He added that this rule was fully supported by four cases, two English and two American, which he cited.⁶ Since that time, the recognition of the doctrine so expressed has grown steadily and certainly, so that it now demands treatment as a specific branch of the law, separate, apart from, but including the narrower and strictly technical law of trademarks.⁷ “The tendency of the courts at the present time seems to be to restrict the scope of the law applicable to technical trademarks, and to extend its scope in cases of unfair competition.”⁸

tingly, 17 Ky. L. Rep. 1, 27 S. W. L. J. Ch. 130; 23 L. T. N. S. 443; Rep. 985; J. G. Mattingly Co. v. 18 W. R. 942; L. R. 5 H. L. 508; 42 Mattingly, 96 Ky. 430, 31 S. W. L. J. Ch. 130; 27 L. T. N. S. 393; Rep. 279. Seb. 229.

4—The writer erred in ascribing 1872. Newman v. Alvord, 49 this as the only reason. The prevention fraud upon the person Barb. 588; 35 How. Pr. 108; Cox, whose goods are pirated is equally 404; 51 N. Y. 189; 10 Am. Rep. important and cogent. Humphrey’s 588; Seb. 282.
Specific Med. Co. v. Wenz, 14 Fed. 1877. Kinney v. Basch, Seb. 542.
Rep. 250; Skinner v. Oakes, 10 7—“The law of unfair competi-
Mo. App. 45. tion is well settled. It is only the
application of that law to individ-
ual cases which requires discus-
sion.” Lacombe, J., in Walter
Baker & Co. v. Sanders, 80 Fed.
Rep. 889, 891, 26 C. C. A. 220.

5—Coddington, Digest, sec. 36.

6—1869. Lee v. Haley, 21 L. T. 8—Baker, J., in Church &
N. S. 546; 18 W. R. 181; L. R. 5 Dwight Co. v. Russ, 99 Fed. Rep.
Ch. 155; 39 L. J. Ch. 284; 22 L. 276-278.
T. N. S. 251; 18 W. R. 242; Seb. 325.

1872. Wotherspoon v. Curie, 22
L. T. N. S. 260; 18 W. R. 562; 42

§ 18. **Historical.**—In 1742, in *Blanchard v. Hill*, a decision of no authority and of no particular use except to illustrate the slow growth of the law of trademarks, Lord Hardwicke observed, referring to *Southern v. How*:⁹ “It was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away business from the other clothier.”¹⁰ The chancellor so crudely expressed (but disapprovingly) the first reported judicial reference to the law of unfair competition. In 1896, Lord Chancellor Halsbury, addressing the House of Lords, said: “For myself, I believe the principle of the law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else.”¹¹ This sentence is a terse statement of the fundamental maxim of unfair competition. The English courts have long recognized the rule, and it may be found repeated in various phraseology by all the English courts within whose jurisdiction trademark and analogous cases have come.

It is more difficult to trace the growth of this doctrine in the American decisions. Chancellor Sandford in 1825, in an action concerning the right to the name of a periodical, observed, “The injury for which redress is given . . . results from the imposture practiced upon the customers of an existing establishment, or upon the public,”¹² so recognizing the rule which Mr. Coddington failed to recognize.

Twelve years later, in Massachusetts, it was said that “Imposition, falsehood and fraud, on the part of the de-

9—*Southern v. How*, Popham. 11—*Reddaway v. Banham*, L. R. 144; Cro. Jac. 471; 2 Rolle, 28; (1896) Appeal Cases, 199-204. Seb. 1.

10—*Blanchard v. Hill*, 2 Atk. Ch. R. 347; Cox, 1; Seb. 41. 484; Seb. 2.

12—*Snowden v. Noah*, Hopkins'

fendant, in passing off his own medicines as those of the plaintiff, would be a ground of action.”¹³

In 1840 Chancellor Walworth was presented with an application for an injunction to restrain the use of the words “New Era” as the name of a newspaper, the complainant being the proprietor of a rival periodical denominated “Democratic Republican New Era.” He denied the application, and in the course of his opinion said: “The allegation in the complainant’s bill of complaint is that the defendant has assumed the name of the complainant’s newspaper for the fraudulent purpose of imposing upon the public, and supplanting him in the good-will of his established paper, by simulating the name and dress thereof; with the intent to cause it to be understood, and believed by the community, that the defendant’s newspaper was the same as the complainant’s, and thereby to injure the circulation of the latter. If this were in fact so, I should have no difficulty in making this order absolute. For although the business of publishing newspapers ought, in a free country, to be always open to the most unlimited competition, fraud and deception certainly are not essential to the most perfect freedom of the press. . . . As the names of party newspapers, in these days, have no necessary connection with the principles which they advocate, and are manufactured as readily as the new names if not the new principles of political parties, there could be very little excuse for the editor of a newspaper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons.”¹⁴

Not until 1888 did the United States supreme court give distinct recognition to the law of unfair competi-

13—Thomson v. Winchester, 19 Pick. 214; Seb. 59.

14—Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

tion,¹⁵ and three years later Mr. Chief Justice Fuller announced the doctrine clearly and unequivocally, in these terms: "The jurisdiction to restrain the use of a trademark rests upon the grounds of the plaintiff's property in it, and of the defendant's unlawful use thereof. If the absolute right belonged to plaintiff, then, if an infringement were clearly shown, the fraudulent intent would be inferred, and, if allowed to be rebutted in exemption of damages, the further violation of the right of property would nevertheless be restrained. It seems, however, to be contended that plaintiff was entitled at least to an injunction, upon the principles applicable to cases analogous to trademarks; that is to say, on the ground of fraud on the public and on the plaintiff, perpetrated by defendant by intentionally and fraudulently selling its goods as those of the plaintiff. Undoubtedly an unfair and fraudulent competition against the business of the plaintiff—conduct with the intent, on the part of the defendant, to avail itself of the reputation of the plaintiff to palm off its goods as plaintiff's—would, in a proper case, constitute ground for relief."¹⁶

15—Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; Cox, Manual, 705. In this case Mr. Justice Field said (128 U. S. at p. 604), "The case at bar cannot be sustained as one to restrain unfair trade. Relief in such cases is granted only where the defendant, by his mark, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacturer, to the injury of the plaintiff." Citing *McLean v. Fleming*, 96 U. S. 245; *Sawyer v. Horn*, 1 Fed. Rep. 24, 4 Hughes, 239;

Perry v. Truefit, 6 Beavan, 66; *Croft v. Day*, 7 Beavan, 84.

Indeed, *McLean v. Fleming* may be properly regarded as the first case in which the federal supreme court made any mention of the doctrine. This sentence occurs in the opinion: "Nor is it necessary, in order to give a right to an injunction, that a specific trademark should be infringed; but it is sufficient that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant." *McLean v. Fleming*, 96 U. S. 245.

16—*Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537; Cox, Manual, 720.

With this decision the doctrine of unfair competition may be regarded as being finally established in the United States; and as based not only on fraud on the public, but on the plaintiff.¹⁷

17—"The law relating to this subject is well understood. No man has a right to use names, symbols, signs or marks which are intended, or calculated, to represent that his business is that of another. No man should in this way be permitted to appropriate the fruits of another's industry, or impose his goods upon the public by inducing it to believe that they are the goods of some one else. If A presents his goods in such a way that a customer who is acquainted with the goods of B and intends to purchase them is induced to take the goods of A instead, believing them to be the goods of B, A is guilty of a fraud which deceives the public and injures his competitor. Where the goods of a manufacturer have become popular not only because of their intrinsic worth, but also by reason of the ingenious, attractive and persistent manner in which they have been advertised, the good-will thus created is entitled to protection. The money invested in advertising is as much a part of the business as if invested in buildings, or machinery, and a rival in business has no more right to use the one than the other,—no more right to use the machinery by which the goods are placed on the market than the machinery which originally created them. No one should be permitted to step in at the eleventh hour and appropriate advantages resulting from

years of toil on the part of another."

"The action is based upon deception, unfairness and fraud, and when these are established the court should not hesitate to act. Fraud should be clearly proved; it should not be inferred from remote and trivial similarities. Judicial paternalism should be avoided; there should be no officious meddling by the court with the petty details of trade; but, on the other hand, its process should be promptly used to prevent an honest business from being destroyed or invaded by dishonest means." *Coxe, J., in Hilson Co. v. Foster*, 80 Fed. Rep. 896-897.

"The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader; and he cannot, therefore (in the language of Lord Langdale in the case of *Perry v. Truefit*, 6 Beavan, 66-73), 'be allowed to use names, marks, letters or other indicia by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.'" Lord Kingsdown in *Leather Cloth Co. (Ltd.) v. American Leather Cloth Co. (Ltd.)*, 11 H. L. C. 358; followed in *Johnston v. Orr-Ewing*, 7 App. Cas. 219-229.

"The gradual but progressive judicial development of the doctrine of unfair competition in trade has shed lustre on that branch of our jurisprudence as an embodiment, to a

§ 19. Unfair competition distinguished from trademark infringement.—It can hardly be doubted that at its inception the doctrine of unfair competition was devised to protect the public, rather than to recognize any vested right in the complainant. He had adopted a geographical name, a generic term, or words otherwise *publici juris*, to designate his wares. Perhaps he had no device, symbol or mark whatsoever, but relied upon the shape, form or color of his packages. He had, at all

marked degree, of the principles of high business morality, involving the nicest discrimination between those things which may, and those which may not, be done in the course of honorable rivalry in business. This doctrine rests on the broad proposition that equity will not permit any one to palm off his goods on the public as those of another. The law of trademarks is only one branch of the doctrine. But while the law of trademarks is but part of the law of unfair competition in trade, yet when the two are viewed in contradistinction to each other an essential difference is to be observed. The infringement of trademarks is the violation by one person of an exclusive right of another person to the use of a word, mark or symbol. Unfair competition in trade, as distinguished from infringement of trademarks, does not involve the violation of any exclusive right to the use of a word, mark or symbol. The word may be purely generic or descriptive, and the mark or symbol indicative only of style, size, shape or quality, and as such open to public use 'like the adjectives of the language,' yet there may be unfair competition in trade by an improper use of such word, mark or symbol. Two rivals in business competing with each other in the same line of goods may have an equal right to use the same words, marks or symbols on similar articles produced or sold by them respectively, yet if such words, marks or symbols were used by one of them before the other and by association have come to indicate to the public that the goods to which they are applied are of the production of the former, the latter will not be permitted, with intent to mislead the public, to use such words, marks or symbols in such a manner, by trade dress or otherwise, as to deceive or be capable of deceiving the public as to the origin, manufacture or ownership of the articles to which they are applied; and the latter may be required, when using such words, marks or symbols, to place on articles of his own production or the packages in which they are usually sold something clearly denoting the origin, manufacture or ownership of such articles, or negating any idea that they were produced or sold by the former." *Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-659.

events, none of those methods of distinguishing his goods from those of other merchants which the law recognizes as a right of property and denominates "trademark." Yet his goods had a fixed quality and were sought for by the public. When his competitor endeavored to palm off other goods as his upon the public, the chancellor would say as Lord Langdale said: "My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not in fair and honest dealing entitled."¹

The true theory of unfair competition has not always been as clearly stated by the courts as it should be. One line of decisions bases this doctrine and the right to injunctive relief upon the protection of the public from fraud. On the other hand, Judge Thayer has stated that relief is granted "To restrain the defendants from perpetrating a fraud which injures the complainant's business, and occasions him a pecuniary loss."²

It is very clear that equity intervenes in the protection from fraud of both the complainant whose business is or may be injured by the unfair and fraudulent competition, and the public who are the consumers of his merchandise.³

In a sense it is not exact to separate the doctrines of trademark infringement and unfair competition.⁴ The underlying doctrine is the same—the control of fraud, great or petty, by the intervention of equity; and yet,

1—*Croft v. Day*, 7 Beav. 84; the same effect see *Pierce v. Gittard*, 68 Cal. 68-71. Seb. 76.

2—*Carson v. Ury*, 39 Fed. Rep. 777; *Cox, Manual*, 709; following *Goodyear India Rubber Glove Mfg.*

3—*Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537. 4—See note to *Scheuer v. Muller*, 20 C. C. A. 161.

Co. v. Goodyear Rubber Co., 128 U. S. 598; *Cox, Manual*, 705. And to

without a clear understanding of the doctrines of unfair competition, it is impossible to read intelligently the tradename cases which have so long been treated either as being "trademark" cases, or cases "analogous to" trademark cases. We have discussed elsewhere the use of proper names as trademarks, and from an examination of the cases the careful student will conclude that proper names are not trademarks, and that there should not be such a thing as a technical tradename. A name which is not a trademark is not entitled to protection as a trademark.⁵ It is only entitled to protection when it is fraudulently used by another. Thus, in the case of "Dent, London,"⁶ which we have before referred to, Dent is a proper name and London a geographical word. They are entitled to protection against fraudulent use, but only for the same reasons and in the same sense that the size, shape, color and design of labels or packages are entitled to protection against such fraudulent use. This is true of many cases which have been decided by the courts as trademark cases.

The fact is that there has always existed the willingness of equity to keep the zeal of competing traders within the bounds of fairness.⁷ In the very early case

5—"After a careful consideration of the various cases bearing on the subject, the conclusion was reached in *Draper v. Skerrett*, 116 Fed. Rep. 206, that, to justify a court of equity in interfering in an alleged case of unfair competition, there must be something more than the mere duplication by the one party of the other's tradename, and that this was to be found in the deceptive use of imitative methods of display, or other device by which the public are led into buying the infringer's goods where they intended to buy those of the original producer; the fraud so perpetrated being a legitimate ground for equitable interference, and the practical basis of it. It is by this standard that the complainant's right to relief in the present instance must be judged. *Stevens Linen Works v. Don & Co.*, 121 Fed. Rep. 171; *Allen B. Wrisley Co. v. Iowa Soap Co.*, 122 Fed. Rep. 796, 59 C. C. A. 54." Archbald, J., in *Heide v. Wallace & Co.*, 129 Fed. Rep. 649, 650: Affirmed (C. C. A.), 135 Fed. Rep. 346.

6—*Dent v. Turpin*, 30 L. J. Ch. 495; Seb. 196; *Ante*, p. 26.

7—This branch of the law is a

of *Singleton v. Bolton*, where both parties made and sold a compound which they styled "Dr. Johnson's Yellow Ointment," Lord Mansfield said: "If the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie. But here both the plaintiff and defendant use the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff."⁸ So that even at the early date of the rendition of that opinion (1783) the remedy for unfair competition would have been applied upon a proper state of facts; i. e., if the defendant had sold his goods as the goods of the plaintiff.

In 1810 Lord Eldon said: "There can be no doubt that this court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same place, under the same sign or name, the party giving himself out as the same person."⁹ It was by analogous reasoning that the same learned judge, six years later, enjoined the piracy of Lord Byron's name, applied to poems not of his composition.¹⁰

In 1836 Lord Langdale enjoined a defendant from using omnibuses painted like the plaintiff's, and driven and managed by servants dressed in livery like that of the plaintiff's servants.¹¹

So that the doctrine was old when Mr. Justice Clifford said from the bench of the federal supreme court, "Nor is it necessary, in order to give a right to an injunction,

most interesting illustration of the unlimited adaptability of equity to cope with fraud in every form. Judge Townsend has accurately observed that "A court of equity keeps pace with the rapid strides of the sharp competitors for the prize of public favor, and insists that it shall be won only by fair trade." *R. Heinisch's Sons Co. v.*

Boker, 86 Fed. Rep. 765-768.

8—*Singleton v. Bolton*, 3 Doug. 293; Cox, 624; Seb. 4.

9—*Crutwell v. Lye*, 17 Ves. 335; 1 Rose, 123; Seb. 17.

10—*Lord Byron v. Johnston*, 2 Mer. 29; Seb. 23.

11—*Knott v. Morgan*, 2 Keen. 213; Seb. 57.

that a specific trademark should be infringed; but it is sufficient that the court is satisfied that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant."¹²

The whole question of fairness in trade is peculiarly within the province of equitable jurisdiction; trademark infringement is but one form of unfair competition. Unfair competition is the equivalent term for the "passing off" of the English¹³ and the "*concurrence deloyale*" of the French decisions.¹⁴

It must be borne in mind, however, that there is this practical distinction between the issues in cases of technical trademark infringement and cases of unfair competition where no technical trademark is involved; the court is to be guided to its conclusions not by reference to any arbitrary, fanciful and distinctive device to which the plaintiff has a property right. But it is for him to determine, in the light of all the facts, whether or not an unfair competition has been instituted by the respondent. Judge Kirkpatrick, in referring to this question, has said: "Recognizing the principle, I am of the opinion that the similarity (of the competing articles) which will warrant the interference of the court must be determined by the circumstance of each case."¹⁵ While fraud is presumed from the wrongful use of a trademark it must be proven, directly or by inference, in all cases of unfair competition which do not involve a technical trademark.¹⁶

12—McLean v. Fleming, 96 U. S. 245.

13—Lever Bros. (Ltd.) v. Beddingfield, 80 L. T. 100.

14—Pouillet, *Marques de Fabrique et de la Concurrence Deloyale* (4th ed.), secs. 459 *et seq.*

15—Kroppf v. Furst, 94 Fed. Rep. 150.

16—Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-279. "The

deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances." Mr. Chief Justice Fuller, in *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 128 U. S. 537-551. To the same effect see *Scriven v. North, C. C. A.*, 134 Fed. Rep. 366, affirming, with modification, *Scriven v. North*, 124 Fed. Rep. 894.

But it is true of both classes of cases that where the defendant's conduct is calculated to mislead, "it is not essential that any particular person should have been actually misled,"¹⁷ nor is it necessary to prove that the defendant's goods have actually been sold as the plaintiff's.¹⁸

As we have noted, the policy of the law is to encourage legitimate competition. Thus it has been held that a manufacturer under a patent cannot complain of the competition of a former employee who has patented an invention in the same art and is manufacturing under his patent.¹⁹

This rule that fraud must be proven in cases of unfair competition is exemplified by reference to the cases cited in the foot-note, where such comparisons have been made by the courts, resulting in a finding that the competition of the respondent was fair,²⁰ and others where the facts have led the court to the contrary conclusion.²¹

With the exception of this feature, the same general rules of law and procedure prevail in this class of cases

17—Dallas, J., in *Bickmore Gall Cure Co. v. Karns*, 134 Fed. Rep. 833, 835, C. C. A. : and to the same effect see *Scheuer v. Muller*, 74 Fed. Rep. 225, 20 C. C. A. 161; *Swift & Co. v. Brenner*, 125 Fed. Rep. 826.

18—*Devlin v. McLeod*, 135 Fed. Rep. 164, 166.

19—*American Coat Pad Co. v. Phoenix Pad Co.*, 113 Fed. Rep. 629, 51 C. C. A. 339.

20—*Kroppf v. Furst*, 94 Fed. Rep. 150; *Putnam Nail Co. v. Aulsebrook Horseshoe Co.*, 53 Fed. Rep. 390; *Sterling Remedy Co. v. Eureka Mfg. Co.*, 70 Fed. Rep. 704; *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.*, 88 Fed. Rep. 694; *Klotz v. Hecht*, 73 Fed. Rep. 822;

Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; *C. F. Simmons Med. Co. v. Simmons*, 81 Fed. Rep. 162; *La Republique Francaise v. Schultz*, 94 Fed. Rep. 500; *Vitascope Co. v. United States Phonograph Co.*, 83 Fed. Rep. 30; *Brown v. Doscher*, 147 N. Y. 647; *Mumm v. Kirk*, 40 Fed. Rep. 589; *Jaros Hygienic Underwear Co. v. Simons*, 49 Fed. Rep. 276.

21—*Draper v. Skerrett*, 94 Fed. Rep. 912; *Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co.*, 87 Fed. Rep. 864; *Block v. Standard Distilling Co.*, 95 Fed. Rep. 978; *Allegretti Chocolate Cream Co. v. Keller*, 85 Fed. Rep. 643; *City of Carlsbad v. Tibbetts*, 51 Fed. Rep. 852.

as obtain in proceedings to restrain trademark infringement. Thus, an injunction to restrain an unfair competition has been expressly denied upon the ground that the complainant was guilty of laches and acquiescence.²²

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts cannot entertain such an action arising between citizens of the same state.²³

§ 20. **Trade slander and libel.**—The question whether equity will enjoin competing traders from publishing libelous or slanderous matter concerning their competitors' business has been frequently presented to the courts. In an early case Lord Eldon said: "The publication of a libel is a crime, and I have no jurisdiction to prevent the commission of crimes, except, of course, such cases as belong to the protection of infants, where a dealing with an infant may amount to a crime,—an exception arising from that peculiar jurisdiction of this court."²⁴ How far this doctrine—which extended to all forms of libel—has been modified by the federal courts of the United States is an involved question, the discussion of which would not be relevant in this book.

But at an early date Lord Cottenham, in refusing to

22—*La Republique Francaise v. Schultz*, 94 Fed. Rep. 500, 501.

23—*Illinois Watch Case Co. v. Elgin Nat. Watch Co.*, 94 Fed. Rep. 667-672. And see *Air-Brush Mfg. Co. v. Thayer*, 84 Fed. Rep. 640.

24—*Gee v. Pritchard*, 2 Swanst. 402. To the same effect see (refusing an injunction against the exhibition of a painting falsely purporting to be a copy of a picture by the plaintiff) *Martin v. Wright*, 6 Sim. 297; refusing to enjoin a publication by defendant of a statement disparaging the plaintiff's literary work, *Seely v. Fisher*, 11 Sim. 581; 10 L. J. Ch. N. S. 274. And see *Clark v. Freeman*, 11 Beavan, 112; *Fleming v. Newton*, L. R. 1 H. L. C. 363; *Bullock v. Chapman*, 2 DeG. & Sm. 211; *Browne v. Freeman* (2), Cox, Manual, 424; *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. D. 142; *Fisher & Co. v. The Apollinaris Co.*, L. R. 10 Ch. D. 297-299; *Ward v. Drat*, Cox, Manual, 607.

enjoin libelous statements uttered of the plaintiff's literary work, said that the proper remedy lay in an action at law.²⁵ And the English courts have subsequently held that where matter has been held libelous in an action at law, the repetition of the libel would be enjoined in equity.²⁶ In one case where the court refused to enjoin a defendant from circulating an advertisement among the plaintiff's customers which charged the plaintiff with infringing his trademarks, the court intimated that the injunction might have been granted if malice had been shown.²⁷ It may now be regarded, however, as the settled law in England that "the court will interfere by injunction where statements are made with reference to the infringement of a patent, or the invasion of a trademark and the like, if it is proved to the satisfaction of the court that these statements are untrue."²⁸

The same doctrine would seem to obtain in this country. It is libelous to publish of a dealer in school books that he deals in "antiquated books" and books which are "disgraceful trash."²⁹ And it has been held libelous *per se* to publish of another dealer of the same name (Davey) "that an unscrupulous grocer of the same name, in the immediate vicinity, advertises 'Davey's teas and coffees,' with a view to deceive the public, and may sell an inferior article."³⁰ Judge Lacombe has laid down the broad proposition that "every legal occupation from which pecuniary benefit may be derived creates such special susceptibility to injury by language charging un-

25—Seely v. Fisher, 11 Sim. 581; Liebig's Extract of Meat Co., 45 L. J. Ch. N. S. 274.

26—Saxby v. Easterbrook, Cox, Manual, 606; Hinrichs v. Berndes, Cox, Manual, 594; Thorley's Cattle Food Co. v. Massam, L. R. 46 L. J. Ch. 713.

27—Colley v. Hart, 7 R. P. C. 101.

28—Chitty, J., in Anderson v. Supp. 161.

Liebig's Extract of Meat Co., 45 L. T. N. S. 757-758; and to the same effect, Halsey v. Brotherhood, 45 L. T. N. S. 640; Empire Typesetting Machine Co. v. Linotype Co., 79 L. T. N. S. 8.

29—American Book Co. v. Gates, 85 Fed. Rep. 729-734.

30—Davey v. Davey, 50 N. Y.

fitness or improper conduct of such occupation that such language is actionable, without proof of special damage."³¹ It is the necessary corollary of this rule that a disparaging statement concerning the goods sold by another, whether under a trademark or not, must be of a character to charge him with business incapacity or improper conduct of his business before it can come within the class of matter that is slanderous or libelous *per se*. For if the words used apply to the plaintiff's merchandise in such a manner as to constitute an imputation of his improper conduct in or want of capacity for his business, they will be libelous or slanderous *per se*.³²

The truth is always a defense in actions of this character. Thus where the plaintiff had bought the goods in question from the defendant and advertised them for sale, the publication of an advertisement by the defendant that read as follows: "An opinion of Shawknit hose should not be formed from the navy blue stockings advertised as first quality by (plaintiff), since we sold (plaintiff) some lots which were damaged in the dye-house," was held not libelous, in the absence of a showing of its untruth.³³ And a wide latitude is allowed in criticism of chattels where the facts are not misstated. So it is not libelous to attack the theories advanced in a book even with sarcasm and ridicule, if there is no misrepresentation of what is set forth in the book;³⁴ and a criticism of one of the pictures of an artist stating that it is not good of its kind is not libelous, where it does not attack him in his professional character generally.³⁵

31—Ohio & Miss. Ry. Co. v. v. Mason (Oregon), 38 Pac. Rep. Press Pub. Co., 48 Fed. Rep. 206. 130.

32—So where in a criminal prosecution under the Oregon Code the words applied to the property of the prosecuting witness in such a manner as to expose him to hatred, contempt or ridicule, they were held to be a libel upon him. State

33—Boynton v. Shaw Stocking Co., 146 Mass. 219; 15 N. E. Rep. 507.

34—Dowling v. Livingstone, 108 Mich. 321; 66 N. W. Rep. 225.

35—Battersby v. Collier, 54 N. Y. Supp. 363.

So, it has been held in England that no action will lie against a defendant trader for stating falsely and maliciously that his goods are superior to those of the plaintiff, even though the plaintiff suffers special damage therefrom,³⁶ and no false statement directly disparaging the plaintiff's goods is actionable in the absence of proof of special damage.³⁷

Where an alleged libel consisted of a charge that the plaintiff had no right to use a certain trademark, it was held to be a slander of title and not a libel upon the plaintiff; that the burden was upon the plaintiff to prove malice, falsity and special damage, and that the cause of action survived the plaintiff's death.³⁸

The remedy for libel or slander affecting the title to a trademark depends upon whether there is a threatened continuance of the publication of the libelous or slanderous matter. "Courts of equity have no jurisdiction of libel or slander affecting title to property or property rights, or any other slander or libel, unless threatened or apprehended repetition makes preventive relief proper and necessary. The remedy for past injuries of that nature is understood to be wholly at law."³⁹

§ 21. Are trademark rights monopolistic in character?
—In some jurisdictions, there has been a tendency to regard trademark rights as monopolies, and to that fact may be accredited the line of decisions which have construed technical trademark rights very narrowly.⁴⁰

36—Hubbuck v. Wilkinson (C. L. R. (1898) 1 Q. B. 86. icy, because against common right. The grants, charters, letters patent, or other form of device or assurance by the sovereign for their creation were declared by the act of Parliament of 21 Jac. I, c. 3, to be 'utterly void and of none effect, and in no wise to be put in use and operation.' Nothing short of the 'omnipotence of parliament' is able to exclude a subject from trade in England. 7 Bac. Abr. p.

37—Mellin v. White, L. R. (1895) A. C. 154. or other form of device or assurance by the sovereign for their creation were declared by the act of Parliament of 21 Jac. I, c. 3, to be 'utterly void and of none effect, and in no wise to be put in use and operation.' Nothing short of the 'omnipotence of parliament' is able to exclude a subject from trade in England. 7 Bac. Abr. p.

38—Hatchard v. Mege, L. R. 18 Q. B. D. 771-775. or other form of device or assurance by the sovereign for their creation were declared by the act of Parliament of 21 Jac. I, c. 3, to be 'utterly void and of none effect, and in no wise to be put in use and operation.' Nothing short of the 'omnipotence of parliament' is able to exclude a subject from trade in England. 7 Bac. Abr. p.

39—Wheeler, J., in Palmer v. Travers, 20 Fed. Rep. 501. or other form of device or assurance by the sovereign for their creation were declared by the act of Parliament of 21 Jac. I, c. 3, to be 'utterly void and of none effect, and in no wise to be put in use and operation.' Nothing short of the 'omnipotence of parliament' is able to exclude a subject from trade in England. 7 Bac. Abr. p.

40—"Monopolies of any sort have never been favorites with the law. They were held by the common law to be against public pol-

This tendency is erroneous. When the Statute of Monopolies, 21 Jac. I, c. 3, was enacted, in 1623, trademarks had never been legally recognized. The Statute, therefore, could have no possible reference to trademark rights. The later decisions which refer to trademarks as being monopolistic in character have been based upon a misconception of what constitutes a trademark. Resulting as it does from the mere effort of the producer or handler of an article to identify his goods to the purchaser, it is merely a medium of authentication, and while the owner's title to it is necessarily exclusive, it is in no sense a monopoly. The effort of an infringer to invade that right is not a laudable attempt to break a monopoly, but an offense against society, and it has been

23. Two exceptions to this general rule were given by the early text writers: First. 'It seemeth clear that the king may, for a reasonable time, make a good grant to any one of the sole use of any art invented or first brought into the realm by the grantee.' Second. The king may grant to particular persons the sole use of some particular employments, as 'of printing the Holy Scriptures and law books' etc. The somewhat curious reason given for the second exception is that an unrestrained liberty to print the books to which it relates might be 'of dangerous consequences to the public.' To these exceptions a third must now be added, viz. the right of a tradesman to the exclusive use of such signs, words, or symbols as he may have adopted and used in his business to distinguish articles of his own production from all similar articles produced by other persons. These exceptions do not impair the force of the general rule,

'Exceptio probat regulam de rebus non exceptis.' The rule is unrestricted liberty in the practice of all arts and trades, and in the use of the methods by which they are conducted. He who asserts the right to an exclusive privilege in any department of business must bring himself under the protection of some recognized exception to the rule. The plaintiffs in this case claim an exclusive privilege under the third exception, viz. the right to the sole use of a certain trademark adopted, used, and registered by them; and they allege that the defendants have adopted and are now using a trademark which is an imitation of, and an infringement upon, their own. It becomes important, therefore, to learn just what the plaintiffs' trademark is, and then to determine whether it has been improperly imitated by the defendants." Williams, J., in *P. C. Weist Co. v. Weeks*, 177 Pa. 412, 35 Atl. Rep. 693.

likened by the courts to the criminal offenses of forgery and counterfeiting. Thus, Judge Rives said, "That any imitation of a trademark, calculated to deceive the unwary customer, differs from absolute forgery, not in the nature, but rather in the extent of the injury."⁴¹

The Supreme Court of Missouri has said that "If by fraudulent means, other parties are permitted to counterfeit and forge and simulate these trademarks . . . the community is imposed on and cheated."⁴²

The distinction has been emphasized by a Scottish court in the following language:

"Monopoly is not the thing for which the one party struggles and which the other resists. On the contrary, fair trading is all for the protection of which the law is invoked; and the public, as well as the manufacturer or merchant, are concerned that infringement of trademarks and trade designations should be prevented. For there is a double wrong: the public are or may be deceived, and the trader whose trademark or trade designation is infringed is or may be injured."⁴³

§ 22. **Title.**—The general rule has been stated by Mr. Justice Clifford to be that "trademarks are an entirety, and are incapable of exclusive use at different places by more than one independent proprietor."⁴⁴ But this rule is subject to exceptions; or, rather, the word "exclusive," as used by Mr. Justice Clifford, must not be construed to mean that there cannot be joint and several ownership of a trademark. Mr. Justice Bradley has said at Circuit that, "In holding that it is necessary to the validity of a trademark or tradename that the claimant must be entitled to an exclusive right to it, or property in it, we do not mean to say that it may not belong to more than one

41—Blackwell v. Armistead, Fed. v. Young & Sons, Ct. Sess. Cas. Case No. 1474, 3 Hughes, 163. 4th Ser. X 874.

42—Wagner, J., in State v. Gibbs, 44—Manhattan Med. Co. v. Wood, 56 Mo. 133, 136. Fed. Case 9026.

43—Lord Craighill in Dunnachie

person, to be enjoyed jointly or severally. Copartners, upon dissolution of a partnership, may stipulate that each of them may use the trademarks of the firm, and there may be many other cases of joint and several ownership; but such co-owners will together be entitled to the exclusive use of the trademark, and perhaps each of them will be entitled to such exclusive use as to all other persons except their associates in ownership.⁴⁵ Judge Swan has said that a trademark "may be the subject of ownership by two or more, without impairing the claim of its owners to redress for its unlawful use by others."⁴⁶

As indicated in the last quotation, general and several ownership arises frequently upon the dissolution of partnership, where the assets are divided or the trademark is not sold with the other assets, even in the absence of a special agreement.⁴⁷

Joint and several ownership may also be created by consent.⁴⁸ It may also be created by assignment.⁴⁹ And a contract for the purpose of establishing and defining the respective trademark rights of the parties to it, and providing for the addition of other matter to the trademark, in order to prevent confusion between the goods of the parties, has been sustained upon grounds of public policy.⁵⁰

§ 23. Licenses.—The extent to which licenses for the use of trademarks may be granted, has not yet been definitely settled, although the courts have repeatedly recognized their existence and enforced them. Thus, relief by injunction was granted by the United States Circuit Court

45—New York & R. Cement Co. v. Copley Cement Co., 45 Fed. Rep. 212.

46—Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-439.

47—Taylor v. Bothin, Fed. Case No. 13,780; Young v. Jones, Fed. Case No. 18159.

48—Emerson v. Badger, 101 Mass. 82; Pratt's App. 117 Pa. 401.

49—Fish Bros. Wagon Co. v. LaBelle Wagon Works, 82 Wis. 546.

50—Waukesha H. M. Springs Co. v. Hygeia S. D. Water Co., 11 C. C. A. 277, 63 Fed. Rep. 438.

in Texas, notwithstanding the defense that the complainant had granted a license to another to use the trademark within the state of Texas; Judge Sabin remarking, "The fee to the trademark still remains in the complainant, and any injury to it will justify injunction."⁵¹ And in a more recent case, Judge Hazel construed a conveyance of "the absolute and exclusive use" of certain trademarks in and to certain states, reserving the right to the personal use of the mark by the person executing the conveyance, to be sufficient to entitle the grantee in the conveyance to maintain suit against an infringer.⁵²

It is to be regretted, that in the case last referred to, the court did not go fully into the question whether exclusive contemporaneous rights to the same trademark may exist in different parts of the same country. The latter question is wholly undetermined, and is probably the most important question concerning the tenure of trademark rights, which has not yet been adjudicated. In a recent case, Judge Dallas has treated the question of licensing the use of a trademark exactly as if it were a license under a patent, wholly on the authority of the well-established line of decisions in patent cases, that where there is an exclusive licensee of the right to use a trademark, he is a necessary party to a bill for its infringement. In this case, however, the mark was used upon a patented article during the life of the patent, and the license granted covered both the patent and the trademark rights.⁵³

Where the defense is interposed to an action for infringement, that the defendant has had a license for its use, that defense is met by showing that the defendant has failed to perform all the conditions of the licens-

51—Moxie Nerve Food Co. v. Preserving Co., 131 Fed. Rep. 359
Baumbach, 32 Fed. Rep. 205-210. 362.

52—Griggs, Cooper & Co. v. Erie 53—Wallach v. Wigmore, 87
Fed. Rep. 469.

ing agreement, and has been notified by the plaintiff that the license has been terminated.⁵⁴

In an action for the recovery of license fees, the defendant is estopped to deny the validity of the mark.⁵⁵

54—Martha Washington Cream-
ery Buttered Flour Co. of the Uni-
ted States v. Martien, 44 Fed. Rep.
473.

55—Hilsen v. Libbey, 44 N. Y.
Supr. Ct. 12.

CHAPTER II.

THE ACQUISITION OF A TRADEMARK.

§ 24. **Who may acquire.**—Generally speaking, any person¹ capable of holding title to personal property may acquire the right to a trademark. In practice, by far the greater portion of all trademarks are held by manufacturers. There are, however, many persons, not manufacturers, who use trademarks as a means of identifying the subject-matter of their commerce. First among these, in their natural order, are those who apply geographical names as trademarks, to the natural products of the earth. This may be done, of course, only by the owner of its sole place of production,² as, if the product were accessible to others, there could be no exclusive right to the trademark, except to identify the person who handled the product on its way to the consumer.

This leads us to the second, and larger, class of those who can acquire trademark rights, though they are not manufacturers. Many mercantile houses who merely select merchandise, use trademarks upon the goods they

1—"A corporation is entitled to have its trademark as well as a private individual, and may sue for its infringement." Fenner, J., in *Insurance Oil Tank Co. v. Scott*, 33 La. Ann. 946.

2—*Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 45 N. Y. 291-302; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; Cox, 599; *Dunbar v. Glenn*, 42 Wis. 118; Seb. 529; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Apolinaris Co. v. Norrish*, 33 L. T. N. S. 242; *Radde v. Norman*, L. R. 14 Eq. 348; *Braham v. Beachim*, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; Seb. 589; *Hill v. Lockwood*, 32 Fed. Rep. 389; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469; *City of Carlsbad v. Kutnow*, 71 Fed. Rep. 167, 18 C. C. A. 24; affirming 68 Fed. Rep. 794; *Northcutt v. Turney*, 101 Ky. 314; 41 S. W. Rep. 21. To the same effect see *Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217.

so select,³ and these are valid, because, in the language of Mr. Chief Justice Fuller, the marks so used are equivalent to a certificate that the goods so marked are the genuine article which has been determined by the selectors to possess a certain degree of excellence, evidencing that the skill, knowledge and judgment of the selectors have been exercised in ascertaining that the particular goods so marked are possessed of a merit rendered definite by their examination and of a uniformity rendered certain by their selection.⁴ Slightly analogous to this class of cases are those where the members of a trades union adopt a label to be used by the workmen who compose the union, upon the goods manufactured by them. In a number of cases their right to the protection of this label, as a trademark, has been denied,⁵ while in others the right is affirmed.⁶

3—*Dewitt v. Mathey*, 18 Ky. L. Rep. 257, 35 S. W. Rep. 1113.

4—*Menendez v. Holt*, 128 U. S. 514-520; *Levy v. Waitt* (1), 56 Fed. Rep. 1016; *Levy v. Waitt* (2), 61 Fed. Rep. 1008, 10 C. C. A. 227; *Hirsch v. Jonas*, L. R. 3 Ch. D. 584, 586; *Re Australian Wine Importers (Ltd.)*, 41 Ch. D. 278-281; *Thompson & Co. v. Robertson*, Ct. Sess. Cas. (4th ser.) XV, 880; 25 Scot. L. Rep. 649; *Yale Cigar Mfg. Co. v. Yale*, 30 Off. Gaz. 1183; *Wood v. Lambert*, L. R. 32 Ch. D. 247.

5—*Ex parte Cigar Makers' Ass'n*, 16 Off. Gaz. 958; *Schneider v. Williams*, 44 N. J. Eq. 391; *Cigar Makers' Union v. Conhaim*, 40 Minn. 726 (the last case by a divided court, three denying the right of trademark and two affirming it); *McVey v. Brendel*, 144 Pa. St. 235; *Cox*, Manual, Case No. 730; *Weener v. Brayton*, 152 Mass. 101; *Cox*, Manual, Case No. 712;

State v. Berlinsheimer, 62 Mo. App. 165.

6—*Allen v. McCarthy*, 37 Minn. 349, affirming the decision of the lower court by an equally divided bench; *Bloete v. Simon*, 19 Abb. N. C. 88; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Cigar Makers' Protective Union v. Lindner*, 3 Ohio St. Dec. 244; *Strasser v. Moonelis*, 108 N. Y. 611; *Tracy v. Banker*, 170 Mass. 266; *Beebe v. Tolerton & Stetson Co.*, 117 Iowa 593, 91 N. W. Rep. 905; *Bulena v. Newman*, 31 N. Y. Supp. 449; *Cigarmakers' International Union of America v. Goldberg*, 57 Atl. Rep. 141; *Cohn v. People*, 149 Ill. 486, 37 N. E. Rep. 60; *State v. Hagen*, 6 Ind. App. 167, 33 N. E. Rep. 223; *Hetterman v. Powers* 102 Ky. 133, 43 S. W. Rep. 180. In *Carson v. Ury*, Judge Thayer remarks: "It is no doubt true that the union label does not answer to the definition ordinarily given of a technical trademark, be-

Importers⁷ or exporters⁸ may have trademarks to identify the goods passing through their hands, and it has been held that a bleacher who finishes goods manufactured by another has a right to a trademark applied to goods so treated by him.⁹

§ 25. **User.**—There can be no right in a trademark until it has been used. Under the English act¹⁰ an application for registration of a trademark is deemed to be equivalent to public use of the trademark. But even this is merely to supply a constructive instead of the actual user required at common law,¹¹ and the general rule is not affected by that statute.¹² The exclusive right to the use of a trademark is acquired only by priority of appropriation. The claimant of a trademark must have

cause it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer, and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long and only so long as he remains a member of the union. In each of these respects the label lacks the characteristics of a valid trademark." In the case at bar, the complainant being a manufacturer of cigars, he was granted equitable relief on the ground of unfair competition. *Carson v. Ury*, 39 Fed. Rep. 777; *Cox, Manual*, Case No. 709. As to criminal prosecution for infringement of union label see *State v. Bishop*, 128 Mo. 373. As to the sufficiency of proof in such a prosecution under the Massachusetts statute of 1895 (C. 462, § 4), see

Commonwealth v. Rozen, 176 Mass. 129, 57 N. E. Rep. 223.

7—*Godillot v. Hazard*, 44 N. Y. Super. Ct. 427.

8—*Robinson v. Finlay*, L. R. 9 Ch. D. 487.

9—*Re Sykes*, 43 L. T. N. S. 626.

10—Sec. 75, Patents, Designs and Trademark Act, 1883, amended 1888, 51 and 52 Vict., c. 50; *Re Hudson's Trademark*, 3 R. P. C. 155; 32 Ch. D. 311; 55 L. J. Ch. 531; 55 L. T. 228; 32 W. R. 616; *Cartmell*, 168; *Edwards v. Dennis*, 30 Ch. D. 454.

11—Under the act of 1870 it was held that registration was equivalent to public use of a trademark. *Re Dutcher Temple Co.*, Comr. Dec. 1871, p. 248. See sections 7 and 11 of the Act of 1881; *Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co.*, 11 Fed. Rep. 495.

12—*Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-440; *Lowell Mfg. Co. v. Larned*, *Cox, Manual*, No. 423.

been the first to use or employ the same on like articles of production.¹³ A single instance of user, with accompanying circumstances evidencing an intent to continue that use,¹⁴ is sufficient to establish the right to a trademark; there is no requirement that the use shall continue for any prescribed or definite length of time.¹⁵ It is immaterial that the first use of the mark was accidental, for a trademark, in the language of the United States Supreme Court, "is often the result of accident rather than design."¹⁶

On the other hand, the use of a mark may be "so transitory, spasmodic, and inconsiderable," as not to vest title in its user as against one whose use has been "long-continued, notorious, and universally recognized."¹⁷

§ 26. **Affixing the mark.**—As stated in our definition, the mark must be affixed to the subject it serves to identify. "It may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envel-

13—J. R. Watkins Med. Co. v. Sands, 83 Minn. 326, 86 N. W. Rep. 340.

14—Columbia Mill Co. v. Alcorn, 150 U. S. 460; Tetlow v. Tappan, 85 Fed. Rep. 774; Hyman v. Solis Cigar Co., 4 Colo. App. 475; American Washboard Co. v. Saginaw Mfg. Co., 43 C. C. A. 233; 103 Fed. Rep. 281; Welsbach Light Co. v. Adam, 107 Fed. Rep. 463.

15—Shaver v. Shaver, 54 Iowa, 208; 37 Am. Rep. 194; Hall v. Barrows, 32 L. J. Ch. 548; Seb. 215.

The length of time required to establish the right of trademark.—"The interference of a court of equity cannot depend on the length of time the manufacturer has

used the trademark." Romilly, M. R., in Hall v. Barrows, 32 L. J. Ch. 548.

The right exists "the moment the article goes into the market so stamped." Westbury, L. C., in McAndrew v. Bassett, 4 DeG. J. & S. 380-386.

The right dates from the time when the actual occupation of the market with goods bearing the mark began. Levy v. Waitt, 61 Fed. Rep. 1008-1011, 10 C. C. A. 227.

16—Mr. Justice Miller in Trademark Cases, 100 U. S. 82.

17—Heublein v. Adams, 125 Adams, 125 Fed. Rep. 782, 785. And see *ante*, sec. 11.

ope or case containing the goods."¹⁸ It has been held in England that a trademark may be water-marked,¹⁹ and a measuring stick with an octagonal head, used as a core for rolls of carpet, has been held to be of itself a valid trademark.²⁰ The question of the mode of affixing is purely practical, and one package, parcel or bottle of merchandise may bear a number of trademarks. A very large percentage of the liquors imported into the United States from Europe bear not only the trademark of the producer, but also that of the bottler; and in many cases another trademark, that of the capsule manufacturer, is to be found impressed in the metallic capsule. In like manner a complicated machine may bear many trademarks, indicating the manufacturers of the wheels, axles, oil-cups, bearings, etc., and the machine as a whole bear the comprehensive trademark of the maker who has selected these several parts and assembled them.

A trademark cannot be acquired by merely using the mark in advertising.²¹

§ 27. **Registration not a means of acquiring.**—With the solitary exception of the California case of *Whittier v. Dietz*,²² it has nowhere been held in the United States that the right to a trademark is created by registration.²³

18—Sir G. Jessel, M. R., in *Singer Mfg. Co. v. Wilson*, *supra*.

19—Alexander Pirie & Sons v. Goodall, L. R. (1891) 1 Ch. D. 35-41; holding a water-mark to be a "brand" within the meaning of sec. 64, subsec. 2 (c) of the Patents, Designs and Trademarks Act, 1883.

20—Lowell Mfg. Co. v. Larned, Cox, Manual, No. 428; Fed. Case No. 8570.

21—Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494, 30 N. E. Rep. 339. *St. Louis Piano Mfg. Co. v. Merkel*, 1 Mo. App. 305.

22—66 Cal. 78. This decision led to the enactment of the present section 3199 of the Political Code of California (March 12, 1885), providing that "Any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner."

23—The recording of a name as a trademark cannot give it the quality of a trademark, if it was not theretofore a valid trademark. *Oakes v. St. Louis Candy Co.*, 146 Mo. 391; 48 S. W. Rep. 467.

"The general rule adopted by the courts on this subject is that state

Section 1 of the act of 1905 provides that owners of trademarks used in commerce may obtain registration of such trademarks by complying with the requirements stipulated in the act. The applicant must show that he, and no one else, has a right to use the mark; that he is actually using it in commerce with foreign nations or among the several states, or with Indian tribes; and that it is not so similar to the registered or known mark of another as to be calculated to deceive.²⁴ So that registration under the act of congress is in no sense a means of acquiring the right to a trademark;²⁵ and indeed the actual application of the trademark in commerce is so essential a prerequisite to registration under the act, that as between two applicants for registration of the same mark, one of whom had in fact used his mark in trade, while the other had the assignment of the mark, acquired by transfer from its inventor, but had never actually applied it, the commissioner of patents held that

statutes providing for registration of trademarks are in affirmance of the common law; that the remedies given by such statutes are either declaratory or cumulative and additional to those recognized and applied by the common law." *Per curiam*, in *Woodcock v. Guy*, 33 Wash. 234, 74 Pac. Rep. 358. "As the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trademark, and its registration as such could not in itself give it validity." Mr. Chief Justice Fuller in *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118.

24—*Ex parte Lyon*, Dupuy & Co., 28 Off. Gaz. 191.

25—"Property in trademarks does not derive its existence from an act of congress." *La Croix v. May*, 15 Fed. Rep. 236.

"Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark, or in cases where it is necessary to give jurisdiction to the United States courts." Hawley, J., in *Hennessy v. Braunschweiger & Co.*, 89 Fed. Rep. 665-668; quoted and followed in *Sleepy Eye Milling Co. v. C. F. Blanke Tea and Coffee Co.*, 85 Off. Gaz. 1905. It does not create a trademark. *United States v. Braun*, 39 Fed. Rep. 775; *Sarrazin v. W. R. Irby Cigar Co.*, 93 Fed. Rep. 624-627, 35 C. C. A. 496; *Brower v. Boulton*, 53 Fed. Rep. 389, 390; *Brower v. Boulton* (2), 58 Fed. Rep. 888-890, 7 C. C. A. 567; *Einstein v. Sawhill*, 65 Off. Gaz. 1918; *Sherwood v. Horton*, Cato & Co., 84 Off.

the actual prior use determined the right to the mark.²⁶ But registration under the laws of the United States and under the laws of several of the states, while creating no new rights, confers remedies and special protection to the owner of a trademark which we will examine in another chapter.

§ 28. Acquisition by assignment.—The assignment of trademarks is a subject of some difficulty and is discussed elsewhere in this book. It is sufficient in this connection to say that trademark rights are generally assignable, that quality being indispensable to the striking characteristic of perpetual existence possessed by trademarks, and that a proper assignment conveys to the assignee all the property rights in and to the trademark possessed by his assignor.²⁷ The Act of 1905, Sec. 10 provides that a registered trademark and trademarks for the registration of which application has been made, shall be assignable in connection with the good-will of the business in which it is employed; and any assignment of such mark shall be void as against a subsequent purchaser for value without notice unless recorded in the Patent Office within three months from its date. We need note at this time only the general restriction on the assignability of trademarks—that they cannot be assigned save in connection with the good-will of the business with which they are identified.²⁸

It is true of trademarks as of other personal property that the great mark of ownership is possession, and contracts that the title to personalty shall be in one party and the possession in another cannot be set up to the prejudice of a bona fide purchaser without notice. Accordingly, a contract that the right to use the mark shall revert to the assignor should the assignee sell his business, cannot

Gaz. 2018; *La Croix v. May*, 15
Fed. Rep. 236.

27—*Walton v. Crowley*, 3 Blatch.
440; *Cox*, 166, Fed. Case No. 17,133.

26—*Schrauder v. Beresford &*
Co., *Browne, Trademarks*, 661.

28—*Field, J.*, in *Kidd v. Johnson*,
100 U. S. 617-620.

avail as against a bona fide purchaser from the assignee, buying without notice.²⁹

§ 29. **Acquisition by an alien.**—In 1844 Chancellor Walworth announced that 'in the interposition of equity for the protection of trademark rights "there is no difference between citizens and aliens."'³⁰ This is also the rule in England,³¹ Scotland,³² Canada,³³ and India.³⁴ But it has been held that a foreigner has no common-law right to a trademark in the United States as against a citizen who has adopted a similar mark, in good faith, before the alien has sold any goods in this country.³⁵

§ 30. **Priority of appropriation.**—In order to acquire a trademark, its claimant must be its first appropriator, as we have seen; for, as said by Finletter, J., "in no other way can a mark or device indicate 'true origin or ownership.'"³⁶ Indeed, Bouvier has defined the right of trademark in these terms: "The right of trademark is said to be best termed an exclusive right arising from first use;"³⁷ and it has been said by the United States

29—Oakes v. Tonsmierre, 49 Fed. Rep. 447-452.

30—Taylor v. Carpenter (3), 11 Paige Ch., 292-296; 3 Story, 458; 2 Wood. & M. 1; Cox, 45. This is the general rule in the United States. La Croix v. May, 15 Fed. Rep. 236; Lemoine v. Gauton, 2 E. D. Smith, 343; Cox, 142; Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Coffeen v. Brunton, 4 McLean, 516; Cox, 82; and under a criminal act against counterfeiting trademarks, a conviction was sustained by the Missouri supreme court where the defendant counterfeited the mark of an English manufacturer. State v. Gibbs, 56 Mo. 133.

31—Collins v. Cowen, 3 K. & J. 428; Collins Co. v. Brown, 3 K. &

J. 423; Collins Co. v. Walker, 7 W. R. 222; Collins Co. v. Reeves, 28 L. J. Ch. 56; Howe v. McKernan, 30 Beav. 547.

32—Singer Mfg. Co. v. Kimball & Morton, Ct. Sess. Cas. (3d ser.) XI. 267.

33—Davis v. Kennedy, 13 Grant, Up. Can. Ch. 523. Pabst Brewing Co. v. Ekers, Rap. Jud. Que. 21 C. S. 545.

34—Orr-Ewing v. Chooneeloll Mullick, Cor. 150; Orr-Ewing v. Grant, Smith & Co., 2 Hyde, 185.

35—Richter v. Anchor Remedy Co., 52 Fed. Rep. 455.

36—Sheppard v. Stuart, 13 Phil. 117; Price & Steuart, 193-200.

37—Bouvier, Dict., title "Trademarks."

supreme court that "The exclusive right to the use of a mark or device claimed as a trademark is founded on priority of appropriation; that is to say, the claimant of a trademark must have been the first to use or employ the same on like articles of production."³⁸ There must necessarily be such a use as qualifies the mark as an indication of the origin and ownership of the goods to which it is applied. If the same mark had been in prior use by another at the same place or another locality near enough to start a similar right, the second user could have no trademark right to it.³⁹ "In order that the claimant of the trademark may primarily acquire the right of property in it, it must have been originally adopted and used by him—that is, the assumed name or designation must not be one that was then in actual use by others; and such adoption and use confer upon him the right of property in the trademark."⁴⁰ A trademark having no necessary relation to invention or discovery,⁴¹ it is the party who first actually uses a mark, and not the one who first thought of it or designed it, that is entitled to protection in its use as a trademark.⁴² A mere declaration of intention to use a certain mark in the future does not create a right to its use as a trademark, for such right can only originate with the actual

38—Columbia Mill Co. v. Alcorn, 150 U. S. 460. See also Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721.

39—Tetlow v. Tappan, 85 Fed. Rep. 774; Hyman v. Solis Cigar Co., 4 Colo. App. 475.

40—Derringer v. Plate, 29 Cal. 292; Cox, 324.

41—Trademark Cases, 100 U. S. 82.

42—George v. Smith, 52 Fed. Rep. 830; Trisdorfer & Co. v. Es-

tate or Bassett, 60 MSS. D. Sept. 1896.

"The right to a trademark does not depend upon originality, even as against the originator of the characteristic use." Holmes, C. J., in Burt v. Tucker, 178 Mass. 493; 59 N. E. Rep. 1111; Citing Monson v. Boehm, L. R. 26 Ch. D. 398, 407, 408; Levy v. Waitt (2), 10 C. C. A. 227, 61 Fed. Rep. 1008, 25 L. R. A. 190; Julian v. Hoosier Drill Co., 78 Ind. 408, 412.

use of the mark in commerce.⁴³ And it has been held in England, by Lord Justice Cairns, that there can be no right of trademark until the goods bearing the mark are actually upon the market, and that it cannot be protected before that time, even though the goods to which it is to be applied are in the course of manufacture, and the claimants of the mark have made expenditures in advertising it.⁴⁴ The right to the mark must relate back to its first use. One cannot unlawfully appropriate a trademark belonging to another, and subsequently acquire a good title thereto by the abandonment thereof by the first proprietor.⁴⁵ But a mark once abandoned is open to appropriation by another who adopts it subsequently in good faith.⁴⁶

As a matter of practice, inasmuch as the plaintiff must show title in order to make a case, evidence of the fact that he or his predecessor in title was the first to appropriate the mark to the class of goods for which he claims it as a trademark, is usually a part of the *prima facie* case. In a New York case, it was shown in defense that prior to the date when plaintiff first labeled cigars with the label in controversy, certain label manufacturers had sold the same label to other persons in the trade. Injunction was denied upon the ground that such evidence negated plaintiff's claim of exclusive title.⁴⁷

It is now well established that priority of adoption alone does not necessarily determine the ownership of the mark. The use of the mark by one claimant may be "so transitory, spasmodic, and inconsiderable," as not to vest title in the user as against one whose use has been

43—Schneider v. Williams, 44 N. J. Eq. 391; 14 Atl. Rep. 812; 44 Off. Gaz. 1400.

44—Maxwell v. Hogg, L. R. 2 Ch. 307; 36 L. J. Ch. 433; 16 L. T. N. S. 130; Seb. 264.

45—O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576-578.

46—Brower v. Boulton, 53 Fed. Rep. 389.

47—Wagner v. Daly, 97 Hun 477, 22 N. Y. Supp. 493.

“long continued, and universally recognized.”⁴⁸ As Judge Elmer B. Adams has stated it, “The right to a trademark at common law, independent of the registration statute, is not created by invention or priority of adoption alone. A word, symbol, or device, to be a valid trademark constituting a right of property, must have been used by the owner in connection with the sale of his goods for such length of time, and under such circumstances, as indicates to the trade that the goods in connection with which it appears are his goods, as distinguished from those of other manufacturers or dealers. The mere adoption of such word, symbol, or device, unaccompanied by such a use, is not sufficient to create an exclusive right thereto.”⁴⁹

48—Heublein v. Adams, 125 Fed. Rep. 782, 785. To the same effect see Tetlow v. Tappan, 85 Fed. Rep. 774, 775;

49—Macmahan Pharmacal Co. v. Levy v. Waitt, 10 C. C. A. 227, 61 Denver Chemical Mfg. Co. 113 Fed. Rep. 1008, 25 L. R. A. 190. Fed. Rep. 468-476; 51 C. C. A. 302.

CHAPTER III.

WHAT CONSTITUTES A VALID TRADEMARK.

§ 31. **The general rule.**—Having seen in the preceding chapters something of the general requisites of a valid trademark, we now approach the subject of the more exact tests to be applied in determining its validity. It is the general rule that a mark must be truthful and unobjectionable on the ground of being a generic term.¹

§ 32. **It must be truthful.**—This rule is apparently simple, yet it has given rise to much discussion and some apparent conflicts in the decisions. Honest competition is the requirement of the chancellor, and he is just as ready to dismiss the bill of a complainant whose trademark is calculated to deceive the public into a belief that his goods are something other than they actually are, as he is to enjoin the defendants where he has infringed an honest trademark. The modern law of unfair trade is a perfect superstructure of ethical principles, founded upon the basis of all ethics—honesty. In no class of cases is the rule that he who comes into a court of equity must do so with clean hands more rigidly applied.² It is not material whether the words or symbols used as trademark contain the deceptive or untruthful statement. Indeed the dishonest matter is usually foreign to the mark itself, and contained in other matter used in advertising or describing the goods sold under the mark.

1—Prince Mfg. Co. v. Prince's Metallic Paint Co. (2), 135 N. Y. Fed. Rep. 872-876.
24, 31 N. E. Rep. 990.

§ 33. **A dishonest label will invalidate.**—We find that where a distiller mixed nearly thirty-six per cent. of other whiskies with his own brand, and sold the blend under a label formerly used upon whisky of his own distillation, with cautions to avoid imitations and asserting that the mixture was “bottled at the distillery warehouse and is warranted perfectly pure and unadulterated,” an injunction was refused because of this misrepresentation. This decision, whose tendency is more far-reaching than that of *Manhattan Medicine Co. v. Wood*,³ seems on the reading of the facts to impose a hardship on the owners of the mark, Jas. E. Pepper & Co. The interest of the complainant was derived under a contract with that firm giving him the entire control of their trade in bottled whisky. The proof showed that up to and including the year 1891 the Pepper Company bottled nothing under the gold trade label partially described above used by them but “Old Pepper” whisky distilled by them, but that after November, 1891, the demand for the distillery bottling became so great that they could not supply it with the output of their own distillery and therefore bought other whiskies shown to be more expensive, older and made by the same formula as their own, and blended these whiskies with their own, and bottled the resulting blend under the same label and trademark. Here, if ever, one would think equity would relax its rule, and, as the public had not suffered by the complainant’s acts, would continue to protect the trademark. But the learned court thus tersely applies the principles: “Pepper offers as an excuse for bottling a mixture that the demand for his goods had so increased that he could not supply it with Pepper whisky. What was this demand for? Plainly for pure and unadulterated Pepper whisky, bottled at the distillery. If this could not be honestly supplied, then it could not be supplied at all in such a way as to keep the

business within the protection of a court of equity. Relief is refused to Pepper and his privies because of his misrepresentations to the public."⁴ Thus is emphasized the statement of Mr. Justice Field that the protection of equity is extended to the owner of a trademark "not only as a matter of justice to him, but to prevent imposition upon the public."⁵ There are a number of cases in which the misrepresentation has been held to be so slight and immaterial as not to disentitle the complainant to relief.⁶ Thus, a claim by the manufacturer of a patent medicine that it permanently overcomes habitual constipation, will not, even if untrue, disentitle the plaintiff from relief in equity, the court taking judicial notice of the fact that the effect of any medicine for constipation is largely dependent upon the constitution and habits of the person treated.⁷

The use of the words "Sole Manufacturer" by a dealer who does not manufacture, but has the article produced for him by another, has been held not to debar the user of the trademark from equitable relief,⁸ as has the addition of the word "distillers" to the firm name of former proprietors of a distillery owned by a complainant.⁹

§ 34. The cases of false representation in connection with trademarks.—In 1837 the English High Court of Chancery in *Pidding v. How*, announced that it could not

4—*Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 584-596. An English case resembling this as to the facts is *Starey v. Chilworth Gunpowder Co.*, L. R. 24 Q. B. D. 90.

Relief will be denied in such cases although the article is actually as good as it is represented to be. *Prince Mfg. Co. v. Prince's Metallic Paint Co.* (2), 135 N. Y. 24, 31 N. E. Rep. 990.

5—*Manhattan Medicine Co. v. Wood*, 108 U. S. 218-223; citing

Amoskeag Manufacturing Co. v. Trainor, 101 U. S. 51.

6—*Tarrant & Co. v. Hoff*, 71 Fed. Rep. 163; affirmed, 76 Fed. Rep. 959, 22 C. C. A. 644; *Centaur Co. v. Robinson*, 91 Fed. Rep. 889; *Ransom v. Ball*, 7 N. Y. Supp. 238.

7—*California Fig Syrup Co. v. Worden*, 95 Fed. Rep. 132-134.

8—*Gluckman v. Strauch*, 91 N. Y. Supp. 223.

9—*Frazier v. Dowling*, 18 Ky. L. Rep. 1109, 39 S. W. Rep. 45.

interfere in behalf of a plaintiff who had "thought fit to mix up that which may be true with that which is false" in his labels and advertisements.¹⁰ The Court of Appeals of New York in a similar case in 1848, by Gardiner, J., observed laconically, "The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce; and at all events, if the maxim that he who asks equity must come with pure hands is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly."¹¹ Prior to this, an injunction was refused where the mark in question was applied by the complainant to a "quack" medicine.¹² "Balm of Thousand Flowers," the name of a cosmetic, being deceptive, its infringement by a defendant assuming the name "Balm of Ten Thousand Flowers" was not enjoined,¹³ although the same mark was held valid and the rule announced that "the public should be left to its own guardianship" in *Fetridge v. Merchandant*.¹⁴ But the doctrine generally is that of *Pidding v. How*.¹⁵

10—*Pidding v. How*, 8 Sim. 477; 212; 36 How. Pr. 33; Cox, 434; Cox, 640; followed in *Perry v. Palmer v. Harris*, 60 Pa. St. 156; Truefit, 6 Beav. 66; Cox, 644. 8 Am. L. Reg. N. S. 137; Cox,

11—*Partridge v. Menck*, 2 Sandf. 523; *Dixon Crucible Co. v. Guggenheim*, 3 Am. Law T. 228; 2 Ch. R. 622; 2 Barb. Ch. R. 101; 1 Brewster, 321; Cox, 559; *Leather How. App. Cas. 558; Cox, 72.* Cloth Co. v. American Leather

12—*Towle v. Spear*, 7 Penn. L. Cloth Co., 11 Jur. N. S. 513; Cox, J. 176; Cox, 67; followed in *Heath 688; 11 H. L. C. 543; Flavel v. v. Wright*, 3 Wall. Jr., 1; Cox, 154. Harrison, 10 Hare, 467; *Morgan v.*

13—*Fetridge v. Wells*, 4 Abb. McAdam, 36 L. J. Ch. 228; *Ford Pr. 144; 13 How. Pr. 385; Cox, 180.* v. Foster, L. R. 7 Ch. D. 611; 41

14—4 Abb. Pr. 156; Cox, 194.

15—*Supra*, 8 Sim. 477; Cox, 640. L. J. Ch. 682; *Re Saunion & Co., Cox, Manual, No. 625; Estcourt v. The Estcourt Hop Essence Co.*, 31 The rule is conceded, announced or followed in *Hobbs v. Francais*, 19 How. Pr. 567; Cox, 287; *Phalon L. T. N. S. 567; L. R. 10 Ch. D. v. Wright*, 5 Phila. 464; Cox, 307; 276; 44 L. J. Ch. 223; 32 L. T. N. *Smith v. Woodruff*, 48 Barb. 438; S. 80; 23 W. R. 213; *Joseph v. Cox, 373; Curtis v. Bryan*, 2 Daly, Macowsky, 96 Cal. 518; *Meriden*

The general rule concerning the effect of false representations by the plaintiff in the use of the mark upon his right to relief in equity, has been comprehensively stated by Mr. Justice Shiras, as follows: "When the owner of a trademark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trademark, or in his advertisements and business, be himself guilty of any false or misleading representation; that if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses his right to claim the assistance of a court of equity; that where any symbol or label claimed as a trademark is so constructed or worded as to make or contain a distinct assertion which is false, no property can be claimed in it, or, in other words, the right to the exclusive use of it cannot be maintained."¹⁶

For the reasons we have been considering in this chapter, the patent office has refused to admit to registration as a trademark for powdered soap "the picture of a bag

- Britannia Co. v. Parker, 39 Conn. 454-460; Laird v. Wilder, 2 Bush (Ky.), 131; 15 Am. Rep. 707; Connell v. Reed, 128 Mass. 477; 35 Am. Rep. 299; Wolfe v. Burke, 7 N. Y. Sup. Ct. 151; 56 N. Y. 115; 2 Off. Gaz. 441; Seabury v. Grosvenor, Fed. Case No. 12576; 14 Off. Gaz. 679; Hennessy v. Wheeler, 69 N. Y. 271; Piso Co. v. Voight, 4 Ohio N. P. 347; California Syrup of Figs Co. v. Stearns (1), 67 Fed. Rep. 1008; Wood v. Butler, 3 R. P. C. 81; L. R. 32 Ch. D. 247; 55 L. J. Ch. 377; 54 L. T. 314; Cartmell, 349; Re Heaton's Trade-mark, L. R. 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. 220; 32 W. R. 951; Cartmell, 160; Newman v. Pinto, 4 R. P. C. 508; 57 L. T. 31; Cartmell, 242; Kenny v. Gillet, 70 Md. 574; Siegert v. Abbott (1), 61 Md. 276; Parlett v. Guggenheimer, 67 Md. 542; Palmer v. Harris, 60 Pa. St. 156; Hoxie v. Cheney, 143 Mass. 592; 10 N. E. Rep. 713; Clotworthy v. Schepp, 42 Fed. Rep. 62; California Syrup of Figs Co. v. Stearns (2), 73 Fed. Rep. 812; Buckland v. Rice, 40 Ohio St. 526; Burton v. Stratton, 12 Fed. Rep. 696-699; Ginter v. Kinney Tobacco Co., 12 Fed. Rep. 782.
- 16—Clinton E. Worden & Co. v. California Fig Syrup Co., 187 U. S. 516, 528; 47 L. ed. 282, 288. To the same effect see Uri v. Hirsch, 123 Fed. Rep. 568; Millbræ Co. v. Taylor, (Cal.), 37 Pac. Rep. 235, 25 L. R. A. 193.

having the open end thereof closed by a tie," the commissioner holding that such a mark was necessarily deceptive or descriptive, and in either event was not a valid trademark.¹⁷

§ 35. **Manhattan Medicine Co. v. Wood.**—This decision, the language of whose opinion has been more often cited in support of the proposition under consideration than any other, was based on this statement of facts. The complainant derived all its trade rights in and to a proprietary medicine styled "Atwood's Genuine Physical Jaundice Bitters" from its original manufacturer, Moses Atwood, who lived at Georgetown, Massachusetts, and manufactured it there. The court says: "It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company, in the city of New York."¹⁸ On these facts the protection of their mark was refused complainants.

§ 36. **The similar cases—Assignment must be made public in conjunction with the trademark, when.**—Following *Manhattan Medicine Co. v. Wood*, the Court of Appeals of Maryland held¹⁹ where the label used by the manufacturers of Angostura Bitters did not disclose the death of Dr. J. G. B. Siegert, their originator, that the label was not truthful and its infringement would not be enjoined. And the same rule has been applied as against one continuing to use the name of a predecessor in business, whose label does not announce the change.²⁰ The rule in this regard is held by McKenna,

17—*Ex parte* Martin, 89 Off. Gaz. 2259. "A word to be used as a trademark must obviously be meaningless as applied to the goods, so as to be neither descriptive nor deceptive." Duell, Commissioner, in *Ex parte* Pearson Tobacco Co., 85 Off. Gaz. 287.

18—*Manhattan Medicine Co. v. Wood*, 108 U. S. 218.

19—*Seigert v. Abbott* (1), 61 Md. 276. The same doctrine is followed in *Sherwood v. Andrews*, 5 Am. L. Reg. N. S. 588; Seb. 263; *Stachelberg v. Ponce*, 23 Fed. Rep. 430; Price & Steuart, 967.

20—*Helmbold v. H. T. Helmbold Mfg. Co.*, 53 How. Pr. 453.

J., to be that where a trademark is a mark of special qualities, due to superior material, processes, skill and care exercised by the originator thereof, an assignee of the business who continues to use labels which contain the false statement that the goods are being prepared by the originator is not entitled to equitable relief against an infringer.²¹

§ 37. **Unauthorized use of words "patent" or "patented."**—The use of the words "patent" or "patented," in connection with or as part of a trademark, where the article identified by the mark is in fact not covered by letters patent, has given rise to many interesting decisions. All of these matters of untruthful representation are to be tested by the question of whether or not they are direct, or "purely collateral" misrepresentations.²² Where the letters patent of the United States covering an alleged improvement in jars had been declared invalid by judicial decision, but the manufacturer continued to designate the jars "Mason's Patent" jars, it was held that the fact deprived the manufacturer of equitable relief against an infringement.²³ In England

21—*Alaska Packers' Association v. Alaska Imp. Co.*, 60 Fed. Rep. 103. The supreme court of Pennsylvania has held the contrary, saying that an assignee is entitled to relief, even though he has not designated himself as assignee in making use of the mark. *Fulton v. Sellers*, 4 Brewst. 42. The tendency of the later rulings is to uphold the use of the mark by the assignee, except where his failure to disclose the fact of the assignment is equivalent to misrepresentation and falsehood. See *Pillsbury v. Flour-mills Co.*, 64 Fed. Rep. 841-850, 12 C. C. A. 432.

22—*Ford v. Foster*, L. R. 7 Ch. D. 611; 27 L. T. N. S. 220; 20 W.

R. 311; *Cox, Manual*, 384. In this case the false use of the word "patentee," used by the complainant in advertisements, was held to be a collateral misrepresentation which did not disentitle him to a remedy in equity against an infringer.

23—*Consolidated Fruit Jar Co. v. Dorflinger*, Fed. Case No. 3129; 6 Fed. Cas. 339; 2 Am. Law T. Rep. N. S. 511; *Cox, Manual*, 444. The same rule is announced in England in *Leather Cloth Co. v. Lorsche*, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. N. S. 661; 18 W. R. 572; *Cox, Manual*, Case No. 324; *Nixey v. Roffey*, W. N. 1870, p. 227; *Cox, Manual*, Case No. 343.

a plaintiff used on his label the words "Royal letters patent," and supported the use of the words by showing that for many years he had paid the stamp duty on "patent medicines," and was only using the labels remaining on hand at the time he discovered his medicines did not belong to that class. He was denied an injunction against an infringer of his label.²⁴

The reason for the particular disfavor with which equity regards this class of cases is that, by using words indicating that an article is patented where it is not, the owner of the mark is seeking to obtain the benefits of a monopoly, where he has none. As stated by Vice-Chancellor Wood, in *Morgan v. McAdam*:²⁵ "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiff under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorized to sell it; and further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of license or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation."

And although in another English case²⁶ a plaintiff was held entitled to recover in an action at law in a case of this kind, where his father had held a patent held to be invalid (as in *Consolidated Fruit Jar Co. v. Dorflinger*,

24—*Lamplough v. Balmer*, W. N. 467; 22 L. J. Ch. 866; 17 Jur. 368; 1867, p. 293. 1 W. R. 213; Cox, Manual, Case

25—26 L. J. Ch. 228; Cox, Manual, Case No. 267. Other arguments are used by the same judge in *Flavel v. Harrison*, 10 Hare,

No. 116. 26—*Sykes v. Sykes*, 3 B. & Cr. 541.

supra, where the contrary rule is announced), the rule is generally that, where no valid patent has ever existed, the use of words indicating the contrary will debar the plaintiff from relief in equity.²⁷

Mr. Justice Fuller has accurately defined the rule under consideration in the following language: "No right to a trademark which includes the word 'patent', and which describes the article as 'patented', can arise when there is and has been no patent; nor is the claim a valid one for the other words used, when it is based upon their use in connection with that word."²⁸

But where there has been a valid patent upon the subject-matter of the trademark, different issues arise.

In England it has been held that the fact that a plaintiff put a mark upon his goods with the addition of the words "trademark," when his mark was not registered, did not amount to such a misrepresentation as to deprive him of the right to an injunction, because the use of the words "trademark" did not necessarily carry with it the implication that the mark had been registered.²⁹

§ 38. Use of such word as a trademark where there has been a patent.—The last clause of Section 4901, Revised Statutes of the United States, declares that "every person who in any manner marks upon or affixes to any unpatented article the word 'patent', or any word importing that the same is patented, for the purpose of deceiving the public shall be liable for every such offence to a penalty of not less than \$100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to

27—*Leather Cloth Co. v. American Leather Cloth Co.*, 11 Jur. N. S. 513; Cox, 688; 11 H. L. C. 543; Cox, Manual, Case No. 223. See, per contra, *Stewart v. Smithson*, 1 Hilt. 119; Cox, 175. This case cannot be regarded as of authority.

28—*Holzappel's Compositions Co.*

v. Rahtjen's American Composition Co., 183 U. S. 1, 8, 46 L. ed. 49; reversing *Rahtjen's Composition Co. v. Holzappel's Composition Co.*, 41 C. C. A. 329, 101 Fed. Rep. 257.

29—*Sen Sen Co. v. Britten*, L. R. (1899) 1 Ch. D. 692.

be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed." It is not an offense under this law to affix to an article the word "patented" and the date of an expired patent, for the reason that the offense is not complete unless the mark affixed indicates that there is a present subsisting patent upon the article.³⁰

In *Cheavin v. Walker*,³¹ Jessel, M. R., observes with regard to the effect of the use of the word "patent" by the plaintiff: "The question was fully discussed in the case in the House of Lords, *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 543,³² and I have nothing to add to what was there said. No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that which was a patent, but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trademark. Protection only extends to the time allowed by the statute for the patent, and if the court were afterwards to protect the use of the word as a trademark, it would be in fact extending the time for protection given by the statute. It is therefore impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trademark."

"But, further, no man can claim a trademark in a falsehood. It is a falsehood to represent that the patent is still subsisting."

And Kekewich, J., said in *Re Adams' Trade-*

30—*Wilson v. Singer Mfg. Co.*, 92; Seb. 528. See also *Nixey v. Roffey*, W. N. 1870, p. 227; Seb.

31—L. R. 5 Ch. D. 850; 46 L. J. 343.

Ch. 686; 36 L. T. 938; Cartmell, 32—*Ante*, § 37.

marks:³³ “The word ‘patent’ means not necessarily that there is now current a patent of protection, but that the article in question is one of those articles which had the merits of utility and novelty, and therefore received the protection of the crown by letters patent.”

There are other decisions, however, not so clear as to facts, and apparently not in harmony with *Cheavin v. Walker, supra*. Five years after that case, Bacon, V. C., in a case where the plaintiffs had stamped the word “patent” on plowshares manufactured by them after their patent had expired, said “(they) make their shares according to the invention in the expired patent, as everybody else may; but to suggest that they have in any manner claimed anything under or in respect to that patent, and that they have done this fraudulently and to deceive the public, is merely desperate, and opposed to the truth of the case.”³⁴ Yet it does not appear in the report wherein this differed from the use of the word “patent” as criticized in *Cheavin v. Walker*. In another case³⁵ Vice-Chancellor Wood said: “It does not follow, because upon the expiration of the patent the article and its known description become known to all, that therefore all would become entitled to use the label by which the patentees had been accustomed to distinguish their goods.” This he held in regard to a label used on packages of pins marked “Taylor & Co.’s Patent Solid-headed Pins;” the manufacturer continuing to use the label after the expiration of his patent. The conclusion of the learned Vice-Chancellor was that “The public may have

33—9 R. P. C. 174; 66 L. T. 610; patent have ever issued, but the Cartmell, 43. exclusive right of manufacture of

34—Ransome v. Graham, 51 L. baskets has been secured by registration of their design. Cave v. J. Ch. 897; 47 L. T. 218; Cartmell, 279. Same rule in Stewart v. Myers, Seton (5th ed.), 539; Cox, Smithson, 1 Hilt. 119; Cox, 175; Manual, Case No. 304.

35—Edelsten v. Vick, 11 Hare, Leather Cloth Co. v. Hirschfeld, 1 78; 1 Eq. Rep. 413; 18 Jur. 7; Cox, N. R. 551; Cox, Manual, Case No. 214. And even where no letters Manual, Case No. 119.

acquired confidence in that particular label, and that confidence may have given a value to it which the patentees may be entitled to have after the expiration of their patent."

In another case it was held that where plaintiffs labeled their thread "Patent Thread," they would not be denied relief against an infringer, because the word "patent" by long usage had come to denote the character of the thread, and did not imply the existence of any patent.³⁶

Of course the holder of letters patent may describe himself as "patentee" and his goods as "patented" even where he doubts the validity of the patent, and its validity has been questioned by others.³⁷ And it has been held in New York that one who applies for letters patent is not disentitled from relief against an infringer by reason of his describing the goods as "patented" after his application had been filed, but before the issuance of letters patent.³⁸ Where the plaintiffs used their label bearing the words "specially registered trademark" after application, but before registration, the English Court of Appeals granted an interlocutory injunction against an infringer, but expressly said in their opinion that they refrained from finally deciding the question whether that misrepresentation *prima facie* destroyed plaintiff's right to protection.³⁹

It will be seen, therefore, that the cases discussed in this and the next preceding section are for the greater part English, and their reasoning is rather confused. The surest conclusion to be reached by an examination of the cases in this section is that of Lord Kingsdown, in *Morgan v. McAdam*:⁴⁰ "Of course it would be better,

36—Marshall v. Ross, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086; Cox, Manual, Case No. 316.

37—Blakey v. Latham, 85 L. T. (Journal), 47.

38—Lauferly v. Wheeler, 16 How. Pr. 488; 11 Daly, 194.

39—Read v. Richardson, 45 L. T. 54; Cartmell, 281.

40—36 L. J. Ch. 228; Cox, Manual, No. 267.

and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty, upon the articles which they designate as patented." Judge Kohlsaat, in denying a motion for preliminary injunction, based his decision upon the fact that the complainant, though not marking the article itself "patented," had issued circulars stating that it was patented, after the patent had expired.⁴¹

One who issues circulars or uses markings on merchandise falsely indicating the goods dealt in by him to have been made under a particular patent will be enjoined at the instance of the owner of the patent.⁴² Where there has been a patent, he who has manufactured a trademarked article under the patent during its lifetime, although he has lost the exclusive right to the use of the trademark upon the expiration of the patent, may yet enjoin one from using the mark upon an article not made according to the expired patent.⁴³ Where the complainant had falsely advertised that the method of applying its name to silk dealt in by it was patented, a preliminary injunction against an infringer was refused because of the misrepresentation.⁴⁴

§ 39. Names of patented articles.—The general rule as to the name applied to a patented article during the life of the patent, is that upon the expiration of the patent, the public acquires the right to make, use, and sell the patented article, and to distinguish it by the name which it bore during the life of the patent.⁴⁵

41—Preservaline Mfg. Co. v. Heller Chemical Co., 118 Fed. Rep. 103.

42—Washburn & Moen Mfg. Co. v. Haish, Fed. Case No. 17217.

43—Singer Mfg. Co. v. Hipple, 109 Fed. Rep. 152.

44—Stirling Silk Mfg. Co. v.

Sterling Silk Co., (N. J. Ch.), 46 Atl. Rep. 199.

45—Fairbanks v. Jacobus, Fed. Case No. 4608, 14 Blatchf. 337; Singer Mfg. Co. v. Stanage, 6 Fed. Rep. 279; Adey v. Peck Bros. & Co., 37 Fed. Rep. 209; Singer Mfg. Co. v. June, 163 U. S. 169;

In the leading case upon this subject, Mr. Justice White, speaking for the United States Supreme Court, explained the reason of the rule as follows: "It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss without further comment the complaint, as to the form in which the defendant made his machines. It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly, in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the

Wilcox & Gibbs S. M. Co. v. The Gibbens Frame, 17 Fed. Rep. 623; Singer Mfg. Co. v. Bent, 163 U. S. 205; Centaur Co. v. Killenberger, 87 Fed. Rep. 725; Singer Mfg. Co. v. Larsen, 8 Biss. 151, Fed. Case No. 12902; Burton v. Stratton, 12 Fed. Rep. 696-700; Good-year Rubber Co. v. Day, 22 Fed. Rep. 44; Singer Mfg. Co. v. Riley, 11 Fed. Rep. 706; Wheeler & Wilson Mfg. Co. v. Shakespear, 39 L. J. Ch. 36; Tucker Mfg. Co. v. Boyington, Fed. Cas. No. 14229; 9 Off. Gaz. 455; Filley v. Child, 16 Blatchf. 376; Fed. Case No. 4787; Ralph v. Taylor, L. R. 25 Ch. D. 194; Linoleum Mfg. Co. v. Nairn, 7 Ch. D. 834; Young v. Macrae, 9 Jur. N. S. 322; Re Palmer's Trademark, 24 Ch. D. 504; Re Leonard

& Ellis' Trademark, 26 Ch. D. 288; Singer Mfg. Co. v. June, 41 Fed. Rep. 208; Brill v. Singer Mfg. Co., 41 Ohio St. 127; 52 Am. Rep. 74; Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Centaur Co. v. Heinsfurter, 84 Fed. Rep. 955; 28 C. C. A. 581; Lorillard v. Pride, 28 Fed. Rep. 434; Gally v. Colt's Patent Fire Arms Mfg. Co., 30 Fed. Rep. 118; Dover Stamping Co. v. Fellows, 163 Mass. 191; 47 Am. St. Rep. 448; Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 91 Fed. Rep. 891; Centaur Co. v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901; Centaur Co. v. Marshall, 97 Fed. Rep. 785.

benefits of the monopoly, or expressly, by his having so connected the name with the machine as to lend countenance to the resulting dedication. To say otherwise would be to hold that, although the public had acquired the device held by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which has become theirs by the disappearance of the monopoly. In other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that at its termination the monopoly should cease, and yet when the end was reached disregard the public dedication and practically perpetuate indefinitely an exclusive right.

“The public having the right on the expiration of the patent to make the patented article and to use its generic name, to restrict this use, either by preventing its being placed upon the articles when manufactured, or by using it in advertisements or circulars, would be to admit the right and at the same time destroy it. It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent.

“Nor is this right governed by different principles where the name, which has become generic, instead of being an arbitrary one, is the surname of the patentee or original manufacturer.”⁴⁶

There appears to be an exception to this general rule where the use of the name antedates the existence of the patent, and where it further appears that the name and not the patent gave its value to the article.⁴⁷

In accordance with the general rule, the patent office has declined to register a trademark which is the name

46—*Singer Mfg. Co. v. June Mfg. Co.* 163 U. S. 169, 185; 41 L. ed. 118, 124. 47—*Batcheller v. Thomson*, 35 C. C. A. 532, 93 Fed. Rep. 660, 665.

of a patented article,⁴⁸ even in association with an arbitrary symbol.⁴⁹

It is by no means clear what trademarks applied to patented articles, other than mere names or words descriptive of the thing patented, will become *publici juris* upon the expiration of the patent. Thus the Supreme Court of Massachusetts has held that where a special word, device or symbol is added to the general descriptive name of the article of the patent, it is possible that the trademark right may exist in the combination of the word and the device or symbol, notwithstanding the expiration of the patent.⁵⁰

In this connection, Lindley, L. J., says "I do not mean to say that a manufacturer of a patented article cannot have a trademark not descriptive of the patented article, so as to be entitled to the exclusive use of that mark after the patent has expired, for instance, if he impressed upon the patented articles a griffin or some other device; but, if his only trademark is a word or set of words descriptive of the patented article of which he is the only maker, it appears to me to be impossible for him ever to make out, as a matter of fact, that this mark denotes him as the maker, as distinguished from other makers."⁵¹

In every case of the kind under consideration, however, others will be enjoined from using the mark in such a way as to deceive the public into the false belief that they are getting the goods of the original owner of the mark.⁵²

Thus in the leading case, the court found that the Singer Sewing Machine sold by the defendant after the expiration of the Singer patent, embodied features not a

48—Ex. p. Velvrl Co., Ltd. 84 Off. Gaz. 807.

49—Holophane Glass Co. 100 Off. Gaz. 450; Ex p. Farnum & Co. 13 Off. Gaz. 412.

50—Dover Stamping Co. v. Fellows, 163 Mass. 191, 47 Am. St. Rep. 448.

51—Re Palmer's Trademark, L. R. 24 Ch. D. 504-521.

52—Singer Mfg. Co. v. Charlebois, 16 Rap. Jud. Q. C. S. 167; Centaur Co. v. Link, 62 N. J. Eq. 147, 49 Atl. Rep. 828.

part of the patented article, and which had been used by the complainant to indicate itself as the manufacturer of the machine; and Mr. Justice White in reversing and remanding the case directed a decree of injunction in favor of the complainant, "perpetually enjoining the defendant, its agents, servants, and representatives, first, from using the word 'Singer' or any equivalent thereto, in advertisements in relation to sewing machines, without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished from the sewing machines made by the Singer Manufacturing Company, second, also perpetually enjoining the defendant from marking upon sewing machines or upon any plate or device connected therewith or attached thereto the word 'Singer,' or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and therefore not the product of the Singer Manufacturing Company.'"⁵³

It is manifest, however, that to create this right in the public, two conditions of facts are prerequisite; first, there must have been a patent, second, the patent must have expired.

Where the owner of the trademark had made an unsuccessful application for a patent upon the article to which the trademark was applied, Bradley, J., held that he had a valid subsisting right to the trademark upon the rejection of his application, and said "His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trademark."⁵⁴

In a case where the patent had not expired, Judge Vann, speaking for the Court of Appeals of New York, said: "Assuming that upon the expiration of the patent

53—Singer Mfg. Co. v. Bent, 163 U. S. 169, 204, 41 L. ed. 118, 131.

54—Sawyer v. Kellogg, 7 Fed. Rep. 720, 723.

any one may use the name, until that time arrives, why should the inventor be deprived of a right which, without question, would be his if he had not taken out a patent for his invention.”⁵⁵

Where a name indicating a patented article exists, an exclusive licensee for the sale of the patented articles under a license to which the defendant is not a party cannot enjoin him from conducting an unfair competition by means of the name; the licensor not being a party to the action, and no infringement of the patent being charged, and the defendant having the right to deal in the articles known by the name.⁵⁶ If the patent is reissued the trademark will be valid during the life of the reissued patent.⁵⁷

§ 40. Generic term, defined.—By “generic term” (Latin, *genus*, *gener*; French, *genre*) is meant a term which may not be appropriated as a trademark because it is too general and comprehensive in its meaning to become the monopoly of an individual in application to merchandise. The word in its proper signification includes the use of geographical names, proper names, and descriptive words, used in commerce. It is a matter of regret that the courts have not defined these several phrases in their relations to each other, but such is the fact. The correctness of the author’s definition is clearly established by analysis of the three classes of words and the reasons why they are not sustained as trademarks. We will examine them in their order.

(a) *Geographical names.*—Mr. Justice Strong has said “It must be considered as a sound doctrine that no one can apply the name of a district or country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others in-

⁵⁵—*Waterman v. Shipman*, 130 N. Y. 301, reversing s. c. 8 N. Y. Supp. 814. *versing Seaman v. Johnson*, 106 Fed. Rep. 915.

⁵⁷—*Hiram Holt Co. v. Wads-*

⁵⁶—*Johnson v. Seaman*, 108 Fed. Rep. 951, 48 C. C. A. 158; re-

habiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation.”⁵⁸ In our further examination of the use of geographical names in trade, we will find that they are never properly sustained as technical trademarks except where they are used by one who is the sole owner of the entire locality to which the name is applied. In such a case the geographical name has ceased to be generic, because one person has the sole and exclusive right of trade or manufacture in the locality. Thus the author reasons that geographical names are ordinarily generic, and whenever they are held not to be valid trademarks it is because they are generic.

(b) *Proper names.*—The eminent English barrister, Mr. Sebastian, has said in his work on trademarks that “a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate.”⁵⁹

(c) *Descriptive words* have always been understood to come within the category of generic terms; indeed, Mr. Browne in his treatise upon the subject has defined “generic names” to be “names merely descriptive of an article of trade, of its qualities, ingredients or characteristics.”⁶⁰ The United States supreme court has held that there can be no technical trademark right in words used to denote class, grade, style, quality, ingredients or characteristics.⁶¹

It is apparent, therefore, that the definition of generic terms which we have adopted is scientifically exact, including nothing more nor less than the words which are not subject to exclusive appropriation as trademark, be-

58—*Delaware & Hudson Canal Co. v. Clark*, 13 Wall. (80 U. S.) 311-327.

59—Sebastian on Trademarks (4th ed.), p. 23.

60—Browne on Trademarks (2d ed.), sec. 134.

61—*Canal Co. v. Clark*, 13 Wall. 311-322; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537-548.

cause they cannot be so appropriated "to the advancement of the business interests of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that, on account of their general or popular use, every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any person."⁶²

A generic or descriptive word cannot be made a valid trademark by misspelling it (as, for example, "Kid Nee Kure," applied to a medicine),⁶³ or by printing it in letters from the alphabet of a foreign language.⁶⁴

Thus the word "Roachsault," applied to a preparation for destroying roaches, has been held invalid as a trademark.⁶⁵

It must not be inferred, however, that words in common use cannot be appropriated as trademarks. They certainly can be so appropriated if used in a new and distinctive sense. If any other rule obtained, no words could be used as trademarks unless the person adopting them was their original and first inventor. There is no such legal requirement either as to words or devices.⁶⁶ "Words in common use may be adopted, if at the time of adoption they were not used to designate the same or similar articles of production."⁶⁷

It is obvious that the article to which the mark is applied must be considered in this connection. As Judge Wallace has put it, "whether a word claimed as a trademark is available because it is a fanciful or arbitrary name, or whether it is obnoxious to the objection of being descriptive, must depend upon the circumstances of each

62—Daniels, J., in *Newman v. Alvord*, 49 Barb. 588; Cox, 404.

63—*Ex parte Henderson*, 85 Off. Gaz. 453.

64—*Ex parte Stuhmer*, 86 Off. Gaz. 181.

65—*Barrett Chemical Co. v. Stern*, 176 N. Y. 27, 68 N. E. Rep.

66—reversing 76 N. Y. Supp. 1009.

66—*Osgood v. Allen*, 1 Holmes, 185, Fed. Case No. 10603.

67—*Osgood v. Allen*, *supra*.

case. The word which would be fanciful or arbitrary when applied to one article may be descriptive when applied to another. If it is so apt and legitimately significant of some quality of the article to which it is sought to be applied that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it cannot be the subject of a monopoly. On the other hand, if it is merely suggestive, or figurative only, it may be a good trademark, notwithstanding it is also indirectly or remotely descriptive.’⁶⁸

While the following is an extract from a judicial argument delivered by a court in a futile attempt to justify its decree sustaining as a trademark a geographical word to which the plaintiff had no color of exclusive right, it is still a lucid exposition of the principle under consideration: “Words and names having a known or established signification cannot within the limits of such specification be exclusively appropriated to the advancement of the business purposes of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that on account of their general or popular use every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any one person, firm or company. What alike may be claimed and used by all cannot be exclusively appropriated to advance the interests of any person. Numerous cases have been before the courts in which this limitation upon the use of words and names as trademarks has been maintained and established, and no good reason can be given for questioning or impeaching their conclusions. But while this limitation is entirely reasonable, there can be no propriety in extending it beyond the circumstance upon which it is founded; and accordingly any member of the community whose inter-

68—Bennett v. McKinley, 65 Fed. Rep. 505, 13 C. C. A. 25.

ests and business may be promoted by doing so, should be at liberty to apply even names and words in common use to the products of his industry, in such a manner as to indicate their origin or particular manufacture, where such application will not intrench upon and be in no way included in their use by the public. By doing so, the rights of no member of the community can be in any manner infringed, and no public inconvenience whatever can be occasioned by it. The public will still be left at full liberty to use such words or terms as they were used before; while for a special purpose a new office or purpose may be imposed upon them.

“In cases of that description no greater inconvenience or embarrassment can be found in protecting parties in the enjoyment of the new use or purpose engrafted upon a popular term than has been found in extending that protection to the case of a word created for the occasion.”¹

§ 41. **Illustrations of generic terms.**—In the following instances the words and marks mentioned have been held to be invalid as trademarks because generic; being geographical or descriptive. The examples are arranged in alphabetical order for convenient reference.

“A. C. A.,” cloth;² “Acid Phosphate,” medicinal preparation;³ “Allcock’s Porous Plasters,” medicated plasters;⁴ “Aluminum,” Washboards;⁵ “Ammoniated Bone Superphosphate of Lime,” fertilizer;⁶ “Anglo-Portugo,” oysters;⁷ “Angostura,” bitters;⁸ “American,” sardines;⁹

1—Newman v. Alvord, 49 Barb. 588. Saginaw Mfg. Co., 103 Fed. Rep. 281; 43 C. C. A. 233.

2—Amoskeag Mfg. Co. v. Train- 6—Alleghany Fertilizer Co. v. er, 101 U. S. 51. Woodside, 1 Hughes, 115, Fed.

3—Rumford Chem. Works v. Case No. 206. 7—Re Saunion & Co., Seb. 625;

Muth, 35 Fed. Rep. 524. 4—Re Brandreth, L. R. 9 Ch. D. 618. Cox, Manual, 625.

5—American Washboard Co. v. 8—Siegert v. Findlater, L. R. 7 Ch. D. 801; Siegert v. Abbott (2),

"Antiquarian," book-store;¹⁰ "Apple and Honey," medicine;¹¹ "Asbestos," Wall plaster;¹² "Astral," oil;¹³ "Balm of Thousand Flowers," cosmetic;¹⁵ "Barber's Model," razors;¹⁶ "Bazaar," patterns for clothing;¹⁷ "Better Than Mother's," mince meat;¹⁸ "Black Package," tea;¹⁹ "Book," the device of a book, used by a publisher;²⁰ "Borax," soap;²¹ "Braided Fixed Stars," cigar lights;²² "Cachemire Milano," fabric;²³ "California Syrup of Figs," laxative medicine;²⁴ "C. A. P.," cream acid phosphate;²⁵ "Castoria," medicine;²⁶ "Celebrated Stomach Bitters," bitters;²⁷ "Cellular," cloth of cellular construction;²⁸ "Centennial," medals;²⁹

79 N. Y. Sup. Ct. 243. But see, *contra*, A. Bauer & Co. v. Siegert, 56 C. C. A. 487, 120 Fed. Rep. 81, 84.

9—Re American Sardine Co., 3 Off. Gaz. 495.

10—Choynski v. Cohen, 39 Cal. 501.

11—*Ex parte* G. F. Heublein & Bro., 87 Off. Gaz. 179.

12—Asbestos & Asbetic Co. v. Wm. Sclater Co., 18 Rap. Jud. Que. C. S. 360.

13—Pratt's Mfg. Co. v. Astral Refining Co., 27 Fed. Rep. 492-494.

15—Fetridge v. Wells, Cox, Am. Tr. Cas. 180.

16—*Ex parte* Krusius Bros., 82 Off. Gaz. 1687.

17—McCall v. Theal, 28 Grant (Up. Can.) Ch. 48.

18—*Ex parte* Ervin A. Rice Co., 83 Off. Gaz. 1207.

19—Fischer v. Blank, 138 N. Y. 244.

20—Merriam v. Famous Shoe & Clothing Co., 47 Fed. Rep. 411.

21—Dreydoppel v. Young, 14 Phila. 226.

22—Re Palmer, L. R. 24 Ch. D. 504.

23—Re Warburg, 13 Off. Gaz. 44.

24—Worden & Co. v. California Fig Syrup Co., 187 U. S. 515; California Fig Syrup Co. v. Putnam, 66 Fed. Rep. 50; California Fig Syrup Co. v. Stearns, 67 Fed. Rep. 1008; s. c. on appeal, 73 Fed. Rep. 812; Re California Fig Syrup Co., L. R. 40 Ch. D. 620.

Contra, see California Fig Syrup Co. v. Improved Fig Syrup Co., 51 Fed. Rep. 296; Improved Fig Syrup Co. v. California Fig Syrup Co., 54 Fed. Rep. 175; California Fig Syrup Co. v. Worden, 86 Fed. Rep. 212; s. c., 95 Fed. Rep. 132.

25—Provident Chemical Works v. Canada Chemical Mfg. Co., 2 Ont. Law. Rep. 182.

26—Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 34 C. C. A. 118, 91 Fed. Rep. 891; Centaur Co. v. Hughes Bros. Mfg. Co., 34 C. C. A. 127, 91 Fed. Rep. 901. Centaur Co. v. Link, 62 N. J. Eq. 147, 49 Atl. Rep. 828.

27—Hostetter v. Adams, 20 Blatchf. 326.

28—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

29—Hartwell v. Viney, Fed. Case No. 6158.

"Cherry Pectoral," medicine;³⁰ "Chill Stop," medicine;³¹ "Chlorodyne," medicinal compound;³² "Club House," gin;³³ "Computing," scales;³⁴ "Continental," sought to be protected from infringement as the name of a fire insurance corporation;³⁵ "Copenhagen," snuff;³⁶ "Cough Remedy," cough medicine;³⁷ "Crack Proof," rubber;³⁸ "Cramp Cure," medicine;³⁹ "Cream," yeast;⁴⁰ "Cresylic," ointment;⁴¹ "Croup Tincture," medicine;⁴² "Crystallized Egg," for a preparation of eggmeat;⁴³ "Cylinder," glass products.⁴⁴

"Desiccated," codfish;⁴⁵ "Druggists' Sundries," cigars;⁴⁶ "Dry Monopole," champagne;⁴⁷ "Durham," tobacco.⁴⁸

"Egg," macaroni;⁴⁹ "Elastic Seam," drawers;⁵⁰ "Elgin," watches;⁵¹ "Emolliorum," waterproof dressing for leather;⁵² "Encyclopedia Britannica," title of an

30—Ayers v. Rushton, 7 Daly, 9.

31—*Ex parte* Hance Bros. & White, 87 Off. Gaz. 698.

32—Browne v. Freeman (1), 12 W. R. 305; Seb. 230; Cox, Manual, 230; Browne v. Freeman (2), Seb. 424; Cox, Manual, 424.

33—Corwin v. Daly, 7 Bos. 222.

34—Computing Scale Co. v. Standard Computing Scale Co. 55 C. C. A. 459, 118 Fed. Rep. 963.

35—Continental Ins. Co. v. Continental Fire Ass'n, 96 Fed. Rep. 846; affirmed, 41 C. C. A., 326, 101 Fed. Rep. 255.

36—Weyman v. Soderberg, 108 Fed. Rep. 63.

37—Gillman v. Hunnewell, 122 Mass. 139.

38—*Re* Goodyear Rubber Co. 11 Off. Gaz. 1062.

39—L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624.

40—Gillett v. Lumsden, 4 Ont. Law Rep. 300.

41—Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625.

42—*Re* Roach, 10 Off. Gaz. 333.

43—Lamont v. Leedy, 88 Fed. Rep. 72.

44—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

45—Town v. Stetson, 4 Abb. Pr. N. S. 218; 3 Daly, 53; Cox, Am. Tr. Cas. 514.

46—*Ex parte* Cohn (2), 16 Off. Gaz. 680.

47—Richards v. Butcher, L. R. (1891) 2 Ch. 522.

48—Blackwell v. Wright, 73 N. C. 310.

49—*Re* Dole Bros., 12 Off. Gaz. 939.

50—Scriven v. North, 124 Fed. Rep. 894, 896.

51—Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667; reversing s. c., 89 Fed. Rep. 487.

52—*Re* Talbot, 8 R. P. C. 149.

encyclopedia;⁵³ "Evaporated," food products;⁵⁴ "Ever Ready," coffee mills;⁵⁵ "Extract of Night-Blooming Cereus," perfume.⁵⁶

"Fairbank's Patent," scales;⁵⁷ "Famous," stoves;⁵⁸ "Favorite," letter-file;⁵⁹ "Ferro-phosphorated Elixir of Calisaya Bark," medicine;⁶⁰ "Fire-proof," oil;⁶¹ "Flinch," unpatented game so named by the inventor;⁶² "French," paints;⁶³ "French Tissue," medicated paper;⁶⁴ "Fruit," vinegar.⁶⁵

"Galen," manufactured glass;⁶⁶ "Gibraltar," lamp chimneys;⁶⁷ "Glendon," iron;⁶⁸ "Golden," ointment;⁶⁹ "Gold Label," bread;⁷⁰ "Gold Medal," saleratus;⁷¹ "Goodyear Rubber Co.," as name for rubber manufacturing house;⁷² "Granite," enameled kitchen utensils;⁷³ "Granolithic," artificial stone;⁷⁴ "Granulated Dirt-Killer," soap;⁷⁵ "Greatest value for the money," shoes;⁷⁶

53—Black v. Ehrich, 44 Fed. Rep. 793.

54—Re Alden, 15 Off. Gaz. 389.

55—Ex parte Bronson Co., 87 Off. Gaz. 1782.

56—Phalon v. Wright, 5 Phila. 464; Cox, Manual, 232.

57—Fairbanks v. Jacobus, 14 Blatch. 337, Fed. Case No. 4608.

58—Ex parte Brand Stove Co., 62 Off. Gaz. 588.

59—Cook & Cobb Co. v. Miller, 65 N. Y. Supp. 730.

60—Caswell v. Davis, 58 N. Y. 223; 17 Amer. Rep. 223.

61—Scott v. Standard Oil Co., 106 Ala. 475; 31 L. R. A. 374; 19 So. Rep. 71.

62—H. B. Chaffee Co. v. Selchow, 121 Fed. Rep. 543.

63—Ex parte Marsching & Co., 15 Off. Gaz. 294.

64—Draper v. Skerrett (2), 116 Fed. Rep. 206, 208.

65—Alden v. Gross, 25 Mo. App. 123.

66—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

67—*Ex parte* Nave & McCord Merc. Co., 86 Off. Gaz. 1985.

68—Glendon Iron Co. v. Uhler, 75 Pa. St. 467; 15 Amer. Rep. 599.

69—Green v. Rooke, W. N. 1872, p. 49.

70—*Ex parte* Stuhmer, 86 Off. Gaz. 181.

71—Taylor v. Gillies, 59 N. Y. 331.

72—Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; reversing s. c., 21 Fed. Rep. 276.

73—St. Louis Stamping Co. v. Piper, 33 N. Y. Supp. 443.

74—Stuart & Co. v. Scottish Val de Travers Paving Co., Ct. Sess. Cas. (4th ser.) 13, 1.

75—*Ex parte* Waeflerling, 16 Off. Gaz. 764.

76—*Ex parte* Parker, Holmes & Co., 85 Off. Gaz. 287.

"Green Mountain," grapes;⁷⁷ "Guaranteed," corset;⁷⁸ "Guenther's Best," flour;⁷⁹ "Gyrator," bolting machines.⁸⁰

"Hand Grenade," fire extinguisher;¹ "Hamburg," tea;² "Harvey's Sauce," condiment;³ "Headache Wafers," medicinal compound;⁴ "Health Food," cereal products and prepared foods;⁵ "Health Preserving," corsets;⁶ "Highly Concentrated Compound Fluid Extract of Buchu," medicine;⁷ "Holbrook's," school apparatus;⁸ "Homœopathic Medicines," description of articles so called;⁹ "Hydro-Bromo Soda Mint," medicine;¹⁰ "Hygienic," underwear.¹¹

"Imperial," beer;¹² "Indurated Fibre," wood-pulp products;¹³ "Instantaneous," tapioca prepared for speedy cooking;¹⁴ "International Banking Co.," as name of banking concern;¹⁵ "Iron Bitters," bitters containing iron;¹⁶ "Ironstone," water pipe.¹⁷

77—Hoyt v. J. T. Lovett Co., 71 Fed. Rep. 173; 17 C. C. A. 652; 31 L. R. A. 44; 39 U. S. App. 1.

78—Symington v. Footman, 56 L. T. N. S. 696.

79—*Ex parte* Guenther Milling Co., 86 Off. Gaz. 1986.

80—*Ex parte* Wolf, 80 Off. Gaz. 1271.

1—*Re* Harden Fire Extinguisher Co.'s Trademark, 55 L. J. Ch. 596.

2—Frese v. Bachof, 14 Blatchf. 432, Fed. Case No. 5110.

3—Lazenby v. White, 41 L. J. Ch. 354.

4—Gessler v. Grieb, 80 Wis. 21; 27 Am. St. Rep. 20; 48 N. W. Rep. 1098.

5—Fuller v. Huff, 99 Fed. Rep. 439 (Reversed by Fuller v. Huff, 43 C. C. A. 453, 104 Fed. Rep. 141).

6—Ball v. Siegel, 166 Ill. 137.

7—Helmbold v. Helmbold Mfg. Co., 53 How. Pr. 453.

8—Sherwood v. Andrews, 3 Am.

Law Reg. N. S. 588.

9—Humphrey's Spec. Homœopathic Med. Co. v. Wenz, 14 Fed. Rep. 250.

10—*Ex parte* Spayd, 86 Off. Gaz. 631.

11—Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 Fed. Rep. 622; s. c., 65 Fed. Rep. 424.

12—Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405; 74 Fed. Rep. 229.

13—Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 Fed. Rep. 695.

14—Bennet v. McKinley, 65 Fed. Rep. 505; 13 C. C. A. 25.

15—Kohler v. Sanders, 122 N. Y. 65; affirming s. c., 48 Hun. 48.

16—Brown Chem. Co. v. Stearns, 37 Fed. Rep. 360; Brown Chem. Co. v. Meyer, 139 U. S. 540; Cox, Manual, 726.

17—*Re* Rader, 13 Off. Gaz. 596.

"Johnson's American Anodyne," liniment;¹⁸ "Julienne," soup.¹⁹

"Kaiser," beer;²⁰ "Kentucky Club," whiskey;²¹ "Kid Nee Kure,"²² "Kidney & Liver," bitters.²³

"Lackawanna," coal;²⁴ "Lake," glass product;²⁵ "La Normandie," cigars;²⁶ "Liebig's Extract of Meat," meat extract made under Liebig's formula;²⁷ "Lieutenant James' Horse Blister," ointment;²⁸ "Linoleum," floorcloth;²⁹ "Loch Katrine," whiskey.³⁰

"Magnolia," alloy metal;³¹ "Malted Milk," infants' food;³² "Marshall's Celebrated," liniment;³³ "Maryland Club Rye," whiskey;³⁴ "Masonic," cigars;³⁵ "Matzoon," fermented milk;³⁶ "Medicated Prunes," medicine;³⁷

18—Re Johnson, 2 Off. Gaz. 315.

19—Godillot v. Hazard, 81 N. Y. 263.

20—Luyties v. Hollender, 30 Fed. Rep. 632. Per *contra*, see Kaiserbrauerei v. Baltz Brewing Co., 71 Fed. Rep. 695.

21—Davies County Distilling Co. v. Martinoni, 117 Fed. Rep. 186.

22—*Ex parte* Henderson, 85 Off. Gaz. 453.

23—Spieker v. Lash, 102 Cal. 38; 36 Pac. Rep. 362.

24—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311.

25—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

26—Stachelberg v. Ponce, 128 U. S. 686.

27—Liebig's Extract of Meat Co. (Ltd.) v. Hanbury, 17 L. T. N. S. 298; Anderson v. Liebig's Extract of Meat Co. (Ltd.), 45 L. T. 757; Cartmell, 47; Liebig's Extract of Meat Co. v. Libby, McNeill & Libby, 103 Fed. Rep. 87; Liebig's Extract of Meat Co. v. Walker, 115 Fed. Rep. 822.

28—James v. James, L. R. 13 Eq.

421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388.

29—Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

30—Bulloch, Lade & Co. v. Gray, 19 Jour. Juris. 218; Seb. 452.

31—Magnolia Metal Co.'s Trade-marks, 66 L. J. Ch. N. S. 312.

32—*Ex parte* Horlick's Food Co., 84 Off. Gaz. 1870; Horlick's Food Co. v. Elgin Milkine Co., 56 C. C. A. 544, 120 Fed. Rep. 264.

33—Marshall v. Pinkham, 52 Wis. 572.

34—Cahn v. Hoffman House, 28 N. Y. Supp. 388. *Contra*, see Cahn v. Gottschalk, 2 N. Y. Supp. 13.

35—*Ex parte* Smith (3), 16 Off. Gaz. 764.

36—Dadirrian v. Yacubian, 72 Fed. Rep. 1010; Dadirrian v. Yacubian, (2), 90 Fed. Rep. 812. But see Dr. Dadirrian & Sons Co. v. Hauenstein, 74 N. Y. Supp. 709.

37—*Ex parte* Smith (2), 16 Off. Gaz. 679.

"Metallic Clinton," paint;³⁸ "Microbe Killer," antiseptic;³⁹ "Moline," plows;⁴⁰ "Montserratt," lime juice.⁴¹

"National Sperm," candles;⁴² "Native Guano," fertilizer;⁴³ "New Manny," harvester;⁴⁴ "New York," glass products;⁴⁵ "Nourishing London," stout.⁴⁶

"Old Bourbon," whiskey;⁴⁷ "Old Country," soap;⁴⁸ "Old Innishowen," whiskey;⁴⁹ "Old London Dock," gin;⁵⁰ "Olive," bicycles having olive-colored frames.⁵¹

"Paraffin," oil;⁵² "Parcheesi," game, invalid because a mere variation of the Hindoostanee name for the same game;⁵³ "Parson's Purgative," pills;⁵⁴ "Perfect Face Paste," medicine;⁵⁵ "Philadelphia," beer;⁵⁶ "Pocahontas," coal;⁵⁷ "Post Office," directory;⁵⁸ "Porous," medicinal plasters;⁵⁹ "Prime Leaf," lard;⁶⁰ "Prize Medal, 1862," on goods sold by one awarded a medal at the Lon-

38—Clinton Metallic Paint Co. v. New York Metallic Paint Co., 50 N. Y. Supp. 437. Co., 59 C. C. A. 54, 122 Fed. Rep. 196.

39—Alff v. Radam, 77 Tex. 530.

49—Watt v. O'Hanlon, 4 P. R. 1.

40—Candee, Swan & Deere v. Deere & Co., 54 Ill. 439; 5 Amer. Rep. 125.

50—Binninger v. Wattles, 28 How. Pr. 206.

41—Evans v. Von Laer, 32 Fed. Rep. 153.

51—*Ex parte* Olive Wheel Co., 84 Off. Gaz. 1871.

42—Re Price's Patent Candle Co., L. R. 27 Ch. D. 681.

52—Young v. Macrae, 9 Jur. N. S. 322.

43—Native Guano Co. v. Sewage Manure Co., 8 P. R. 125.

53—Selchow v. Chaffee & Selchow Mfg. Co., 132 Fed. Rep. 996.

44—Re Graham, 2 Off. Gaz. 618.

54—Re Johnson, 2 Off. Gaz. 315.

45—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

55—*Ex parte* Rall, 85 Off. Gaz. 453.

46—Raggett v. Findlater, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. N. S. 448; 22 W. R. 53; Seb. 431.

56—Eggers v. Hink, 63 Cal. 445.

47—Hardy v. Cutter, 3 Off. Gaz. 468.

57—Coffman v. Castner, 87 Fed. Rep. 457, 31 C. C. A. 55. Affirmed in Castner v. Coffman, 178 U. S. 168, 44 L. ed. 1021, and overruling Atwater v. Castner, 32 C. C. A. 77, 88 Fed. Rep. 642.

48—Allen B. Wrisley Co. v. Iowa Soap Co., 104 Fed. Rep. 548; Allen B. Wrisley Co. v. Iowa Soap

58—Kelly v. Byles, 40 L. T. 623.

59—Re Brandreth, Seb. 626.

60—Popham v. Wilcox, 66 N. Y. 69.

don International Exhibition of 1862;⁶¹ "Purity," oleo-margarine.⁶²

"Red," snuff;⁶³ "Richardson's Patent Union," leather splitting machine;⁶⁴ "Rose," vanilla extract;⁶⁵ "Rosedale," cement;⁶⁶ "Rye and Rock," liquor.⁶⁷

"Safety," explosive powder;⁶⁸ "Sanitary," filter;⁶⁹ "Sarsaparilla and Iron," tonic;⁷⁰ "Satinine," starch and soap;¹ "Satin Polish," boots and shoes;² "Schiedam Schnapps," liquor;³ "Selected Shore," mackerel;⁴ "Singer," sewing machines, after expiration of the Singer patents;⁵ "Snowflake," crackers, the word being descriptive of the quality of flour used;⁶ "Somatose," meat extract, from the Greek "soma," Angl. "body," genitive "somatos";⁷ "Splendid," flour;⁸ "Standard A," cigars;⁹

61—Batty v. Hill, 1 H. & M. Id. 855; Same v. Liberty Soda Works Co., Id. 856.
264; 8 L. T. N. S. 791; 11 W. R. 745; 2 N. R. 265; Seb. 218.

62—*Ex parte* Capitol City Dairy Co., 83 Off. Gaz. 295.

63—*Ex parte* Pearson Tobacco Co., 85 Off. Gaz. 287.

64—Re Richardson, 3 Off. Gaz. 120.

65—Clotworthy v. Schepp, 42 Fed. Rep. 62.

66—New York Cement Co. v. Coplay Cement Co. (1), 44 Fed. Rep. 277; New York Cement Co. v. Coplay Cement Co. (2), 45 Fed. Rep. 212.

67—Van Beil v. Prescott, 82 N. Y. 630.

68—*Ex parte* Safety Powder Co., 16 Off. Gaz. 136.

69—Re Atkins Filter Co., 3 P. R. 164.

70—Schmidt v. Brieg, 100 Cal. 672; Same v. McEwen, 35 Pac. Rep. 854; Same v. Crystal Soda Water Co., Id. 855; Same v. Steinke, Id. 855; Same v. Haake,

Id. 855; Same v. Liberty Soda Works Co., Id. 856.

1—Re Meyerstein, 7 R. P. C. 114; L. R. 43 Ch. D. 604; 59 L. J. Ch. 401; 62 L. T. 526; 38 W. R. 440; Cartmell, 225.

2—*Ex parte* Brigham, 20 Off. Gaz. 891.

3—Wolfe v. Goulard, 18 How. Pr. 64; Seb. 179; Cox, Am. Tr. Cas. 226; Burke v. Cassin, 45 Cal. 467; Wolfe v. Hart, 4 V. L. R. Eq. 125; Wolfe v. Alsop, 10 V. L. R. Eq. 41; 12 V. L. R. 421; Wolfe v. Lang, 13 V. L. R. 752.

4—Trask Fish Co. v. Wooster, 28 Mo. App. 408.

5—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169.

6—Larrabee v. Lewis, 67 Ga. 561; 44 Am. Rep. 735.

7—Farben-fabriken T. M. K., 7 R. P. C. 439; L. R. (1894) 1 Ch. 645.

8—*Ex parte* Stokes, 64 Off. Gaz. 437.

9—*Ex parte* Cohn (1), 16 Off. Gaz. 650.

"Steel Shod," shoes having soles quilted with steel wire;¹⁰ "Stoga Kip," boots;¹¹ "Straight-Cut," cigarettes;¹² "Svenska Snusmaganiset," meaning Swedish snuff store;¹³ "Sweet Lotus," tobacco;¹⁴ "Swing," scythe-sockets.¹⁵

"Taffy-Tolu," chewing-gum;¹⁶ "Tasteless," drugs;¹⁷ "Thomsonian," medicines;¹⁸ "Timekeeper," watches;¹⁹ "Toothache Gum," remedy for toothache;²⁰ "Tycoon," tea;²¹ "Tucker Spring," bed.²²

"United States," dental rooms.²³

"Valvolene," oil;²⁴ "V-O," medicine;²⁵ "Vitae-Ore," medicine;²⁶ "Victoria," lozenges.²⁷

"Water of Ayr," stone;²⁸ "Webster's Dictionary," applied to the standard lexicon of that name;²⁹ "Whirling Spray," syringes;³⁰ "Wister's Balsam of White Cherry," medicine;³¹ "Worcestershire," sauce.³²

10—*Brennan v. Emery-Bird-Thayer Dry Goods Co.*, 99 Fed. Rep. 971; S. C. 108 Fed. Rep. 624; 47 C. C. A. 532.

11—*Walker v. Reid*, Fed. Case No. 17,084.

12—*Ginter v. Kinney*, 12 Fed. Rep. 782.

13—*Bolander v. Peterson*, 136 Ill. 215.

14—*Wellman & Dwire Tob. Co. v. Ware Tob. Works*, 46 Fed. Rep. 289.

15—*Ex parte Thompson*, Derby & Co., 16 Off. Gaz. 137.

16—*Colgan v. Danheiser*, 35 Fed. Rep. 150.

17—*Re Dick & Co.*, 9 Off. Gaz. 538.

18—*Thomson v. Winchester*, 36 Mass. 214.

19—*Ex parte Strasburger & Co.*, 20 Off. Gaz. 155.

20—*Devlin v. McLeod*, 135 Fed. Rep. 164; *Devlin v. Peck*, 135 Fed. Rep. 167.

21—*Corbin v. Gould*, 133 U. S. 308.

22—*Tucker Mfg. Co. v. Boyington*, 9 Off. Gaz. 455, Fed. Case No. 14229.

23—*Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

24—*Re Horsburgh*, 53 L. J. Ch. 237.

25—*Noel v. Ellis*, 89 Fed. Rep. 978-981.

26—*Noel v. Ellis*, *supra*.

27—*Wotherspoon v. Gray*, Ct. Sess. Cas. (3d ser.) 238.

28—*Montgomerie v. Donald*, Ct. Sess. Cas. (4th ser.) 11,506.

29—*Merriam v. Texas Siftings*, Pub. Co., 49 Fed. Rep. 944-947.

30—*Marvel Co. v. Pearl*, C. C. A., 133 Fed. Rep. 160, 162.

31—*Towle v. Spear*, 7 Penn. L. J. 176; *Cox*, Am. Tr. Cas. 67; *Seb.* 90.

32—*Lea v. Deakin*, 11 Biss. 23 Fed. Case No. 8154; *Lea v. Wolff*, 15 Abb. Pr. N. S. 1; 46

“Yale,” locks;³³ “Yucatan,” leather and leather goods.³⁴

§ 42. **Examples of valid trademarks, fancy, arbitrary or distinctive words.**—The following instances are illustrative of fancy, arbitrary or distinctive words, which have been either held proper, protected against unfair competition, or their use upheld as trademarks in application to the classes of merchandise in connection with which the words have respectively been used. In some cases the question of validity was not raised, nor are all of them to be upheld as technical trademarks. These illustrations are given in their alphabetical order to facilitate reference.

“Ainsworth,” thread;³⁵ “Alderney,” oleomargarine;³⁶ “American Cold Japan,” paint;³⁷ “American Express,” sealing wax;³⁸ “American Volunteer,” shoes;³⁹ “Anatolia,” licorice;⁴⁰ “A. N. Hoxie’s Mineral,” soap;⁴¹ “Anchor Brand,” wire;⁴² “Annihilator,” medicine;⁴³ “Anti-Wash-board,” soap;⁴⁴ “Apollinaris,” mineral water;⁴⁵ “A. V. H.,” gin.⁴⁶

How. Pr. 157; Seb. 407; Lea v. Millar, Seton (4th ed.), 242; Seb. 513.

33—*Ex parte* Yale & Towne Mfg. Co. 81 Off. Gaz. 801.

34—*Ex parte* Weil, 83 Off. Gaz. 1802.

35—Ainsworth v. Walmesley, 44 L. R. 1 Eq. 518.

36—Lauferty v. Wheeler, 11 Abb. N. C. 220; 11 Daly, 194; 63 How. Pr. 488.

37—Reeder v. Brodt, 6 Ohio Dec. 248; 4 Ohio N. P. 265.

38—Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-653.

39—Joseph Banigan Rubber Co. v. Bloomingdale, 89 Off. Gaz. 1670.

40—McAndrews v. Bassett, 4 DeG. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S.

442; 12 W. R. 777; 4 N. R. 123; Cox, 669. Anatolia is a geographical name, but its use here was protected on the theory of unfair competition.

41—Hoxie v. Chaney, 143 Mass. 592.

42—Edelsten v. Edelsten, 1 DeG. J. & S. 185; Cox, 667.

43—Fulton v. Sellers, 4 Brewst. 42.

44—O’Rourke v. Central City Soap Co., 26 Fed. Rep. 576.

45—Apollinaris Co. v. Norrish, 33 L. T. N. S. 242; Same v. Edwards, Seton (4th ed.), 247; Same v. Moore, Cox, Manual, Case No. 675; Same v. Herrfeldt, 4 P. R. 478; Same v. Scherer, 27 Fed. Rep. 18.

46—Van Hoboken v. Mohns & Kaltenbach, 112 Fed. Rep. 528.

"Baco-Curo," remedy for tobacco habit;⁴⁷ "B. B. B.," medicine;⁴⁸ "B. B. H.," with a crown, iron;⁴⁹ "Baffle," safes;⁵⁰ "Balm of Thousand Flowers," cosmetic;⁵¹ "Beatty's Headline," copy book;⁵² "Bell of Moscow," wine;⁵³ "Benedictine," liqueur;⁵⁴ "Bethesda," mineral water;⁵⁵ "Bismarck," paper collars;⁵⁶ "Blackstone," cigars;⁵⁷ "Blood Searcher," medicine;⁵⁸ "Blue Lick," water;⁵⁹ "Boker's Stomach Bitters," medicine;⁶⁰ "Bovilene," pomade;⁶¹ "Bovril," meat extract;⁶² "Bromidia," medicine;⁶³ "Bromo-Caffeine," medicine.⁶⁴

"Carrom," game-board;⁶⁵ "Cashmere Bouquet," toilet soap;⁶⁶ "Celluloid," compound of pyroxyline;⁶⁷ "Celery

47—Sterling Remedy Co. v. Eureka Chemical and Mfg. Co., 80 Fed. Rep. 105; 49 U. S. App. 709; 25 C. C. A. 314.

48—Foster v. Blood Balm Co., 77 Ga. 216, 3 S. E. Rep. 284.

49—Hall v. Barrows, 4 DeG. J. & S. 150; Cox, 668.

50—Talbot v. Webley, 3 R. P. C. 276; Cartmell, 324.

51—Fettridge v. Merchant, 4 Abb. Pr. 156.

52—Gage v. Canada Publ. Co., 11 Can. Sup. Ct. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

53—Re Charles Narcisse Ferre, Cert. No. 8939.

54—Societe Anonyme v. Western Distilling Co., 43 Fed. Rep. 416; Societe Anonyme De La Distillerie De La Benedictine v. Micalovitch, Fletcher & Co., 36 Abb. Law J. 364; A. Bauer & Co. v. Distillerie de la Liqueur Benedictine, 56 C. C. A. 480, 120 Fed. Rep. 74.

55—Dunbar v. Glenn, 42 Wis. 118; Seb. 529.

56—Messerole v. Tynberg, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; Seb. 300.

57—Levy v. Waitt, 56 Fed. Rep. 1016.

58—Fulton v. Sellers, 4 Brewst. 42; Cox, Manual, Case No. 279.

59—Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21; Parkland Hill Blue Lick Water Co. v. Hawkins (Ky.) 26 S. W. Rep. 389; 95 Ky. 502; 16 Ky. Law Rep. 210; 44 Am. St. Rep. 254.

60—Funke v. Dreyfus, 34 La. Ann. 80; 44 Am. Rep. 413.

61—Lockwood v. Bostwick, 2 Daly, 521.

62—Re Bovril, L. R. (1896) 2 Ch. D. 600.

63—Battle v. Finlay (2), 50 Fed. Rep. 106; Battle v. Finlay (1), 45 Fed. Rep. 796.

64—Keasbey v. Brooklyn Chemical Works, 37 N. E. Rep. 476; 142 N. Y. 467; reversing s. c., 21 N. Y. Supp. 696.

65—Luddington Novelty Co. v. Leonard, 119 Fed. Rep. 937; Williams v. Mitchell, 45 C. C. A. 265, 106 Fed. Rep. 168.

66—Colgate & Co. Cert. No. 914 Colgate v. Adams, 88 Fed. Rep. 899.

67—Celluloid Mfg. Co. v. Read,

Compound," medicine;⁶⁸ "Centennial," clothing;⁶⁹ or alcoholic spirits;⁷⁰ "Champion," flour;⁷¹ "Charley's Aunt," name of farce;⁷² "Charter Oak," stoves;⁷³ "Chat-terbox," juvenile books, published periodically;⁷⁴ "Chi-cago Waists," corset waists;⁷⁵ "Chicken Cock," whis-key;⁷⁶ "Chinese Liniment";⁷⁷ "Climax," stoves;⁷⁸ "Club," Cocktails;⁷⁹ "Club Soda," carbonated water;⁸⁰ "Coal Oil Johnny's Petroleum," soap;⁸¹ "Cocaine," hair oil;⁸² "Coe's Superphosphate of Lime," fertilizer;⁸³ "Comfort," periodical publication;⁸⁴ "Compactum," umbrellas;⁸⁵ "Congress Water," mineral water;⁸⁶ "Cot-tolene," lard substitute;⁸⁷ "Cough Cherries," confection-

47 Fed. Rep. 712; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

68—Wells & Richardson Co. v. Siegel, Cooper & Co., 106 Fed. Rep. 77.

69—Sternberger v. Thalheimer, 3 Off. Gaz. 120.

70—Re Bush & Co., 10 Off. Gaz. 164.

71—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; 27 Off. Gaz. 1322.

72—Frohman v. Miller, 29 N. Y. S. 1109; 8 Misc. Rep. 379.

73—Filley v. Fassett, 44 Mo. 173; 100 Am. Dec. 275; Cox, Am. Tr. Cas. 530; 9 Am. L. Reg. N. S. 402; Seb. 313; Filley v. Child, 16 Blatchf. 376.

74—Estes v. Leslie, 29 Fed. Rep. 91; Estes v. Worthington, 31 Fed. Rep. 154; Estes v. Leslie, 27 Fed. Rep. 22; Fed. Case No. 4787.

75—Gage-Downs Co. v. Feather-bone Corset Co., 83 Fed. Rep., 213.

76—G. G. White Co. v. Miller, 50 Fed. Rep. 271.

77—Coffeen v. Brunton, 4 McLean 516; 5 McLean 256.

78—Filley v. Fassett, 44 Mo. 173.

79—Heublein v. Adams, 125 Fed. Rep. 782.

80—Cochrane v. Macnish (P. C.) L. R. (1896) A. C. 225; 65 L. J. P. C. N. S. 20; 74 Law T. R. 109.

81—Petrolia Mfg. Co. v. Bell & Bogart Soap Co., 97 Fed. Rep. 781.

82—Burnett v. Phalon, 3 Keyes, 594; 5 Abb. Pr. N. S. 212; 9 Bos. 193.

83—Bradley v. Norton, 33 Conn. 157; Cox's American Trademark Cases 331; 87 Am. Dec. 200.

84—Gannert v. Rupert, 127 Fed. Rep. 962, 62 C. C. A. 594, reversing S. C. 119 Fed. Rep. 221.

85—Re Davis Trademarks, 22 Trademark Record, 50.

86—Congress, etc. Spring Co. v. High Rock Congress Spring Co. 57 Barb. 526; Cox, 599; 45 N. Y. 291; 10 Abb. P. R. N. S. 348; 6 Am. Rep. 82; 4 Am. L. T. 168; Cox, Am. Tr. Cas. 624; Seb. 354.

87—N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

ery;⁸⁸ "Cream," baking powder;⁸⁹ "Cuticura," toilet soap.⁹⁰

"Derringer," fire-arms;¹ "Dr. Drake's German Croup Remedy," medicine;² "Dr. Lobenthal's Essentia Anti-phthisica," medicine;³ "Dublin," soap;⁴ "Durham," smoking tobacco;⁵ "Dyspepticure," medicine.⁶

"Edelweiss," perfume;⁷ "Elastic," book-cases;⁸ "Electro-Silicon," polishing preparation;⁹ "Elk," cigars;¹⁰ "Emollia," toilet cream;¹¹ "Empire," stoves;¹² "Epiqueure," canned salmon;¹³ "Ethiopian," stockings;¹⁴ "Eureka," fertilizer;¹⁵ shirts,¹⁶ fire-hose,¹⁷ or steam-packing;¹⁸ "Excelsior," stoves;¹⁹ or soap.²⁰

88—Stoughton v. Woodard, 39 Fed. Rep. 902.

89—Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799.

90—Potter Drug & Chem. Co. v. Miller, 75 Fed. Rep. 656. Held infringed by word "curative" and imitative devices. The mark assumed to be valid in Potter Drug & Chem. Corp. v. Pasfield Soap Co., 102 Fed. Rep. 490; Same v. Same, 106 Fed. Rep. 914, 46 C. C. A. 40.

1—Derringer v. Plate, 29 Cal. 292; Cox, Am. Tr. Cas. 324.

2—Drake Medicine Co. v. Glessner 68 Ohio St. 337, 67 N. E. Rep. 722.

3—Re Rohland, 10 Off. Gaz. 980.

4—Re Cornwall & Co., 12 Off. Gaz. 312.

5—Blackwell v. Armistead, Fed. Case No. 1474, 5 Am. L. T. 85; 3 Hughes, 163; Armistead v. Blackwell, 1 Off. Gaz. 603; Blackwell v. Dibrell, 14 Off. Gaz. 633, Fed. Case No. 1475; Blackwell v. Wright, 73 N. C. 310.

6—*Ex parte* Foley & Co., 87 Off. Gaz. 1957.

7—Rosing v. Atkinson, 27 Sol. J. 534.

8—Globe-Wernicke Co. v. Brown, 121 Fed. Rep. 185.

9—Electro-Silicon Co. v. Hazard, 29 Hun, 369; 36 N. Y. Sup. Ct. 369.

10—Lichtenstein v. Goldsmith, 37 Fed. Rep. 359.

11—Re Grossmith, 60 L. T. N. S. 612.

12—Filley v. Fassett, 44 Mo. 173; Seb. 313.

13—George v. Smith, 52 Fed. Rep. 830.

14—Hine v. Lart, 10 Jur. 106; 7 L. T. O. S. 41; Seb. 80.

15—Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115; Seb. 364; Fed. Case No. 206.

16—Ford v. Foster, L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384.

17—Eureka Fire Hose Co. v. Eureka Rubber Mfg. Co., N. J. Ch. 60 Atl. Rep. 561.

18—Symonds v. Greene, 28 Fed. Rep. 834.

19—Filley v. Fassett, 44 Mo. 173; Seb. 313; Sheppard v. Stuart, 13 Phila. 117.

20—Braham v. Bustard, 1 H. & M. 447, 9 L. T. N. S. 199.

"Faber," pencils;²¹ "Family," salve;²² "Favorita," flour;²³ "Fibre Chamois," dress linings;²⁴ "Filofloss," silk;²⁵ "Filtre Rapide," filters.²⁶

"Glenfield," starch;²⁷ or washing powder;²⁸ "Golden Crown," cigars;²⁹ "Golden Wedding," whiskey;³⁰ "Gouraud's Oriental Cream," cosmetic;³¹ "Hunter," whiskey;³² "Grand Master," cigars;³³ "Green Mountain," scythe-stones;³⁴ "Grenade," syrup.³⁵

"Hanford's Chestnut Grove," whiskey;³⁶ "Hansa," lard, sausages and bacon;³⁷ "Heliotype," prints;³⁸ "Hero," jars;³⁹ "Home," sewing machine;⁴⁰ "Hoosier," drills;⁴¹ "Howqua's Mixture," tea;⁴² "Hunyadi," medicinal water;⁴³ "Hygeia," water;⁴⁴ "Hygieniques," suspenders.⁴⁵

21—Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, Am. Tr. Cas. 401.

22—Reinhart v. Spaulding, 49 L. J. Ch. 57.

23—Menendez v. Holt, 128 U. S. 182; Cox, Manual, Case No. 707.

24—American Fibre Chamois Co. v. De Lee, 67 Fed. Rep. 329; 71 Off. Gaz. 1458.

25—Rawlinson v. Brainard & Armstrong Co. 59 N. Y. Supp. 880; 28 Misc. Rep. 287.

26—Re Maignen's Application, 28 W. R. 759; Cartmell, 216.

27—Wotherspoon v. Currie, L. R. 5 H. L. 508; 42 Law J. Ch. 130; 27 L. T. N. S. 393.

28—N. K. Fairbank Co. v. Luckel, etc. Soap Co., 88 Fed. Rep. 694.

29—Palmer v. Harris, 60 Pa. St. 156.

30—Pontefact v. Isenberger, 106 Fed. Rep. 499.

31—Gouraud v. Trust, 10 N. Y. Sup. Ct. 627.

32—Lanahan v. John Kissel & Son, 135 Fed. Rep. 899.

33—Yale Cigar Mfg. Co. v. Yale, 30 Off. Gaz. 1183.

34—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

35—Rillet v. Carlier, 61 Barb. 435.

36—Hanford v. Westcott, 16 Off. Gaz. 1181.

37—*Ex parte* Tietgens & Robertson, 87 Off. Gaz. 2117.

38—Osgood v. Rockwood, 11 Blatchf. 310, Fed. Case No. 10605.

39—Rowley v. Houghton, 2 Brewst. 303.

40—New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.

41—Julian v. Hoosier Drill Co., 78 Ind. 408.

42—Pidding v. How., 8 Sim. 477.

44—Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19.

45—Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 63 Fed. Rep. 438; 11 C. C. A. 277; Hygeia Distilled Water Co. v. Hygeia Ice Co., 72 Conn. 646; 45 Atl. Rep. 957; 49 L. R. A. 147.

"Ideal," fountain pens;⁴⁷ "Indian Pond," scythe-stones;⁴⁸ "Indian Root," pills;⁴⁹ "In-er-seal," bakery products;⁵⁰ "Insectine," insect powder;⁵¹ "Insurance," oil;⁵² "Invigorator," spring bed bottoms;⁵³ "Iron Clad," boots.⁵⁴

"Junket," rennet preparation.⁵⁵

"Kaiser," beer;⁵⁶ "Kathairon," remedy;⁵⁷ "King Bee," smoking tobacco;⁵⁸ "Kitchen Crystal," soap;⁵⁹ "Knickerbocker," shoes;⁶⁰ "Koffio," cereal coffee.⁶¹

"La Cronica," newspaper;⁶² "Lacto-Peptine," medicine;⁶³ "La Favorita," flour;⁶⁴ "Lamoille," scythe-stones;⁶⁵ "La Norma," cigar-boxes;⁶⁶ "La Normandi," cigars;⁶⁷ "Leopold," woolen-cloth;⁶⁸ "LaPage," glue;⁶⁹

46—Bailly v. Nashawannuck Mfg. Co., 51 Off. Gaz. 970; 10 N. Y. Supp. 224.

47—Waterman v. Shipman, 130 N. Y. 301.

48—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

49—Comstock v. White, 18 How. Pr. 421.

50—Ohio Baking Co. v. National Biscuit Co., 62 C. C. A. 116; 127 Fed. Rep. 116; affirming National Biscuit Co. v. Ohio Baking Co., 127 Fed. Rep. 160.

51—Arthur v. Howard, 19 Pa. Co. Ct. 81.

52—Insurance Oil Tank Co. v. Scott, 33 La. Ann. 946.

53—*Ex parte* Heyman, 18 Off. Gaz. 922.

54—Hecht v. Porter, 9 Pac. Coast, L. J. 569.

55—Hansen v. Siegel-Cooper Co. (2), 106 Fed. Rep. 691.

56—Kaiserbrauerei v. Blatz Brewing Co., 71 Fed. Rep. 695; s. c. affirmed, 74 Fed. Rep. 222.

57—Heath v. Wright, Cox, Am. Tr. Cas. 154, 3 Wall. Jr. 1.

58—Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 35 C. C. A. 496.

59—Re Eastman, W. N. 1880, p. 128.

60—Burt v. Tucker, 178 Mass. 493, 59 N. E. Rep. 1111, 52 L. R. A. 112.

61—Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co., 85 Off. Gaz. 1905.

62—Stephens v. DeConto, 4 Abb. Pr. N. S. 47.

63—Carnrick v. Morson; Seb. 543; Cox, Manual, 543.

64—Menendez v. Holt, 128 U. S. 514.

65—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

66—*Ex parte* Egyptian Cigarette Co., 85 Off. Gaz. 1905.

67—Stachelberg v. Ponce, 23 Fed. Rep., 430.

68—Hirst v. Denham, L. R. 14 Eq. 542; 27 L. T. N. S. 56; 41 L. J. Ch. 752.

69—Russia Cement Co. v. Katzenstein, 109 Fed. Rep. 314.

“Licensed Victuallers,” relish;⁷⁰ “Lightning,” hay knives;⁷¹ “Lion,” merchandise;⁷² “Liverpool,” woolen cloth;⁷³ “London Whiffs,” cigars;⁷⁴ “Lone Jack,” smoking tobacco.⁷⁵

“Magic,” scythe-stones;⁷⁶ “Magnetic Balm,” ointment;⁷⁷ “Magnolia,” liquor;⁷⁸ “Maizena,” corn flour;⁷⁹ “Marvel,” mill products;⁸⁰ “Medicated Mexican Balm,” medicine;⁸¹ “Menlo Park,” watches;⁸² “Mojava,” blended coffee;⁸³ “Muffet,” neck-scarfs.⁸⁴

“Napoleon,” cigars;⁸⁵ “New Era,” newspaper;⁸⁶ “Nickel,” soap;⁸⁷ “Nickel-In,” cigars;⁸⁸ “No-To-Bac,” medicine.⁸⁹

“O. F. C.,” whiskey;⁹⁰ “Old Crow,” whiskey;⁹¹ “Ome-

70—Cotton v. Gillard, 44 L. J. Ch. 90.

71—Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

72—Re Weaver, 10 Off. Gaz. 1.

73—Hirst v. Denham, L. R. 14 Eq. 542.

74—Feder v. Brudno, 5 Ohio N. P. 275.

75—Carroll v. Ertheiler, 1 Fed. Rep. 688.

76—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

77—Smith v. Sixbury, 25 Hun. 232; 32 N. Y. Sup. Ct. 232.

78—Kidd & Co. v. Mills, Johnson & Co., 5 Off. Gaz. 337; Kidd v. Johnson, 100 U. S. 617.

79—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823.

80—Listman Mill Co. v. William Listman Milling Co., 60 N. W. Rep. 261; 88 Wis. 334.

81—Perry v. Truefit, 6 Beav. 56; 1 L. T. 384; Seb. 73.

82—*Ex parte* Hampden Watch Co., 81 Off. Gaz. 1282.

83—American Grocery Co. v. Sloan, 68 Fed. Rep. 539.

84—Hygienic Fleeced Underwear Co. v. Way, C. C. A. 137 Fed. Rep. 592, 595.

85—Goldstein v. Whelan, 62 Fed. Rep. 124.

86—Bell v. Locke, 8 Paige, 75; Cox, Am. Tr. Cas. 11.

87—*Ex parte* Butler, 87 Off. Gaz. 1781.

88—Schendel v. Silver, 18 N. Y. Supp. 1; 63 Hun. 330.

89—Sterling Remedy Co. v. Eureka, etc. Mfg. Co., 70 Fed. Rep. 704; 80 Fed. Rep. 105.

90—Geo. T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S. W. Rep. 247.

91—W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421; W. A. Gaines & Co. v. E. Whyte Grocery, Fruit & Wine Co., 107 Mo. App. 507; 81 S. W. Rep. 648.

ga Oil," liniment;⁹² "Osman," towels;⁹³ "Otaka," biscuits;⁹⁴ "Oxford," bibles.⁹⁵

"Pain-Killer," medicine;⁹⁶ "Parabola," needles;⁹⁷ "Pectorine," medicine;⁹⁸ "Pepto-Mangan," medicinal preparation;⁹⁹ "Perfection," mattresses;¹ "Persian," thread;² "Pigs in Clover," puzzle;³ "Portland," stoves;⁴ "Pride," cigars;⁵ "Puddine," pudding preparation.⁶

"Queen," shoes.⁷

"Ranier," beer;⁸ "Rising Sun," stove polish;⁹ "Roger Williams," cotton cloth;¹⁰ "Rosebud," canned salmon;¹¹ "Royal," baking powder;¹² "Royal Blue," carpet sweeper.¹³

"Sapolio," scouring brick;¹⁴ "Saponifier," concentrated lye;¹⁵ "Sefton," cloth;¹⁶ "Shawknit," stockings;¹⁷

92—Omega Oil Co. v. Weschler, 71 N. Y. Supp. 983.

93—Barlow & Jones v. Johnson, 7 P. R. 395.

94—*Ex parte* Lorenz, 89 Off. Gaz. 2067.

95—Chancellor of Oxford University v. Wilmore-Andrews Pub. Co., 101 Fed. Rep. 443.

96—Davis v. Kendall, 2 R. I. 566; Davis v. Kennedy, 13 Grant Up. Can. Ch. 523.

97—Roberts v. Sheldon, Fed. Case No. 11,916; 18 Off. Gaz. 1277; 8 Biss. 398.

98—Smith v. Mason, W. R. (1875) p. 62.

99—M. J. Breitenbach Co. v. Spangenberg, 131 Fed. Rep. 160.

1—Kyle v. Perfection Mattress Co., 127 Ala. 39, 28 So. Rep. 545.

2—Taylor v. Carpenter (1), 3 Story, 458.

3—Lyman v. Burns, 47 Off. Gaz. 660.

4—Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788.

5—Hier v. Abrahams, 82 N. Y. 519; 37 Am. Rep. 589.

6—Clotworthy v. Schepp, 42 Fed. Rep. 62.

7—Thomas G. Plant Co. v. May Co., 44 C. C. A. 534, 105 Fed. Rep. 375; Thomas G. Plant Co. v. May Co., 100 Fed. Rep. 72.

8—Kostering v. Seattle Brewing & Malting Co., 54 C. C. A. 76, 116 Fed. Rep. 620.

9—Morse v. Worrell, 10 Phila. 168.

10—Barrows v. Knight, 6 R. I. 434; Cox, Am. Tr. Cas. 238.

11—*Ex parte* Kinney, 72 Off. Gaz. 1349.

12—Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376; Raymond v. Royal Baking Powder Co., 85 Fed. Rep. 231, 29 C. C. A. 245.

13—*Ex parte* Grand Rapids School Furniture Co., 87 Off. Gaz. 1957.

14—Enoch Morgan's Sons Co. v. Wendover, 43 Fed. Rep. 420.

15—Pennsylvania Salt Mfg. Co. v. Meyers, 79 Fed. Rep. 87.

16—Hirst v. Denham, L. R. 14 Eq. 542.

17—Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707.

"Silver Grove," whiskey;¹⁸ "Six Little Tailors," tailoring firm's name;¹⁹ "Slate Roofing," paint;²⁰ "Sliced Animals," toys;²¹ "Social Register," directory;²² "Star," shirts;²³ iron,²⁴ oil,²⁵ soap,²⁶ lead pencils,²⁷ tobacco;²⁸ "St. James," newspaper,²⁹ or cigarettes;³⁰ "Sunlight," soap;³¹ "Swan Down," complexion powder;³² "Sweet Caporal," cigarettes;³³ "Sweet Opoponax of Mexico," perfume;³⁴ "Syrup of Red Spruce Gum," medicine.³⁵

"Tamar Indien," lozenges;³⁶ "The Good Things of Life," periodical;³⁷ "The Nile," playing cards registered as a print;³⁸ "Tidal Wave," tobacco;³⁹ "Tivoli," beer;⁴⁰ "Trilby," gloves;⁴¹ "Twin Brothers," yeast.⁴²

"Uneeda," biscuit.⁴³

18—Seltzer v. Powell, 8 Phila. 296.

19—Mossler v. Jacobs, 65 Ill. App. 571.

20—Re Glines, 8 Off. Gaz. 435.

21—Selchow v. Baker, 93 N. Y. 59.

22—Social Reg. Ass'n v. Howard, 60 Fed. Rep. 270; 67 Off. Gaz. 1448.

23—Morrison v. Case, 9 Blatchf. 548; 2 Off. Gaz. 544; Fed. Case No. 9845; Hutchinson v. Blumberg, 51 Fed. Rep. 829; Hutchinson v. Covert, 51 Fed. Rep. 832.

24—Dixon v. Jackson, 2 Scot. L. Rep. 188.

25—Re American Lubricating Oil Co., 9 Off. Gaz. 687.

26—Re Cornwall, 12 Off. Gaz. 138.

27—Faber v. Hovey, Codd. Dig. 79, 242; Seb. 481.

28—Liggett & Myer Tob. Co. v. Sam Reid Tob. Co., 155 Mo. 843; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883.

29—Giblett v. Read, 9 Mod. 459; Seb. 3; *Ex parte* Foss, Re Baldwin, 30 L. T. 354; 2 DeG. & J. 230; 27 L. J. Bkptcy. 17; 4 Jur. N.

S. 522; 21 L. T. 30; Seb. 159.

30—Kinney v. Basch, Seb. 542.

31—Lever Bros. (Ltd.) v. Pasfield, 88 Fed. Rep. 484.

32—Tetlow v. Tappan, 85 Fed. Rep. 774.

33—Kinney Tob. Co. v. Maller, 53 Hun, 340; 6 N. Y. Supp. 389; Hornbostel v. Kinney, 110 N. Y. 94, 17 N. E. Rep. 666.

34—Smith v. Woodruff, 48 Barb. 438.

35—Kerry v. Toupin, 60 Fed. Rep. 272.

36—Grillon v. Guenin, W. N. 1877, p. 14.

37—Stokes v. Allen, 9 N. Y. Supp. 846; 56 Hun, 526.

38—*Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209.

39—Sorg v. Welsh, 16 Off. Gaz. 910.

40—Berliner Brauerei Gesellschaft v. Knight, W. N. 1883, p. 70.

41—Re Holt & Co.'s Trademark (C. A.), L. R. (1891) 1 Ch. 711.

42—Burton v. Stratton, 12 Fed. Rep. 696.

43—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

“Valvoline,” lubricating oil;⁴⁴ “Vitascope,” machine.⁴⁵

“Vulcan,” matches.⁴⁶

“Waverly,” bicycles;⁴⁷ “Willoughby Lake,” scythe-stones;⁴⁸ Wistar’s Balsam of Wild Cherry,” medicine.⁴⁹

“Yankee,” soap.⁵⁰

§ 43. **Generic terms judicially defined.**—It is confusing to the student to be told that words indicating quality cannot be a valid trademark, and yet to be confronted by the physical fact and judicial dictum that the highest function of the trademark is its indication of quality. In a leading case Mr. Justice Field said that a trademark is “a sign of the quality of the article;”⁵¹ and in the leading case of *Amoskeag Manufacturing Co. v. Spear*, the learned court says that the trademark of a manufacturer “is an assurance to the public of the quality of his goods.”⁵² In the same opinion, however, the judge

44—Leonard v. White’s Golden Lubricator Co., 38 Fed. Rep. 922; Leonard v. Wells, L. R. 26 Ch. D. 288. *Per contra*, Re Horsburgh, 53 L. J. Ch. 237.

45—Vitascope Co. v. U. S. Phonograph Co. 83 Fed. Rep. 30.

46—Taendsticksfabriks Antiebolaget Vulcan v. Myers, 139 N. Y. 364.

47—*Ex parte* Indiana Bicycle Co., 72 Off. Gaz. 654.

48—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

49—Fowle v. Spear, 7 Pa. L. J. 176.

50—Williams v. Adams, 8 Biss. 452; Fed. Case No. 17711; Williams v. Spence, 25 How. Pr. 366; Williams v. Johnson, 2 Bos. 1.

51—Manhattan Medicine Co. v. Wood, 108 U. S. 218-222.

52—Amoskeag Mfg. Co. v. Spear (1849), 2 Sand. S. C. 599; Cox, 87; Seb. 100.

In a recent case Judge Bradford has called attention to the use of the word “quality” in the cases, and distinguished its two different meanings, in the following language:

“A trademark is designed to enable one legitimately to build up or protect his business, but not to deprive others of the right to use necessary or proper means for carrying on an honorable competition in trade. No one has a right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Canal Co. v. Clark, 13 Wall. 311, 324. Hence no one can acquire an exclusive right to the use, as a trademark, of a generic name, or word, which is merely descriptive of an article, or a sign, symbol, figure, letter,

(Duer) observes that the manufacturer "has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Were such an appropriation to be sanctioned by an injunction, the action of a court of equity would be as injurious to the public as it is now beneficial; it would have the effect in many instances of creating a monopoly in the sale of particular

brand, form or device, which either on its face or by association indicates or denotes merely grade, quality, class, shape, style, size, ingredients or composition of an article or a word or words in common use designating locality, section or region of country. The word 'quality' is used in different senses in the cases. It is employed in some to denote the grade, ingredients or properties of an article, and in others to indicate generally the merit or excellence of an article as associated with or coming from a certain source. While there can be no valid trademark as denoting quality when used merely in the former sense, there may be a valid trademark as indicating quality when used in the latter sense. Thus in *McLean v. Fleming*, 96 U. S. 245-253, the court said:

"Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trademark adopted and applied by him to the goods to distinguish them as being of a particular manufacture and quality,' etc.

"In *Medicine Co. v. Wood*, 108 U. S. 218, 222; 2 Sup. Ct. 439, the court said:

"He may thus notify the public of the origin of the article and secure to himself the benefits of any particular excellence it may possess from the manner or materials of its manufacture. His trademark is both a sign of the quality of the article and an assurance to the public that it is a genuine product of his manufacture.'

"In *Menendez v. Holt*, 128 U. S. 514, 520; 9 Sup. Ct. 144, the court, speaking of the words 'La Favorita' as applied to flour, said:

"It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article which had been determined by them to possess a certain degree of excellence. . . . And the fact that flour so marked acquired an extensive sale, because the public discovered that it might be relied on as of a uniformly meritorious quality, demonstrates that the brand deserves protection rather than it should be debarred therefrom, on the ground, as argued, of being indicative of quality only.'"

Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-657.

goods as exclusive as if secured by a patent, and freed from any limitation of time.”

In another early case the chancellor observed: “In respect to words, marks or devices which do not denote the goods or property or particular place of business of a person, but only the nature, kind or quality of the articles in which he deals, . . . no property in such words, marks or devices can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded.”¹ And in more recent cases the rule has been explained in somewhat similar terms. “It is true that no one can appropriate as a trademark the commercial name of an article which every man has the right to make and sell.”²

“No manufacturer can acquire a special property in an ordinary term or expression, the use of which as an entirety is essential to the correct and truthful designation of a particular article or compound. The courts have gone a long way, and with plain justice, in protecting the honest and enterprising manufacturer of any good and useful article from the unscrupulous pirating of his special reputation; but they have been equally careful to prevent any attempted monopoly of that which is common to all.”³

“Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trademark, and the exclusive use of it be entitled to legal protection. No one

1—*Stokes v. Landgraff*, 17 Barb. Phila. 226; *Price & Steuart*, 423, 608; *Cox*, 137; *Seb.* 121. 424.

2—*Dreydoppel v. Young*, 14 3—*Town v. Stetson*, 5 Abb. Pr. N. S. 218; *Cox*, 514, 515.

can claim protection for the exclusive use of a trademark or tradename which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed.”⁴

The fact that the article to which the trademark is applied has obtained such a wide sale that the mark has become indicative of quality, as well as of origin and ownership, is not of itself sufficient to render the mark *publici juris* and so deprive its owner of the right to relief against infringers.⁵

§ 44. The name given an unpatented invention by the inventor.—Such names clearly should, if otherwise unobjectionable, be treated as valid trademarks in the hands of the inventor or his assigns. Under the rule discussed in the next section, if the inventor patents his invention, he cannot lengthen his monopoly’s duration by applying a trademark to the patented article; his right to the trademark expires with the life of the letters patent. Where he elects to dedicate his invention to the public, his right to adopt a trademark for such specimens as he himself may manufacture, is obvious. But the name by which he distinguishes his invention, being the necessary name of the article, cannot be used by another, holding no assignment from the inventor.⁶

§ 45. Necessary name of a product.—The necessary name of a product, natural or manufactured, cannot be a trademark, for the reasons we have discussed. This is true of goods manufactured under a patent. The descriptive name by which they are known during the life of the letters patent becomes their popular name in the

4—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311-323; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327.

see Mfg. Co., 138 U. S. 537, 547; Burton v. Stratton, 12 Fed. Rep. 696.

5—Lawrence Mfg. Co. v. Tennessee, 131 Fed. Rep. 543.

6—H. B. Chaffee Mfg. Co. v. Selchow, 131 Fed. Rep. 543.

trade—the name by which they are necessarily known and distinguished. When, therefore, the protection of the patent has expired the name is *publici juris*, and the manufacturer under the letters patent can claim no trademark in it.⁷

Thus, the word “Linoleum” as applied to a kind of floor covering,⁸ “Singer” applied to sewing machines,⁹ and “Lanoline” applied to a wool-fat preparation,¹⁰ were held to be *publici juris* upon the expiration of the letters patent covering the articles to which they were applied.

Analogous to this class of cases is that where new combinations of old elements are found, and it is sought to distinguish such a new compound or combination by joining the descriptive names of its constituent elements. This is best illustrated by a case where the words claimed as trademark were “Ferro-phosphorated Elixir of Calisaya Bark,” which claim was distinctly negated by the New York Court of Appeals, Folger, J., saying: “They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him.”¹¹ For this reason the name “Acid Phosphate” applied to a medicinal preparation,¹² and “Indurated Fibre” applied to wares made of wood-pulp,¹³ are not valid trademarks; and the word “Bromo-Quinine” was refused registration

7—Centaur Co. v. Robinson, 91 U. S. 205; Singer Mfg. Co. v. June, Fed. Rep. 889; Same v. Neathery, 163 U. S. 169.
91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901.
The cases are collected, *ante*, § 39.

8—Linoleum Mfg. Co. v. Nairn. L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

9—Singer Mfg. Co. v. Bent, 163

10—Jaffe v. Evans & Sons, Ltd., 75 N. Y. Supp. 257.

11—Caswell v. Davis, 58 N. Y. 223-233.

12—Rumford Chemical Works v. Muth, 35 Fed. Rep. 524.

13—Indurated Fibre Co., v. Amoskeag Fibre Co., 37 Fed. Rep.

695.

as a trademark for medicines,¹⁴ as was also the word "Ferro-Manganese" as a mark for mineral waters,¹⁵ and the word "Bromo-Celery" for a medicinal preparation.¹⁶

There are cases, however, where such words or combinations of words have been held not to be descriptive. Thus the word "Cocaine" as applied to a hair wash compounded from cocoanut oil and other ingredients,¹⁷ and "Magnetic Balm" as applied to a medicinal compound,¹⁸ have been upheld as valid trademarks. The word "Electro-Silicon" applied to a polishing compound has also been upheld,¹⁹ and it appears very clear that the words "Magnetic" or "Electric" as used in the two cases last referred to are purely arbitrary and fanciful.

We have noted that the patent office has refused registration to an applicant offering the word "Bromo-Quinine" as the name of a medicinal preparation. This decision is in hopeless conflict with some of the adjudicated cases. The word "Bromidia," as a trademark for a chemical combination of chloral hydrate, bromide of potassium and other substances, was admitted to registration and subsequently upheld as valid, the court upon final hearing saying that the word "has no meaning whatever except as connected with complainants' business, and as associated with and indicative of a soothing or soporific mixture prepared and sold by them."²⁰ The word "Bromo-Caffeine" was admitted to registration, and upheld judicially, the Court of Appeals of New York saying, per Peckham, J., "We think there is a distinction between the facts in this case and that of *Caswell*

14—Re Grove, Newton, Dig. 192;
s. c., Ibid. 191; 67 Off. Gaz. 1447.

15—Re Excelsior Spring Co.,
Newton, Dig. 153.

16—Re Bromo-Celery Co., New-
ton, Dig. 190.

17—Burnett v. Phalon, 3 Keyes,
594.

18—Smith v. Sixbury, 25 Hun,
232.

19—Electro-Silicon Co. v. Trask,
59 How. Pr. 189; Electro-Silicon
Co. v. Hazard, 29 Hun, 369.

20—Battle & Co. v. Finlay (pre-
liminary hearing), 45 Fed. Rep.
796, (final hearing) 50 Fed. Rep.
106.

*v. Davis.*²¹ In this case the term perhaps suggests that some one among the hundreds of substances that bromine may combine with has been used in such combination together with caffeine. There are, however, some seven different ingredients in the plaintiff's preparation, and there is no free bromine among them, and there is no evidence as to what the substance is which the bromine (if any) had combined with before being used in the preparation, and so it is plain that the words 'Bromo-Caffeine' do not in fact describe the ingredients or even give any clear general idea as to what they are.'²² It is the general rule that "when an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable."²³

Under peculiar circumstances a mark, otherwise a valid trademark, will become the common property of two or more merchants, each of whom may have a right to its use, provided he so uses it as not to pass off his goods as those of one of the others entitled to use the mark. Thus a plaintiff was refused an injunction restraining the use of the mark "Aramingo Check" to designate printed cloth made at the Aramingo Mills, where the defendant showed that the cloth sold by him under the mark was the product of the same mills, and the labels used by the respective parties differed in size and color so that confusion could not result from their use.²⁴

§ 46. **Marks common to the trade.**—In a considerable number of cases, marks have been involved which, wholly or in part, are common to the particular trade in which

21—58 N. Y. 223, cited *supra*.

Battery Co. v. Western Elec. Co.,

22—Kearney v. Brooklyn Chemical Works, 142 N. Y. 467-476.

23 Fed. Rep. 276.

24—Colladay v. Baird, 4 Phila.

23—Wallace, J., in Leclanche

139; Cox' American Trademark Cases, 257.

they are used. It is obvious that this condition must, in many cases, have originated in infringement, or an attempt to prey upon the mark or dress of the first trader who adopted it: and that, in time, it became impossible to tell to whom the mark or dress belonged. Thus the "sawbuck" or "cross-bar" mark or brand has been found common to the tea-trade.²⁵

§ 47. **The trademarked article not a trademark.**—It is obvious that if a commercial article itself could constitute a trademark, there would be little use for patent laws. As Judge Carpenter said, "in the very nature of the case, * * * the trademark must be something other than, and separate from, the merchandise."²⁶

Nor can the article, by being colored, constitute a trademark. This is illustrated by the case in which it was sought to protect a bronzed horse-shoe nail as a trademark.²⁷ It is again illustrated by the attempts to hold as a trademark a "distinctively colored streak in a wire rope,"²⁸ or a "rose-colored metallic capsule" for a champagne bottle.²⁹

§ 48. **Packages as trademarks.**—It is equally obvious that a commercial package cannot be a trademark. In one of the early cases upon this rule, Judge Johnson said: "It appears that the ornamental tin pail which the plaintiff employs is a common article in commerce, and that pails made of tin, ornamented or unornamented, are and have long been in use for all such purposes as any one chose to apply them to. The question whether any one can seize upon such an article and make title to its exclusive use for a special purpose, by calling it a trademark, must be far from clear in favor of the claimant. The

25—Castle v. Siegfried, 103 Calif. 71, 37 Pac. Rep. 210.

26—Davis v. Davis, 27 Fed. Rep. 490, 492.

27—Putnam Nail Co. v. Dulaney, 140 Pa. 205.

28—A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 134 Fed. Rep. 571, Affirming s. c. 123 Fed. Rep. 152.

29—Mumm v. Kirk, 40 Fed. Rep. 589.

forms and materials of packages to contain articles of merchandise, if such claims should be allowed, would be rapidly taken up and appropriated by dealers, until some one, bolder than the others, might go to the very root of things, and claim for his goods the primitive brown paper and tow string, as a peculiar property. It will be observed, that it is not a mark at all which is claimed, but the whole enveloping package, the whole surface of which is covered by the ornamental pattern."³⁰

Nor can a package be made a trademark by being colored.³¹ Judge Coxe concisely embodied the rule in these words: "The trend of the law is strongly towards the proposition that, in ordinary circumstances, the adoption of packages of peculiar form and color alone, unaccompanied by any distinguishing symbol, letter, sign, or seal, is not sufficient to constitute a trademark."³²

§ 49. Method of arranging goods as trademark.—The arrangement of goods in a package can not constitute a trademark. Judge Welker said: "The complainants could not obtain a trademark * * * in the manner in which the gun might be placed in the boxes."³³ Judge Carpenter made the same ruling with reference to the arrangement of cakes of soap in red and yellow wrappers, the colors alternating.³⁴

The importance of these rulings has vastly decreased of late years, owing to the fact that all of these matters, packages, labels, and methods of packing, are now understood to relate only to proof of fraudulent intent in competition. No technical trademark right exists in either of them; in the abstract, they are each of common right. But like size, shape, form and color, each readily becomes

30—Harrington v. Libby, Fed. Co. v. Rouss, 40 Fed. Rep. 585, 587 Case No. 6,107, 12 Off. Gaz. 188.

33—Adams v. Heisel, 31 Fed.

31—Philadelphia Novelty Mfg. Rep. 279.

Co. v. Blakesley Novelty Co., 40 Fed. Rep. 588.

34—Davis v. Davis, 27 Fed. Rep. 490.

32—Philadelphia Novelty Mfg.

subservient as an instrumentality of fraud where unfair competition is intended. They enter into the litigation of today, not upon the theory that property is claimed in them, but merely as badges of fraud.

§ 50. **Words taken from the dead languages.**—Words from the dead languages have frequently been applied to merchandise and sustained as valid trademarks, as, for example, the Greek “Eureka” as a mark for shirts³⁵ or for a fertilizing material,³⁶ and the Latin “Excelsior” for stoves³⁷ or soap.³⁸ The Latin phrase “Ne Plus Ultra” was invalid as a trademark solely because the plaintiff did not show exclusive user in himself, and the words and an accompanying device were found to be common to the trade.³⁹ It has been said by the Canadian supreme court that there can be property in a word of a dead language even if it be expressive of quality,⁴⁰ but this dictum is incorrect, as appears from the authorities reviewed in the next succeeding section. A descriptive word from a dead language cannot be other than a generic term when used as a mark for goods. Thus, on an application for registration for the word “Sanitas” for medicines, Kay J., remarked: “The truth is that if this word were applied to medicines, it would mean to any ordinary person that the medicines were health medicines; that is, health-giving medicines; and that is descriptive of the quality or of the effect of the use of these medicines. How is it possible that it is not descriptive?”⁴¹

35—Ford v. Foster, L. R. 7 Ch. D. 611.

36—Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115, Fed. Case No. 206.

37—Sheppard v. Stuart, 13 Phila. 117; Price & Steuart, 193.

38—Braham v. Bustard, 1 H. & M. 447. “Excelsior” applied to gun-cotton goods was not upheld. Steinthal v. Samson, Seb. 546.

39—Beard v. Turner, 13 L. T. N. S. 746; Seb. 251.

40—Partlo v. Todd, 17 Can. S. C. R. 196.

41—Re Sanitas Co., 4 R. P. C. 533; 58 L. T. 166; Cartmell, 305.

Similar reasoning forbade the registration of “Somatose” as a trademark for a nourishing meat product; the Greek “Soma,” genitive “Somatos,” being the equiva-

§ 51. **Words and phrases from modern foreign languages.**—This topic has been fruitful of conflicting holdings. It is not settled what character of words so taken will be sustained as valid trademarks.

The English courts have consistently adhered to the rule announced by Chitty, J., in *Davis v. Stribolt*: "I am of the opinion that in reference to an article produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy name within the meaning of the act." For these reasons the Norwegian words "Bokel" and "Bokol" (meaning "beer") were held not valid as trademarks for beer.⁴²

A curious case is that of *Re Rotherham*. The house of Rotherham of Coventry had long made and exported watches to Tod & Co. of Alexandria, by whom they were sold, such watches bearing upon their dials the word "Tod" in Arabic characters; "Tod" as an Arabic substantive meaning "A high mountain." The Arabic word was registered as a trademark, Vice-Chancellor Bacon holding an order of the commissioners prohibiting registration of words in foreign languages invalid.⁴³

The phrase "Flor Fina Prairie Superior Tabac" was held to be a valid trademark for cigars,⁴⁴ as have been the words "Tamar Indien" for lozenges,⁴⁵ "Intimidad" for cigars,⁴⁶ "El Destino," also for cigars,⁴⁷ "El Cabio"

lent of the English "body;" "so-mat" being the root of many English words and "ose" a common English suffix. *Re Farben-fabriken T. M. K.*, L. R. (1894) 1 Ch. D. 645.

42—*Davis v. Stribolt*, 59 L. T. 854; *Cartmell*, 105.

43—*Re Rotherham*, 29 W. R. 503; *Seb.* 647.

44—*Cope v. Evans*, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453; *Seb.* 433.

45—*Grillon v. Guenin*, W. N. 1877, p. 14; *Seb.* 532.

46—*Caruncho v. Stephenson*, 25 Sol. J. 929.

47—*Pinto v. Badman*, 8 R. P. C.

181; *Cartmell*, 270.

for tobacco,⁴⁸ and "La Favorita" for flour.⁴⁹ "Mazawattee," a compound of the Hindustani words "Maza," meaning taste or relish, and the Singalese "Wattee," meaning garden or estate, is a valid trademark because it conveys no meaning to any class of persons, English, Hindoo or Singalese, and has no reference to the quality of the goods.⁵⁰

With reference to "Pepto-Mangan," used as a mark for a medicinal preparation, Judge Holt has said, "It seems, if analyzed by a person familiar with the Greek and German languages, somewhat descriptive, but I think it would seem to the general public to be an artificial and manufactured word."⁵¹

The rules thus far discussed in this section do not seem to apply to aboriginal words or sounds. The word (or sound) "Oomoo," taken from the language of the Australian aborigines, was admitted to English registration by Chitty, J., after a careful consideration;⁵² on the other hand, the word "Kokoko," meaning "owl" in the language of the Chippeway Indians, was refused registration as a trademark for cotton goods.⁵³

It was held in a dictum of the supreme court of Canada, in the very thoroughly considered case of *Partlo v. Todd*, that a descriptive foreign word, or a word in a dead language not known to people in general, because it is not understood, may become the trademark of the person who first uses it upon a particular article sold by him.⁵⁴ This theory has been affirmed by a New York state court and denied by Judge Showalter in the federal circuit court for the Northern District of Illinois, in two

48—*Solis Cigar Co. v. Pozo*, 16 Colo. 388; 26 Pac. Rep. 556.

49—*Menendez v. Holt*, 128 U. S. 514.

50—*Re Densham*, L. R. (1895) 2 Ch. D. 176.

51—*M. J. Brietenbach Co. v. Spangenberg*, 131 Fed. Rep. 160.

52—*Re Burgoyne*, 6 R. P. C. 227; 61 L. T. 39; *Cartmell*, 85.

53—*Re Jackson Company's Trademark*, 6 R. P. C. 80; *Cartmell*, 177.

54—*Partlo v. Todd*, 17 Can. S. C. R. 196-213.

suits of the same complainant, involving the right to the word "Matzoon" as a trademark for a food product made of fermented milk. "Matzoon" or "Maadzoon" appears to be the sound of the name which Armenians give to a similar article made of fermented milk in Turkey. The New York court says: "I do not think that such a term can properly be regarded as descriptive in this country. It would be absolutely meaningless to all but a little group of Armenians in the millions of inhabitants of the United States. It would be equally meaningless in most of Europe. A Choctaw word would signify just as much. To the medical profession, among whom the plaintiff sought approval for his product, and to the drug trade, the name 'Matzoon' was practically an arbitrary or fanciful designation. It was not incorporated into the English language. It was derived from a language hardly known here, and to the vast majority of our people it meant nothing. Hence the rule upon which the defendant relies has no application here." It was accordingly held to be a valid trademark.⁵⁵ That this rule is dangerous to the law of trademarks is apparent. If it is left to the courts to say when a descriptive word taken from a modern foreign language may or may not be used as a trademark, practically endless litigation is opened to future generations. The court forgot the rule that a trademark must be capable of universal use, and knows no territorial restriction.⁵⁶ As Chitty, J., remarked in *Davis v. Stribolt*: "If the argument were well founded, the importer into this country of any foreign article not previously known in this country could restrain any one else from using the name by which it was called in the country in which it was produced."⁵⁷ Upon the application to Judge Showalter for a prelimin-

55—*Daddirrian v. Yacubian*, 37 N. Y. Supp. 611.

57—*Davis v. Stribolt*, 59 L. T. N. S. 854, cited *supra*.

56—Subject to the exceptions noted *ante*, § 13.

any injunction to restrain the use of the same word "Matzoon," that learned court said: "The strong contention is that Dr. Dadirrian introduced into this country a product which was unknown here, and by a name which was equally unknown, and that, since the name has become identified here with the article as made by him his property in the name should be recognized. But, as already said, the product was in fact old, as was also the name. The ignorance of people in this country touching it, its uses and its name, cannot be treated as property, and be, in a manner, capitalized as an element in the good-will of this complainant. This would be the case if no other dealer was permitted to tell what Matzoon is, and what a considerable portion of the human race has found it useful for, after an experience with it under that name which, according to the record, dates back some eight centuries." The application was accordingly denied, and the ruling of the trial court was followed in the first circuit and subsequently upheld by the United States circuit court of appeals for that circuit.⁵⁸

The German word "Ansatz," meaning "Compound," has been refused registration as a trademark for bitters,⁵⁹ as have been the words "Chili Colorow" (meaning red pepper in provincial Spanish), as a trademark for condiments.⁶⁰

Vice-Chancellor Shadwell held a complainant who marked watches manufactured by him for the Turkish trade with the Turkish word "Pessendede" (meaning warranted) in Turkish characters, entitled to the exclusive right to so mark his watches. This was, however,

58—Dadirrian v. Yacubian, 72 Fed. Rep. 1010-1014; 75 Off. Gaz. 1856; followed in Dadirrian v. Yacubian (2), 90 Fed. Rep. 812. Latter case affirmed on appeal, Dadirrian v. Yacubian (3), 98 Fed. Rep. 872, 39 C. C. A. 321. Followed in Selchow v. Chaffee & Selchow Mfg. Co., 132 Fed. Rep. 996.
59—Re Weisman, Newton, Dig. 119.
60—Re Railton, Newton, Dig. 213.

not necessary to the decision of the case, and was a mere dictum.⁶¹

The case of *Broadhurst v. Barlow* was that of plaintiffs who used, beside a symbol of a lion in a scroll, the words "Exactly 12 Yards," in Turkish, Armenian and Greek, upon the rolls of cloth made by them for exportation to Greece and Turkey. With other relief, the defendant was enjoined from using the words "exactly 12 yards" in the languages used by plaintiffs. This relief would seem to be incidental to the portion of the injunction which related to fanciful scrollwork used by both parties.⁶²

The use of the word "Grenadine" as a trademark for a syrup made of pomegranate juice was protected by injunction against a defendant who began the sale of another syrup under the name of "Grenade Syrup," notwithstanding the word "Grenade" in French signifies "Pomegranate." This was purely a case of unfair competition.⁶³ The patent office has refused registration for the words "Fur Familien-Gebrauch" (For Family Use) and "Lawrence Feiner Familien-Flannel" (Lawrence Fine Family Flannel), but upon the ground that they were mere words in common use and not distinctive.⁶⁴ And it is now the fixed rule of that office that no descriptive words reproduced in letters from a foreign language will be admitted to registration, when registration would be refused to their English equivalents.⁶⁵

61—*Gout v. Aleploglu*, 6 Beavan, 69; 5 Leg. Obs. 495; Seb. 51.

62—*Broadhurst v. Barlow*, W. N. 1872, p. 212; L. J. Notes of Cases, p. 183; Seb. 411. The use of labels printed in several languages was enjoined in *Siegert v. Findlater*, L. R. 7 Ch. D. 801; *Siegert v. Ehlers*, Seb. 432; *Curtis v. Bryan*, 2 Daly, 212; *Cox*, 434, *Siegert v. Abbott* (2), *Cox*, Manual, 718; *Societe Anonyme v. Western Distilling Co.*,

43 Fed. Rep. 416; *Fischer v. Blank*, *Cox*, Manual, 731, 138 N. Y. 244.

63—*Rillet v. Carlier*, 61 Barb. S. C. 435; 11 Abb. Pr. N. S. 186; Seb. 334. The word "Ethiopian" printed in Egyptian characters upon stockings was protected from infringement, but in a case of unfair competition. *Hine v. Lart*, 10 Jur. 106; 7 L. T. 41.

64—*Re Lawrence & Co.*, 10 Off. Gaz. 163; Seb. 504.

65—*Ex parte Stuhmer*, 86 Off.

§ 52. **Words become generic through use.**—A word originally fanciful and indicative of origin or ownership may through the laches of the owner become *publici juris*. Thus the word “Chlorodine,” while originally a good trademark, became generic through the failure of the manufacturer to prosecute a suit brought by him to restrain its use,⁶⁶ and because it had become the name of the article.⁶⁷ This, of course, is substantially a holding that the trademark has been abandoned by the owner’s neglect. The American courts have been averse to so holding. It was said in *Taylor v. Carpenter* that the court was “not aware that a neglect to prosecute, because one believed he had no rights, or from mere procrastination, is any defense at law, whatever it may be in equity, except under the statute of limitations pleaded and relied on, or under some positive statute, like that as to patents, which avoids the right if the inventor permits the public to use the patent some time before taking out letters.”⁶⁸ Words primarily indicative of origin or ownership remain valid as trademarks notwithstanding the fact that the articles to which they are applied may obtain such extensive sales that the marks have also become indicative of quality.⁶⁹

Gaz. 181. In this case the applicant sought registration for the words “Gold Label” produced in Hebrew characters.

66—*Browne v. Freeman* (1), 12 W. R. 305; 4 N. R. 476.

67—*Browne v. Freeman* (2), W. N. 1873, 178; *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541.

In this case the controlling fact was that the complainant’s and defendant’s marks were used on different classes of goods. The court, however, expressly names the laches of the complainant as a

ground for withholding relief, citing, in support of this proposition, *inter alia*, the opinion of Chancellor Walworth in *Smith v. Adams*, 6 Paige, 435-443; and the copyright case of *Lewis v. Chapman*, 3 Beavan, 133, where a delay of six years was held to disentitle the plaintiff from relief.

68—*Taylor v. Carpenter*, 2 Wood. & M. 1; 9 L. T. 514; Cox, 32.

69—*Burton v. Stratton*, 12 Fed. Rep. 696-702; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537-547.

Whether or not a word has become public property, in that it has acquired a generic meaning, descriptive of a general kind, quality, or class of goods is a pure question of fact to be determined from the evidence in each particular case.⁷⁰

§ 53. **The use of generic names protected.**—Possibly the widest deviation from the narrow path of trademark protection which has been accomplished by the law of unfair competition is to be found in the cases involving the deceptive use of generic terms. The supreme court of the United States has held in regard to the name of a person used as a descriptive name of a patented article, during the life of a patent, that while that name becomes *publici juris* upon the expiration of the patent, it must be so used by manufacturers other than the original maker as not to deceive the public into the belief that the goods offered for sale are the goods of such original maker.⁷¹ The same rule has been established in England.⁷²

So it was held by Mr. Justice McKenna, when circuit judge, that "Syrup of Figs" was entitled to injunctive protection. He said: "Respondent urges that the words 'Syrup of Figs' are descriptive, and that complainant deceives when it uses them to designate its compound. The deceit does not appear on the face of the bill, and it is unimportant if they are descriptive. The question is now, not whether complainant has the exclusive right to use the words 'Syrup of Figs' or 'Fig Syrup,' but it is whether respondent has, by use of them and other words, and by the other imitations alleged and exhibited, so far imitated the form of complainant's device and descrip-

70—Williams Mfg. Co. v. Noera, & Co., 39 Fed. Rep. 209; Singer 158 Mass. 110, 32 N. E. Rep. 1037. Mfg. Co. v. Brill, Cox, Manual.

71—Singer Mfg. Co. v. June Mfg. 672.

Co., 163 U. S. 169; Singer Mfg. Co. 72—Singer Mfg. Co. v. Loog, H. v. Bent, 163 U. S. 205. See, also, L. 8 A. C. 15; 53 L. J. Ch. 481; 48 to the same effect, Fairbanks v. L. T. 3; 31 W. R. 325; Cartmeil, Jacobus, 14 Blatchf. 337; Fed. 306. Case No. 4608. Adeo v. Peck Bros.

tion to represent its goods as its goods, and appropriate its reputation and trade. The *gravamen* of the action is the simulation of complainant's devices and the deception of purchasers. This is the principle of the best considered cases, uniting them, notwithstanding their diverse facts."⁷³

In affirming the decision of Judge McKenna, however, the circuit court of appeals held that "Syrup of Figs" was not a generic name.⁷⁴ The later case of *California Fig Syrup Co. v. Worden*⁷⁵ put the plaintiff's right to relief upon the proper ground of unfair competition, aside from any technical trademark right in the words.

From the doctrine stated by the federal supreme court⁷⁶ it follows that the designs, symbols and marks used by a patentee during the life of the patent upon packages containing the patented article may not be imitated by another upon the expiration of the patent, and such imitation will be enjoined.⁷⁷

The rule of unfair competition, that no man has a right to represent his goods as the goods of another, is dis-

73—*California Fig Syrup Co. v. Improved Fig Syrup Co.*, 51 Fed. Rep. 296-297, citing *Burton v. Stratton*, 12 Fed. Rep. 696; *Baking Powder Co. v. Fyfe*, 45 Fed. Rep. 799; *Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205; *Anonyme, etc., Societe v. Western Dis. Co.*, 43 Fed. Rep. 417.

74—*Improved Fig Sprup Co. v. California Fig Syrup Co.*, 54 Fed. Rep. 175-178. It is very difficult to understand how the court could conclude that "Syrup of Figs" was not a generic name. It lacks every requisite of a valid trademark, and is undoubtedly either deceptive or merely descriptive of one of the ingredients of the medicine (a liquid laxative.) It has been so held in *California Fig Syrup Co. v.*

Stearns, 67 Fed. Rep. 1008; s. c., 73 Fed. Rep. 812-814; *California Fig Syrup Co. v. Putnam*, 66 Fed. Rep. 750. Since the foregoing was written, the United States Supreme Court has held the mark to be deceptive. *Clinton E. Worden & Co. v. California Fig Syrup Co.*, 187 U. S. 516.

75—(1) 86 Fed. Rep. 212-215; *California Fig Syrup Co. v. Worden* (2), 95 Fed. Rep. 132.

76—*Singer Mfg. Co. v. June*, 163 U. S. 169; *Singer Mfg. Co. v. Bent*, 163 U. S. 205.

77—*Greene v. Woodhouse*, 38 Off. Gaz. 1891; *Centaur Co. v. Killenberger*, 87 Fed. Rep. 725; *Same v. Robinson*, 91 Fed. Rep. 889; *Same v. Neathery*, 91 Fed. Rep. 891; *Same v. Hughes Bros. Mfg. Co.*, 91

tinently applied in several of the more recent English decisions to terms strictly generic and of which technical trademark rights could not be predicated. Thus where the manufacturers of "Reddaway Camel Hair Belting" sought to enjoin a rival manufacturer from styling his product "The Bentham Camel Hair Belting," Lord Justice Lindley, in the court of appeal, said: "The catch-words are 'Camel Hair Belting.' * * * The use of the catch-words alone may establish the plaintiff's right to relief. The plaintiffs have no right to the exclusive use of these words; but they have a right to restrain any one from so using them as to pass his goods off as the goods of the plaintiffs."⁷⁸ So an injunction was granted. Very similar to this was the case in which the plaintiffs manufactured a soap under the name "The Self-Washer." The defendants thereafter applied the term "Self-washing" to their soaps. It was held that the terms "Self-washer" or "Self-washing" were used in a descriptive sense and therefore neither could be appropriated as a valid technical trademark; but because of the paper used by the defendants in wrapping their soap, being an imitation parchment paper, and the type used by them, which closely resembled that used by the plaintiffs, the defendants were enjoined, Lord Justice Cotton, in the court of appeal, observing: "There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing off, the defendants' soap as the plaintiffs', then, although the plaintiffs have no monopoly either in 'Self-washing' or 'Self-washer' or in the parchment paper or in the spaced printing, yet if those

Fed. Rep. 901. In this connection with the prefix "original." *Cocks v. Chandlers*, L. R. 11 Eq. 447.
 78—*Reddaway v. Bentham Hemp Spinning Co.*, 9 R. P. C. 503; L. R. (1892) 2 Q. B. 639; 67 L. T. 301; *Cartmell*, 282.

things in which they have no sole right are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common-law doctrine in respect of which equity will give to the aggrieved party an injunction in order to restrain the defendant from passing off his goods as those of the plaintiff."⁷⁹

These cases, with those cited in the foot-note, will sufficiently demonstrate the fact that the rule under consideration is not only important but well established, and that the user of a strictly generic term will be protected in the business he has established under that term, as against a dishonest use of it by a competitor.⁸⁰

The doctrine of unfair competition, by which the use of descriptive words has sometimes been restrained, has engrafted upon it this important qualification—that in no case will the use of a merely descriptive word be restrained as deceptive, unless in circumstances which show fraud on the part of the user.⁸¹ The English leading cases upon this proposition are the "Camel Hair Belt-ing" case,⁸² to which we have already referred, and the "Cellular Clothing" case.⁸³ In the former case the defendant said expressly that by using the term "Camel

79—Lever v. Goodwin, 4 R. P. Co., 58 Fed. Rep. 884; Morgan Envelope Co. v. Walton, 86 Fed. Rep. 492-506; 36 Ch. D. 1; 57 L. T. 583; 36 W. R. 177; Cartmell, 209.

80—Lever v. Bedingfield, 80 L. T. N. S. 100; Barlow v. Johnson, 7 R. P. C. 395; Cartmell, 73; Curtis v. Pape, 5 R. P. C. 146; Cartmell, 105; Jay v. Ladler, 6 R. P. C. 136; 40 Ch. D. 649; 60 L. T. 27; 37 W. R. 505; Cartmell, 184; Powell v. Birmingham Vinegar Brewery Co., L. R. (1894) 3 Ch. D. 449-462; Reddaway v. Banham, L. R. (1896) A. C. 199; Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; Jennings v. Johnson, 37 Fed. Rep. 364; Meyer v. Bull Medicine

Co., 58 Fed. Rep. 884; Morgan Envelope Co. v. Walton, 86 Fed. Rep. 605; VanHorn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326; Goodman v. Bohls, 3 Tex. Civ. App. 183; 22 S. W. Rep. 11.

81—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-341.

82—Reddaway v. Banham, L. R. (1896) A. C. 199.

83—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

Hair Belting'' he would be enabled to sell his goods as those of the plaintiff. Each case involved the use of a descriptive word. In the belting case, however, the word had acquired an additional meaning. The mere use of the words ''Camel's Hair'' had come to be understood in the trade as indicating belting of the plaintiff's manufacture. It was proved in addition to this that the defendant's acts were done in consummation of a fraudulent design to sell his goods as those of the plaintiff. For these reasons the use of the word by the defendant was restrained.⁸⁴ The Cellular Clothing case differed from this on the facts. As in the belting case, the words ''Cellular Clothing'' were originally purely descriptive, being applied to a cloth of cellular structure. It was not shown that the term had so acquired a technical and secondary meaning, arising from its natural meaning, that it could be excluded from the use of every one else,⁸⁵ and it was not shown that the defendant had intended to defraud the plaintiff, or that any one had bought of the defendant in the belief that he was getting plaintiff's goods.⁸⁶ The Cellular Clothing case demonstrates very clearly that one who takes upon himself to prove that words which are merely descriptive or expressive of the quality of the goods have acquired a secondary meaning and indicate that the goods are of his manufacture has assumed a burden which, while it is not impossible, is, in the language of Lord Davey, ''at the same time extremely difficult to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word, not significant and not descriptive, but what has been compendiously called a 'fancy' word.'⁸⁷

84—See opinion of Lord Halsbury in *Cellular Clothing Co. v. Maxton*, L. R. (1899) A. C. 326-337.

Maxton, L. R. (1899) A. C. 326-335, and *Reddaway v. Banham*, L. R. (1896) A. C. 199, 204-205. 86—Lord Watson in *Cellular Clothing Co. v. Maxton*, L. R. (1899) 326-337.

85—Lord Halsbury in *Cellular* 87—Lord Davey in *Cellular*

§ 54. The test of "origin or ownership."—One of the primary methods—if indeed it is not the fundamental test—in determining the validity of a trademark has been broadly announced by the supreme court of the United States in these words: "The office of a trademark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer."⁸⁸ And it has recently been said: "That such mark or symbol (i. e., any mark or symbol claimed as trademark) must be designed, as its primary object and purpose, to distinguish each of the articles to which it is affixed from like articles produced by others, seems to be the clear consensus of all the cases which are authoritative."⁸⁹

Substantially this form of expression has been employed by the American courts from their earliest trademark decisions. Our profoundly learned chancellor, Walworth, stated the rule as well as any court that has followed him, when he said: "The court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade or business. And that having appropriated to himself a particular label, or sign or trademark, indicating to those who wish to give him their patronage that the article is manufactured or sold by him, or by his authority, or that he carries on business at a particular place, he is entitled to protection against a defendant who attempts to pirate upon the good-will of the complainant's friends or customers, or the patrons of his trade or business, by sailing under his flag without

Clothing Co. v. Maxton, L. R. Co., 91 Fed. Rep. 376-378, citing (1899) 326-343. Delaware & Hudson Canal Co. v.

Clark, 13 Wall. 311; Amoskeag Mfg. Co. v. Trainer, 101 U. S. 54; L. T. 135; 1 Off. Gaz. 279; Seb. Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; Columbia

89—Lurton, J., in Deering Harvester Co. v. Whitman-Barnes Mfg. Mill Co. v. Alcorn, 150 U. S. 460.

his authority or consent.”⁹⁰ In the light of this statement, the words of the supreme court assume a broader meaning. In 1849, the year following that in which the opinion last quoted from was rendered, it was said in an opinion of the superior court of New York City, that “the owner of a trademark has no right to an exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods.”⁹¹ And the same court, by the same judge (Duer), repeated the statement in very nearly the same words in 1857, saying that a name could be rightfully used and protected as a trademark only “where the name is used merely as indicating the true origin or ownership of the article offered for sale, never where it is used to designate the article itself and has become, by adoption and use, its proper appellation.”⁹² And in 1868 the supreme court of California stated the rule to be that trademarks will be protected “only so far as such marks serve to designate the true origin or ownership of the goods to which they are attached.”⁹³ So that when the doctrine as first stated by the federal supreme court was announced, it had become well settled in our jurisprudence that a trademark must indicate origin or ownership, and the only difficulty presented by the maxim to bench and bar is that of its application to each new state of facts as it arises. It must be noted, however, that “it is, of course, no fatal objection to the validity of a trademark that it does not include the name of the manufacturer or producer. The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the

90—Partridge v. Menck, 2 Sand. Pr. 144; 13 How. Pr. 385; Cox, Ch. 622; 2 Barb. Ch. 101; 1 How. 180; Seb. 144.

App. Cas. 558; Cox, 72; Seb. 91. 93—Falkinburg v. Lucy, 35 Cal.

91—Amoskeag Mfg. Co. v. Spear, 52; and Eggers v. Hink, 63 Cal. 2 Sand. S. C. 599; Cox, 87; Seb. 445. See also Osgood v. Allen 100. (Maine), 1 Holmes, 185; 6 Am. L.

92—Fetridge v. Wells, 4 Abb. T. 20; 3 Off. Gaz. 124; Seb. 410.

essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source.”⁹⁴

It is self-evident that while a mark may be indicative of origin and ownership, it may, because generic or deceptive, fall short of being a valid trademark. But every valid trademark must be indicative of origin or ownership in the sense in which those words are used in the decisions.

§ 55. **Geographical names.**—The rule that geographical names cannot be exclusively appropriated for the purposes of trademark has been recognized from the infancy of trademark law. It was said by the United States supreme court that “No one can apply the name of a district of country to a well-known article of commerce and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trademark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it.”⁹¹

94—Lurton, J., in *Deering Harvester Co. v. Whitman & Barnes Mfg. Co.*, 91 Fed. Rep. 376-380. To the same effect see *Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-656.

1—*Delaware & Hudson Canal Co. v. Clark*, 13 Wall. 311; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327; and to the same effect, see *Columbia Mill Co. v. Alcorn*, 150 U. S. 460; *Candee, Swan & Co. v. Deere & Co.*, 54 Ill. 439; 5 Am. Rep. 125; 4 Am. L. T. 266; 10 Am. L. Reg. N. S. 694; Seb. 339; *Re Tolle*, 2 Off. Gaz. 415; Seb. 405; *Osgood v. Allen*, 1 Holmes, 185; 6

Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410; *Glendon Iron Co. v. Uhler*, 75 Pa. St. 467; 15 Am. Rep. 599; 13 Am. L. Reg. N. S. 543; 6 Off. Gaz. 154; Seb. 439; *Bulloch, Lade & Co. v. Gray*, 19 Journ. of Jurisp. 218; Seb. 452; *Wolfe v. Goulard*, 18 How Pr. 64; *Clinton Met. Paint Co. v. N. Y. Met. Paint Co.*, 50 N. Y. Supp. 437; *Gabriel v. Sicilian Asphalt Co.*, 52 N. Y. Supp. 722; *Morgan Envelope Co. v. Walton*, 86 Fed. Rep. 605; *Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co.*, 11 Fed. Rep. 495; *Burgess v. Burgess*, 17 Eng. L. & Eq. 257; *Brooklyn White Lead Co. v. Masury*, 25 Barb.

§ 56. **As employed by sole owner of a natural product and its place of production.**—There can be no doubt that, where the owner of a geographical site productive of a salable article is the sole owner, he may have an exclusive right in the name of his site. This rule has been followed in several cases where the proprietor of the commodity was the owner of the place of its production, and the name of that place was a prominent and controlling part of the trademark. Lord Cranworth so held in the case of a wine-grower who used the name of his vineyard as a trademark for his wines.² And the use of the words "Congress Water" as designating the product of "Congress Spring" was sustained on the suit of the sole owner of the springs.³

§ 57. **When geographical names will be protected as trademarks.**—In many cases the use of geographical words has been protected on the ground of unfair competition. It was so held where the complainants applied the word "Durham," the name of a town in North Carolina, to tobacco manufactured by them at that locality.

416; *Lea v. Wolff*, 13 Abb. Pr. N. S. 389; 15 Id. 1; 46 How. Pr. 157; 1 Am. L. T. N. S. 400; Seb. 407; *Carmichel v. Latimer*, 11 R. I. 395; *Eggers v. Hink*, 63 Cal. 445; *Dunbar v. Glenn*, 42 Wis. 118; *Anheuser-Busch Brewing Association v. Pisa*, 23 Blatchf. 245; *Lea v. Deakin*, Fed. Case No. 8154, 11 Biss. 23; *Pratt's Appeal*, 117 Pa. St. 401; *Smith v. Walker*, 37 Mich. 456; *Smith v. Imus*, 32 Alb. L. J. 455; *Burton v. Stratton*, 12 Fed. Rep. 696; *Evans v. Van Laer*, 32 Fed. Rep. 153; *Gabriel v. Sicilian Asphalt Co.* (2), 56 N. Y. Supp. 30; *Gebbie v. Stitt*, 31 N. Y. Supp. 102; *Weyman v. Soderberg*, 108 Fed. Rep. 63; *Telephone Mfg. Co. v. Sumter Mfg. Co.*, 63 S. C. 313, 41 S. E. Rep. 322. Even

though the word "Raleigh" was that of an historical personage, registration was refused because it was also a geographical name. *Ex parte Oliver*, 18 Off. Gaz. 923; *Price & Steuart*, 59.

2—*Seixo v. Provezende*, L. R. 1 Ch. 192; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

3—*Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 4 Am. L. T. 168; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; 45 N. Y. 291; *Cox*, 599; to the same effect, see *La Republique Francaise v. Schultz*, 57 Fed. Rep. 37; *City of Carlsbad v. Kutnow*, 68 Fed. Rep. 794; s. c., 71 Fed. Rep. 167; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469; *Northcutt v. Turney*, 101 Ky. 314; 41 S. W. Rep. 21.

The defendant, whose business was conducted at Richmond, was enjoined from applying the word to tobacco produced by him.⁴ And the usual rule by which geographical names have been protected against infringers by injunction was thus tersely stated by the patent office: "Undoubtedly courts of equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiffs."⁵ Probably a more accurate statement, however, is that of the United States circuit court of appeals in the very well considered opinion in *Pillsbury-Washburn Co. v. Eagle*.⁶ "The distinction, both in the English and American cases, is between those where a geographical name has been adopted and claimed as a trademark proper, and those where it has been adopted first as merely indicating the place of manufacture, and afterwards, in the course of time, has become a well-known sign and synonym for superior excellence. In the latter class of cases, persons residing at other places will not be permitted to use the geographical name so adopted as a brand or label for similar goods for the mere purpose, by fraud and false represen-

4—*Blackwell & Co. v. Dibrell & Co.*, 3 Hughes, 151, Fed. Case No. 1,475; *Price & Steuart*, 10.

5—*Ex parte Farnum & Co.*, 18 Off. Gaz. 412; *Price & Steuart*, 68.

6—86 Fed. Rep. 608, 30 C. C. A. 386; overruling s. c., 82 Fed. Rep. 816. The false use of a geographical name will not be tolerated when it is so used as to promote unfair competition and to induce the sale of spurious goods. *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693.

"Whatever might have been the doubts some years ago, we think that now it is pretty well settled

that the plaintiff, merely on the strength of having been first in the field may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names' and advertisements from deceitfully diverting the plaintiff's custom." This was said of the word "Waltham" as applied to watches by *Holmes, J., in American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85; 53 N. E. Rep. 141; followed in *American Waltham Watch Co. v. Sandman*, 96 Fed. Rep. 330.

tation, of appropriating the good-will and business which long continued industry and skill and a generous use of capital has rightfully built up. It will be of no avail in such cases, where the facts are admitted or proven, to allege a want of power in a court of equity to find a remedy." In other words, geographical names can never be appropriated as trademark; but with the development of the law of unfair competition has come the incidental protection of geographical names applied to merchandise, not as technical trademark, but as an indication to the public of the true place of its manufacture. And no manufacturer can defend, any more than he could maintain, a suit in equity, where he is falsely representing the place where his manufacture is conducted.

§ 58. Geographical names—The underlying principle.

—Judge Lacombe has recently given this concise expression of the rule applied by courts of equity to geographical names falsely used in unfair competition: "Whatever may be the decisions in the state courts, it is abundantly settled by authority in the federal courts that they will not tolerate a false use of a geographical name when it is so used as to promote unfair competition and to induce the sale of spurious goods."⁷ In a later case, the rule has been illustrated and applied as follows: "The respondents concede that they put up in cans pears grown in Maryland and adjoining states, and keep the cans without labels until they are sold, and then, at the desire of their customers, they label them as California pears, canned by some pretended packer at some place in California. This is a clear case of fraudulent competition by the use of a geographical name which the complainants are entitled to use, but the respondents are not. It is true that no one single packer can acquire an exclusive right to use as a private trademark, 'California Pears,' or 'California,' as

⁷—Collinsplatt v. Finlayson, 88 Fed. Rep. 693.

a label on canned pears; but all the persons who put up California grown pears in California have a right to use it; and it has acquired, the bill alleges, an especial trade significance of value. With regard to articles of food, and particularly with regard to fruits, the place where they are grown creates often an essential distinction as to quality and flavor; and this distinction, when it has become known in trade by the geographical name of the place where grown, the growers of the fruit are entitled to the benefit of, and the consumers should not be deceived. The present is such a case, and presents, I think, indisputable ground for application of the equitable jurisdiction which prevents unfair and fraudulent competition by simulated trade designations.”⁸

The supreme court of the United States has clearly excluded geographical names from use as technical trademarks.

It was said by Mr. Justice Jackson: “The general principles of law applicable to trademarks, and the conditions under which a party may establish an exclusive right to the use of a name or symbol, are well settled by the decisions of this court, . . . which . . . establish the following general propositions: . . . (3) That the exclusive right to the use of the mark or device claimed as a trademark is founded on priority of appropriation; that is to say, the claimant of the trademark must have been the first to use or employ the same on like articles of production. (4) Such trademarks cannot

8—Morrow, J. in *California Fruit Cannery Ass’n v. Myer*, 104 Fed. Rep. 82, citing *Pillsbury-Washburn Co. v. Eagle*, 30 C. C. A. 336, 86 Fed. Rep. 608-618. The leading English case is the *Stone Ales Case*, *Thompson v. Montgomery*, (1891) App. Cas. 217; 8 R. P. C. 365. Of this decision a very learned English law writer has said: “There are dicta

in the *Stone Ales Case*, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured; but they must, it is submitted, be read by reference to the facts of the case, which was one of deliberate fraud.” Kerly on Trademarks (London, 1894), p. 44.

consist of words in common use as designating locality, section, or region of country.”⁹

The reasons for this rule have been more fully expressed by Mr. Justice Strong, in these words: “No one can claim protection for the exclusive use of a trademark or tradename, which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected; for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trademark, and the exclusive use of it be entitled to a legal protection. . . . He has no right to appropriate a sign, or a symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they cannot point to the origin (personal origin) of the articles of trade to which they may be applied. . . . It must be considered as sound doctrine that no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation.”¹⁰

Is it not a reasonable conclusion from these and the kindred cases which we have heretofore examined, that there can be no technical trademark in a geographical

9—Columbia Mill Co. v. Alcorn,
150 U. S. 460.

10—Delaware & Hudson Canal
Co. v. Clark, 13 Wall. 323.

name? To the author's mind that conclusion is inevitable, and there is but one class of geographical names which are to be excepted from the operation of the rule, namely, those applied to a natural product and its sole place of production. The name so used may very properly be a trademark, indicative of the origin and ownership of the natural product, and at the same time indicating the locality of its production. Here the name undoubtedly is a trademark if there is but one owner of the entire locality, and the courts have uniformly so held.¹¹ The same scientific objection to geographical names as trademark obtains as in the case of proper names. They are generic, in that every manufacturer who sees fit to locate [in that city or vicinage] and inaugurate a competing business has an equal right with all those who have preceded him in the locality, and all those who may thereafter so locate, in using the name of that locality in advertising his wares and in preparing them for commerce.¹²

Being generic they cannot be used as trademarks, with the one exception we have noted, that of the title to the entire locality being vested in one owner. In that case no one else can locate there and institute competition; the name of the locality is not generic, and that fact exempts it from the operation of the rule.

In the course of a well-considered opinion Judge Shonwalter has held the name "Elgin" as applied to watch-movements to be a strictly technical trademark, even though the name is that of the town where the factory is situated, because, in the words of the court: "This mark has this significance (designating complainants' manu-

11—City of Carlsbad v. Schultz, 78 Fed. Rep. 469; City of Carlsbad v. Kutnow, 71 Fed. Rep. 167, affirming 67 Fed. Rep. 794; Hill v. Lockwood, 32 Fed. Rep. 389; Northcutt v. Turney, 101 Ky. 314, 41 S. W. Rep. 21.

12—Blackwell v. Dibrell, Fed. Case No. 1475, 3 Hughes, 160; Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; New York Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212.

facture) where the town of Elgin is entirely unknown." But this is purely a dictum, and presented in a case of fraudulent competition, where the defendants had removed their factory from Chicago to Elgin "with the purpose . . . of giving some color of right to a designed trespass on complainant's good-will."¹³

§ 59. A false geographical name vitiates trademark.

—To all that has been said in the last preceding section must be noted one broad qualification. He who seeks to uphold a trademark in a court of equity must do so with clean hands, so that a trademark otherwise good will be vitiated and the right to it destroyed by the use of a false geographical name in connection with it.¹⁴ And this is true, as expressed by Judge Showalter, even though "No actual or substantial wrong may have resulted to any one from this misrepresentation."¹⁵

This rule, however, has its practical limitations. Like other forms of misrepresentation, it may be that the use of a geographical name, by one not residing or manufacturing within the locality named, amounts to a mere collateral misrepresentation. Thus, the fact that one of the mills of manufacturers who are joined in an action to restrain the fraudulent use of the name of the city in which they are situated, is situated outside the limits of the city, is not a bar to equitable relief, when the mill is practically a portion of a plant the remainder of which is within the city.¹⁶

There is a class of words usually treated as "geograph-

13—Elgin Nat. Watch Co. v. Illinois Watch Co., (1) 89 Fed. Rep. 487. Reversed on jurisdictional grounds, Illinois Watch Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667; 35 C. C. A. 237; the latter decision affirmed in Elgin Nat. Watch Co. v. Illinois Watch Co. (2), 179 U. S. 665.

14—Manhattan Med. Co. v.

Wood, 108 U. S. 218; and cases cited *ante*, § 34.

15—Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376-382. To same effect, see American Cereal Co. v. Eli Pettijohn Cereal Co. (1), 72 Fed. Rep. 903, 908.

16—Pillsbury-Washburn Flour Mills Co. v. Eagle, 86 Fed. Rep. 608, 30 C. C. A. 386, 58 U. S. App. 490, 41 L. R. A. 162.

ical names fancifully used" that have been treated as trademarks. So of "Alderney" oleomargarine,¹⁷ "Vienna" bread,¹⁸ "German" sweet chocolate ("German" being the name of an individual).¹⁹ But in their last analysis, the "fanciful use" ascribed to those words by the Courts are simply a convenient excuse for avoiding the harsh doctrine of *Manhattan Medicine Co. v. Wood*. The misrepresentation may be implied from the language employed though not in express words.²⁰

§ 60. **The right to complain of unfair use of geographical name.**—The right to use the name of a locality in the manufacture and sale of goods is a general right of all who manufacture in that locality.²¹ It therefore follows that where any one not living in that locality uses its name to indicate his merchandise, he is resorting to a trick to divert business from the dealers in the same kind of merchandise who in fact live in the locality and honestly use its name as a mark upon their goods.²²

The action to restrain such an unfair competition may be brought either by one²³ or all²⁴ of the merchants who are entitled to the use of the name of the locality and are using it upon the same class of merchandise.

§ 61. **When relief will be granted against fraudulent use of geographical names.**—It would be a vain

17—*Lauferty v. Wheeler*, 62 How. Pr. 488.

18—*Fleischmann v. Schuckmann*, 62 How. Pr. 92.

19—*Walter Baker & Co. v. Baker*, 77 Fed. Rep. 181.

20—*Prince Mfg. Co. v. Prince's Metallic Paint Co.* 135 N. Y. 24, 31 N. E. Rep. 990, 17 L. R. A. 129.

21—*Pillsbury-Washburn Co. v. Eagle*, 86 Fed. Rep. 608, 30 C. C. A. 386.

22—*Ibid.* "A palatable trick," it was termed by Gresham, J., in *Southern White Lead Co. v. Cary*, 25 Fed. Rep. 125-127. *California*

Fruit Cannery Ass'n v. Myer, 104 Fed. Rep. 82.

23—*Newman v. Alvord*, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; 51 N. Y. 189; 10 Am. Rep. 588; *Klotz v. Hecht*, 73 Fed. Rep. 822; *Scheuer v. Muller*, 20 C. C. A. 161, 74 Fed. Rep. 225; *Gage-Downs Co. v. Featherbone Corset Co.*, 83 Fed. Rep. 213; *Southern White Lead Co. v. Coit*, 39 Fed. Rep. 492; *A. F. Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896.

24—*Pillsbury-Washburn Co. v. Eagle*, 86 Fed. Rep. 608.

task to enumerate the various forms of misuse of geographical names which have been enjoined. An examination of the cases will show the versatility of the fraudulent dealer in devising schemes to deceive the public and deprive the legitimate dealer of his trade. The printing of an American label in the French language has been treated as evidence of unfairness in competition against French exporters to the United States;²⁵ and the statement upon a package that its contents were "Chicorien Kaffee aus der fabrik von E. B. Muller & Co., in Roulers (Belgien)," was held to be misleading and unfair where the facts showed that the only part of the manufacture done in Belgium was to "harvest" the chicory root, the other processes being done in the United States.²⁶ In brief, it is particularly true of the subject under discussion that "a court of equity keeps pace with the rapid strides of the sharp competitors for the prize of public favor and insists that it shall be won only by fair trade."²⁷ Some of the cases are cited in the footnote.²⁸

§ 62. **Proper names as trademark.**—It is a self-evident proposition that every one has the right to use his own name for purposes of trade. It was held by Vice-Chancellor Wood that a man's own name might be his trademark even when united with other words, themselves generic and hence incapable of exclusive appropriation. In sustaining the words "Ainsworth's

25—Klotz v. Hecht, 73 Fed. Rep. 822.

26—Scheuer v. Muller, 74 Fed. Rep. 225-228; 20 C. C. A. 161.

27—R. Heinisch's Sons Co. v. Boker, 86 Fed. Rep. 765-768.

28—Anheuser-Busch Brewing Ass'n v. Piza, 24 Fed. Rep. 149; A. F. Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896; Southern White Lead Co. v. Cary, 25 Fed. Rep. 125; Same v. Coit, 39

Fed. Rep. 492; City of Carlsbad v. Thackeray, 57 Fed. Rep. 18; Cahn v. Gottschalk, 2 N. Y. Supp. 13; Hiram Walker & Sons v. Mikolas, 79 Fed. Rep. 955; Von Mumm v. Frash, 56 Fed. Rep. 830; Lea v. Wolff, 15 Abb. Pr. N. S. 1; 46 How. Pr. 147; Seb. 407; Anheuser-Busch Brewing Co. v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Manitowoc Pea-Packing Co. v. William Numsen & Sons, 93 Fed. Rep. 196.

Thread'' as a trademark he said: "Is not a man's name as strong an instance of trademark as can be suggested?—subject only to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name."²⁹ But any name may be used by any one who cares to designate himself by it, and in this sense a proper name can never be an essential part of a trademark,³⁰ because, as we have seen, a valid trademark must be exclusive, as against all the world. The decisions as to this are conflicting, very confusing, and in many instances the result of careless use of language. Thus Chancellor Westbury said: "It is true that a name or the style of a firm may by long usage become a mere trademark."³¹ In another case the same learned chancellor said: "A name, though originally the name of the first maker, may in time become a mere trademark or sign of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues to be used for generations after the death of the individual who first affixed it."³² In the first named case, any one named "Ainsworth" might lawfully use the word as a trademark. He would be restrained only where he resorted to unfair competition by so preparing or advertising his thread as to deceive customers into the belief that they were buying the thread made by another Ainsworth. As to the

29—*Ainsworth v. Walmsley*, L. trade." *Davis, J., in Drake Medicine Co. v. Glessner*, 68 Ohio St. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. N. S. 205; 14 L. T. N. S. 220; 337, 67 N. E. Rep. 722.
14 W. R. 363; Seb. 257.

30—"In a technical sense, there can be no trademark in the name of a person, because all such names are generic, and because, speaking in a general sense, every person has the right to use his own name for the purposes of

31—*Leather Cloth Co. v. American Leather Cloth Co.*, 4 DeG. J. & S. 137-142; Seb. 223.

32—*Hall v. Barrows*, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; 3 N. R. 259; Seb. 215.

dicta of Lord Westbury, they are meaningless, for the same reason. If a man's name is not a valid trademark for his goods in his life-time, because any one of the same name may use it for the same purpose, how can it possibly become a trademark in the use of his successors after his death?

§ 63. **Names of celebrities.**—Far different is the rule as to names which are those of celebrities, their use as trademarks being universally recognized.³³ Yet here the scientific objection remains that any one bearing the name of the ill-fated Corsican would have the undoubted right to manufacture "Napoleon" cigarettes, notwithstanding the prior appropriation of that word as a trademark by another manufacturer. If the words "Emperor Napoleon" were so appropriated, they would undoubtedly be good as against the world.³⁴

§ 64. **In general, of one's own name.**—Although the custom is universal for male persons to bear the name of their parents, there is nothing in the common law pro-

33—"Roger Williams," though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be so applied the names of Washington, Greene, Perry, or of any other heroes, living or dead." Ames, C. J., in *Barrows v. Knight*, 6 R. I. 434; Cox, 238; Seb. 184. It has been so held of the word "Bismarck" (used as a trademark for paper collars) during the life-time of Bismarck. *Messerole v. Tynberg*, 36 How. Pr. 14; 4 Abb. Pr. N. S. 410.

34—The learned English barrister Sebastian, in his work on Trademarks, thus states the rule: "There is between a name of an individual or firm used as a trademark, and a fancy name or arbitrary symbol used for the same

purpose, a broad distinction which was early perceived and which caused some difficulty in the universal acceptance of a name as an efficacious trademark. The difference is, that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the christian name is commonly abbreviated to an initial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate." Sebastian, *Trademarks* (4th ed.), 24.

libiting a man from taking any other name he may choose.³⁵ This doctrine has long been settled beyond peradventure. It is of course equally certain that one must not use his name so as to work a fraud upon others of the same name.³⁶ Subject to this restriction a man will never be restrained from the full enjoyment of his name, whether that name be that of his parents or adopted by himself. As stated by Turner, L. J.: "Where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that

35—*England v. New York Pub. Co.*, 8 Daly, 375; *Price & Steuart*, 14; *Re Snock*, 2 Hilt. 566. *Linton v. First National Bank of Kittanning*, 10 Fed. Rep. 894-897.

The right to assume a name.—Lord Chelmsford observes: "In this country we do not recognize the absolute right of a person to a particular name to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by an injunction. But the mere assumption of a name which is the patronymic of a family by a stranger who had never before been called by that name, whatever cause of annoyance it may be to the family, is a grievance for which our law affords no redress." *Du Boulay v. Du Boulay*, L. R. 2 P. C. 420-441; and see *Olin v. Bate*,

98 Ill. 53; 38 Am. Rep. 98, where injunction to restrain the use of an assumed name was denied under peculiar circumstances.

36—The doctrine is well settled that "every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name, in such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But although he may thus use his name, he cannot resort to any artifice or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name." *Devens, J., in Russia Cement Co. v. Le Page*, 147 Mass. 206-208; 17 N. E. Rep. 304; quoted and followed in *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169-187. This is the rule announced in *Burgess v. Burgess*, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53. And see *Linoleum Mfg. Co. v. Nairn*, 7

the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not.³⁷ Hence we see that the subject of this section is more properly treated under the head of unfair competition, and it is therefore considered in that connection in the next section.

§ 65. The use of proper names in trade.—We have in the preceding sections given some consideration to the subject of proper names, considered with reference to their exclusive appropriation for mercantile purposes. The conclusion reached was that in a scientific sense there can be no trademark in a proper name, because all proper names are generic. The author believes that this rule is well sustained by the reasons heretofore given at length. In their anxiety to effect perfect justice the courts have frequently said that such words were valid trademarks,³⁸ but the reasoning of the opinions indicated that the use of the language adopted was careless and erroneous. The proper method of reading the class of

Ch. Div. 834-837; 47 L. J. Ch. 430; 562; 45 Off. Gaz. 347; Singer Mfg. 38 L. T. N. S. 448; 26 W. R. 463; Co. v. Larsen, Fed. Case No. 12902, Dig. 536; Croft v. Day, 7 Beavan, 8 Bissell, 151-153; Price & Steuart, 84; Dig. 76; Holloway v. Holloway, 72; Singer Mfg. Co. v. Bent, 163 U. 13 Beavan, 209; Dig. 106; Wother- S. 205.

spoon v. Currie, L. R. 5 H. L. 508; 37—Burgess v. Burgess, 3 DeG. Montgomery v. Thompson, (1891) M. & G. 896; 22 L. J. Ch. 675; 17 App. Cas. 217; Rogers v. Rogers, 53 Jur. 292; 21 L. T. O. S. 53; Cox, Conn. 121; 55 Am. Rep. 78; 33 Alb. 117. A man cannot sell his own L. J. 70; Gilman v. Hunnewell, name to another for the purpose 122 Mass. 139; Cox 541; Menecely of carrying on a rival trade against v. Menecely, 62 N. Y. 427; another bearing the name so attempted to be used. Melachrino v. 1 Hun, 673; 2 Thomp. & C. Melachrino Cigarette Co., 4 R. P. 540; 62 N. Y. (17 Sickels), 427; C. 215; Cartmell, 223.

20 Am. Rep. 489; 2 Am. L. T. N. S. 38—Standinger v. Standinger, 19 482; Dig. 472; Pillsbury v. Pills- Leg. Int. 85; Fulton v. Sellers, 4 bury, 24 U. S. App. 395-404; Lawrence Mfg. Co. v. Tennessee Mfg. Brews. 42; Candee v. Deere, 54 Ill. Co., 138 U. S. 537; 31 Fed. Rep. 439; Howe v. Howe Sewing Machine Co., 50 Barb. 236; Gillis v. 776; Brown Chem. Co. v. Meyer, 139 U. S. 540; 31 Fed. Rep. 453; Coats v. Merrick Thread Co., 149 U. S. Hall, 3 Brews. 509.

cases just referred to is to bear in mind that, while the courts recognized the law of unfair competition, they did not know or recognize it by that name. The tendency was to restrain fraudulent competition, but to restrain it by invoking trademark law. In the inaccurate reasoning of the courts, the fact that a man whose name was "R. P. Hall" came into equity seeking an injunction against a defendant bearing a different name, but printing "R. P. Hall" upon his merchandise, suggested that the easiest manner of disposing of the issues was to say that Hall had a trademark right in his own name, which right the defendant was infringing.³⁹ So the defendant was very properly enjoined, justice was done, and the technical error of the decision was overlooked. For error it was, because the proper name Hall, even prefixed by the initials R. P., is a generic name which any one may use, provided that he does not so use it as to pass off his goods upon the purchasing public as the goods of another.

If any further proof were needed to show the rule to be accurate, we could examine the cases in which the use of a proper name could not possibly give a right of trademark, because the name was not used in application to merchandise. One of the most striking instances of this kind is afforded by the case in which a theatrical combination was protected in the use of the name "Christy's Minstrels."⁴⁰

39—Gillis v. Hall, 3 Brews. 509.

40—Christy v. Murphy, 12 How. Pr. 77. In his opinion, Judge Clarke makes these prefatory remarks: "It is now well established that the court will grant an injunction against the use by one tradesman of the trademarks of another. Will this protection be extended to enterprises undertaken for the purpose of affording amusement or recreation to the public?" The court instinctively,

in his sense of equity, saw that a wrong was being committed and that it ought to be enjoined, and he enjoined it. The remedy was just as effective and proper as if he had comprehended the law of unfair competition as treated in the later decisions. But if he had understood the principles he administered he would not have referred to the law of trademarks to justify his conclusion.

§ 66. **The use of proper names generally.**—From this preliminary discussion of the principles of unfair competition we can now undertake to classify what we may term, for want of a better phraseology, the proper-name cases.

(a) Where the defendant is using his own name in good faith. In these cases there is no unfairness in the competition between the parties, and the defendant will not be restrained.⁴¹

But in this connection it should be observed that one

- 41—Burgess v. Burgess, 3 DeG. 97 Mass. 291; Thynne v. Shove, L. M. & G. 806; 17 Jur. 292; Seb. 117; R. (1890) 45 Ch. D. 577-582; Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; Marcus Ward & Co. v. Ward, 15 N. Y. Supp. 913; 61 Hun, 625; Drummond Tobacco Co. v. Randle, 114 Ill. 412; 2 N. E. Rep. 536; Newark Coal Co. v. Spangler, 54 N. J. Eq. 354; 34 Atl. Rep. 932; American Cereal Co. v. Eli Pettijohn Cereal Co. (2), 76 Fed. Rep. 372; 22 C. C. A. 336, affirming s. c. 72 Fed. Rep. 903; Duryea v. National Starch Mfg. Co., 25 C. C. A. 139, 45 U. S. App. 649; 79 Fed. Rep. 651; affirmed, 101 Fed. Rep. 117; Wm. Rogers Mfg. Co. v. Simpson, 54 Conn. 527; Foster v. Webster Piano Co., 13 N. Y. Supp. 338; 59 Hun, 624; Tussaud v. Tussaud, 38 W. R. 440; Iowa Seed Co. v. Dorr, 70 Ia. 481; Turton & Sons (Ltd.) v. Turton, 42 Ch. D. 128; American Cereal Co. v. Eli Pettijohn Cereal Co. (1), 72 Fed. Rep. 903; Bingham School v. Gray, 122 N. Car. 699, 30 S. E. Rep. 304, 41 L. R. A. 243; Harson v. Halkyard, R. I., 46 Atl. Rep. 271; Von Faber v. Faber, 124 Fed. Rep. 603, 611; National Starch Mfg. Co. v. Duryea, 41 C. C. A. 244, 101 Fed. Rep. 117.
- M. & G. 806; 17 Jur. 292; Seb. 117; Coats v. Platt, 17 Leg. Int. 213; Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, 401; Seb. 278; Wolfe v. Burke, 56 N. Y. 115; Meneely v. Meneely, 1 Hun, 367; 62 N. Y. 427; Seb. 472; Decker v. Decker, 52 How. Pr. 218; Seb. 525; Prince Metallic Paint Co. v. Carbon Metallic Paint Co., Seb. 573; Rodgers v. Nowill, 6 Hare, 325; Seb. 82; Clark v. Clark, 25 Barb. 76; Cox, 206; Seb. 148; Comstock v. White, 18 How. Pr. 421; Cox, 232; Binnering v. Wattles, 28 How. Pr. 206; Cox, 318; Seb. 240; Hardy v. Cutter, 3 Off. Gaz. 468; Seb. 427; Carmichef v. Latimer, 11 R. I. 395; 23 Am. Rep. 481; 16 Alb. L. J. 73; Seb. 521; Gilman v. Hunnewell, 122 Mass. 139; Seb. 541; McLean v. Fleming, 96 U. S. 245; 13 Off. Gaz. 913; Brown Chemical Co. v. Meyer, 139 U. S. 540; Cox, Manual, 726; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495; Landreth v. Landreth, 22 Fed. Rep. 41; Wm. Rogers Mfg. Co. v. R. W. Rogers Co., 66 Fed. Rep. 56; affirmed, 17 C. C. A. 57, 70 Fed. Rep. 1019; Wm. Rogers Mfg. Co. v. Rogers, 84 Fed. Rep. 639; Rogers v. Taintor,

who enters into competition with another person of the same name, who has an old and established business, is under an obligation to more widely differentiate his goods from those of the latter than is required of third persons having different names.⁴² A court of equity may direct a defendant, in such a case, how to use his name so as not to injure the complainant who bears the same name.⁴³ This direction has at times taken the form of an injunction restraining the party at fault from using his name in connection with his product, except in conjunction with the words "No connection with the original——" (giving the name and location of the other party), or words of like import.⁴⁴

(b) Where the defendant is using his own name or that of another in a manner wilfully calculated to deceive the public into a belief that his goods are the goods of the plaintiff who bears the same name. This presents a state of facts that warrants the invocation of the injunctive power of equity; the decisions being practically unanimous.⁴⁵

42—*Baker & Co. v. Baker*, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; *Walter Baker & Co. v. Sanders*, 26 C. C. A. 220, 80 Fed. Rep. 889-895.

43—*Baker & Co. v. Baker*, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; *Tarrant & Co. v. Hoff*, 76 Fed. Rep. 959; affirming s. c., 71 Fed. Rep. 163; *Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889-894; *City of Carlsbad v. Schultz*, 78 Fed. Rep. 469. In the last named case Judge Coxe designed a label for the defendant's use, a copy of which is embodied in his opinion.

44—*Allegretti Chocolate Cream Co. v. Keller*, 85 Fed. Rep. 643.

45—*Holloway v. Holloway*, 13 Beav. 209; Seb. 106; *Burgess v. Burgess*, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T.

53; Seb. 117; *Taylor v. Taylor*, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124; *Clark v. Clark*, 25 Barb. 76; Cox, 206; Seb. 148; *Stonebraker v. Stonebraker*, 33 Md. 252; Seb. 333; *Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co.*, 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; *James v. James*, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388; *McLean v. Fleming*, 96 U. S. 245; 13 Off. Gaz. 913; *Thorley's Cattle Food Co. v. Massam*, 42 L. T. N. S. 851; Cox, Manual, 668; *Russia Cement Co. v. Le Page*, 147 Mass. 206; 17 N. E. Rep. 304, 44 Off. Gaz. 823; Cox, Manual, 706; *Brown Chemical Co. v. Meyer*, 55 Off. Gaz. 287; 139 U. S. 540; *Meyer v. Bull Medicine Co.*, 66 Off.

"Every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But, although he may thus use his name, he cannot resort to any artifice or to any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name. Where the name is one which has previously thereto come to indicate the source of manufacture of particular devices, the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception alluded to in the foregoing adjudications."⁴⁶

Gaz. 197; 18 U. S. App. 372; 7 C. Sup. 306; Rogers Co. v. Wm. Rogers C. A. 558; 58 Fed. Rep. 884; Higgins Co. v. Higgins Soap Co., 144 Landreth v. Landreth, 22 Fed. N. Y. 462; 39 N. E. Rep. 490, 43 Rep. 41; Manufacturing Co. v. Am. St. Rep. 769; Wm. Rogers Simpson, 54 Conn. 527; Rogers v. Mfg. Co. v. R. W. Rogers Co., 66 Rogers, 53 Conn. 121; Hohner v. Fed. Rep. 66; 73 Off. Gaz. 970; Gratz, 52 Fed. Rep. 871; Williams DeLong v. DeLong Hook & Eye v. Johnson, 2 Bos. 1; Cox, 214; Co., 74 Off. Gaz. 809; Garrett v. Stuart v. F. G. Stewart Co., 33 C. C. A. 480, 91 Fed. Garrett & Co., 24 C. C. A. 173, 79 Off. Gaz. 1681; 78 Rep. 243; reversing s. c., 85 Fed. Rep. 472-478; Baker & Co. Fed. Rep. 778; International Silver v. Baker, 77 Fed. Rep. 181; 78 Off. Co. v. Simeon L. & George H. Gaz. 1427; Rogers Mfg. Co. v. Rogers Rogers Co., 110 Fed. Rep. 955; & Spurr Mfg. Co., 11 Fed. Rep. Chickering v. Chickering & Sons, 495; Price & Steuart, 621; Tuerk 120 Fed. Rep. 69, 56 C. C. A., 475; Power Co. v. Tuerk, 36 N. Y. Supp. Royal Baking Powder Co. v. Royal, 384; 92 Hun, 65; Gillis v. Hall, 58 C. C. A. 499, 122 Fed. Rep. 337; Cox, 596; Devlin v. Devlin, 69 N. Y. International Silver Co. v. Wm. G. 212; Tussaud v. Tussaud, 38 W. R. Rogers Co., 113 Fed. Rep., 526; 440; Frazer v. Frazer Lubricator Robinson v. Storm, 103 Tenn. 40, Co., 121 Ill. 147; 13 N. E. Rep. 639; 52 S. W. Rep. 880.

46—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169. "A man may not use his own name to accomplish a fraud, designed or con-

(c) Where the defendant is a corporation whose corporate name includes a proper name and was selected by its incorporators with the intent and for the purpose of deceiving the public into the belief that its goods are the goods of the plaintiff. Such frauds will of course be enjoined.⁴⁷

(d) Where the defendant has, solely for the purpose of unfair trade, secured from some person having the same name as the plaintiff a license to use that name for the purpose of fraudulently competing with the plaintiff. This, being an artifice in promotion of unfair trade, renders the defendant liable to injunction.⁴⁸

In such a case, the licensor is a joint tort-feasor with the licensee.⁴⁹

Finally, in regard to the assignment of the right to use one's name, the law is well settled that a man can so assign the right to use his name subject only to the general rules of public policy governing contracts in restraint of trade.⁵⁰

The right to use the name Booth, in connection with a theatre, described in the assignment of a lease as "Booth's Theatre," was held to pass to the assignee because it had become affixed to the establishment;⁵¹ and

structive." Jenkins, J., in *Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243-248, 33 C. C. A. 480.

47—*Wm. Rogers Mfg. Co. v. Rogers*, 73 Off. Gaz. 970; 84 Fed. Rep. 639; *Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co.*, 11 Fed. Rep. 495; *Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; 39 N. E. Rep. 490, 43 Am. St. Rep. 769; *Plant Seed Co. v. Michel Plant & Seed Co.*, 23 Mo. App. 579; *Garrett v. T. H. Garrett & Co.*, 24 C. C. A. 173, 78 Fed. Rep. 472; *Clark Thread Co. v. Armitage*, 21 C. C. A. 178, 74 Fed. Rep. 936; *Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243; reversing s. c., 85

Fed. Rep. 778; *Dodge Stationery Co. v. Dodge, Cal.*, 78 Pac. Rep. 879.

48—*Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215; *Cartmell*, 223; *Sawyer v. Kellogg*, 7 Fed. Rep. 720; *Cox, Manual*, 681; *R. Heinisch's Sons Co. v. Boker*, 86 Fed. Rep. 765; *Garrett v. T. H. Garrett & Co.*, 78 Fed. Rep. 472, 24 C. C. A. 173.

49—*Wm. G. Rogers Co. v. International Silver Co.*, 55 C. C. A. 83, 118 Fed. Rep. 133.

50—*Brewer v. Lamar*, 69 Ga. 656, 47 Am. Rep. 766.

51—*Booth v. Jarrett*, 52 How. Pr. 169; Seb. 524.

it may follow that proper names attached to or used in connection with places of amusement generally would pass to an assignee without specific enumeration in the instrument of assignment.

It was suggested in the case of *Christy v. Murphy*, involving the right to use the words "Christy's Minstrels," that if the plaintiff had seen fit to do so he could have conveyed to the defendants an irrevocable license to use that name in connection with that form of theatrical enterprise.⁵² But in the more recent case of *Messer v. The Fadettes*, the supreme court of Massachusetts, Lathrop, J., dissenting, refused to recognize an assignment of the name of an orchestra, holding that while the organizer and conductor of a musical organization may have some right of ownership in it, such right is purely personal, depending upon the personal reputation or skill of the conductor, and is therefore not assignable; and that the continued use of the name would mislead and therefore work a fraud upon the public.⁵³ While the name involved ("The Fadettes") is not the name of a person, the decision is properly noticed here as a striking deparature from the doctrine of *Christy v. Murphy*, *supra*, and from what the author conceives to be the law. The dissenting opinion of Justice Lathrop is well grounded on authority, and the reader is referred to it for his reasoning. Briefly, the court ought to have done as has been occasionally done in the federal courts, namely, it should have instructed the assignee of the name "The Fadettes" how to use that name in its advertising matter so as not to deceive the public into a belief that the orchestra was still under the personal direction of its former manager and director. To hold that the assignment was void was to put a premium on dishonesty.

It is interesting to note that in a subsequent case the

52—*Christy v. Murphy*, 12 How. Pr. 77; Cox, 164; Seb. 137.

53—*Messer v. The Fadettes*, 168 Mass. 140.

same court affirms a decree directing a defendant to clearly mark his goods so as to indicate they are not the plaintiff's.⁵⁴

One who has assigned the right to use his name in specific trade will be enjoined from using his own name in that trade, in competition with his assignee, for such competition would be unfair and fraudulent.⁵⁵ Promoters of a corporation whose names have been used as a part of the corporate name cannot be permitted to use their names in connection with and as the name of a rival company. Such conduct will be enjoined because of "the injury to the party aggrieved, and the imposition upon the public, by causing them to believe that the goods of one man or firm are the production of another."⁵⁶

In conclusion, the general rule underlying this class of cases has been aptly stated as follows: "All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so."⁵⁷

§ 67. **Fictitious proper names.**—Whether the use of a fictitious proper name will vitiate an accompanying trademark so as to deprive its owner of relief in equity depends upon whether fraud is accomplished through the use of the name. Thus, one Thomas Nelson Dale, mark-

54—Flagg Mfg. Co. v. Holway, — Mass. —, 59 N. E. Rep. 667.

55—Meyers v. Kalamazoo Buggy Co., 54 Mich. 215; Thynne v. Shove, L. R. (1890) 45 Ch. D. 577; Wood v. Sands, Seb. 467; Russia Cement Co. v. Le Page, 147 Mass. 206; 17 N. E. Rep. 304; Kidd v. Johnson, 100 U. S. 617; Spieker v. Lash, 102 Cal. 38-45; Hoxie v. Chaney, 143 Mass. 592, 10 N. E. Rep. 713; Skinner v. Oakes, 10 Mo. App. 45; Grow v. Seligman, 47 Mich. 647; Churton v. Douglas, Johns. 174; 28 L. J. Ch. 841; 5 Jur. N. S. 887; 33 L. T. 57; 7 W.

R. 365. And where the assignor has acquiesced in the opening of mail addressed to him, by his assignee, he will be enjoined from receiving and opening such mail addressed to him. Dr. David Kennedy Corp. v. Kennedy, 55 N. Y. Supp. 917.

56—Holmes, Booth & Haydens v. The Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340.

57—Lowell, J., in Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495-499.

ing thread made and sold by him with the fictitious firm name "Thomas Nelson & Co." was granted an injunction against an infringer, the court saying "the public is not in fact deceived, as it is shown that no such firm exists as Thomas Nelson & Co. who are known to be manufacturers of thread."⁵⁸ Upon the same principle, if a manufacturing or business establishment has a firm name which it uses upon its merchandise, it is no fraud upon the public if the firm name no longer represents the same individuals that it did when first adopted.⁵⁹

§ 68 Revocation of license to use one's own name.—When a person has permitted another to build up a business under his name, the license may become irrevocable. It was so held by the supreme court of Pennsylvania, where the purchaser of the machinery and stock of goods of an insolvent partnership at a sheriff's sale was given permission to continue the use of the firm name. A bill was filed four years subsequently to enjoin the purchaser from continuing to use the name, and for an account of profits. Among other controlling facts, it appeared that at the time of the sheriff's sale the good-will and firm name were valueless, and that their sole value was due to the efforts of the purchaser. This decision seems to be sound, and it is chiefly of value because of the distinction between the license here involved, and the license which is implied in the case of the infringer of a technical trademark, and which has been held to be revocable at any time. Mestrezat, J., said "It is undoubtedly true that a mere license without consideration is determinable at the pleasure of the licensor. But that is not the rule in this state, where the enjoyment of the license must necessarily be and is preceded by the expenditure of money. In such cases the license becomes an

58—Dale v. Smithson, 12 Abb. 59—Leather Cloth Co. Ltd. v. Pr. 237; Cox' American Trade- American Leather Cloth Co. Ltd., mark Cases, 282. L. R., 11 H. L. C. 523, 542.

agreement on a valuable consideration, and is irrevocable.”⁶⁰

§ 69. **Corporate names.**—The general rule governing the supervision of equity over the names of corporations has been comprehensively stated as follows: “In respect to corporate names, an injunction lies to restrain the simulation and use by one corporation of the name of a prior corporation which tends to create confusion, and to enable the later corporation to obtain, by reason of the similarity of names, the business of the prior one. The courts interfere in these cases, not on the ground that the state may affix such corporate names as it may elect to the entities it creates, but to prevent fraud, actual or constructive. The names of corporations organized under general laws, and in most other cases, are chosen by the promoters, and it would be an easy way to escape from the obligations which are enforced as between individuals if a corporation were granted immunity by reason of their corporate character.”⁶¹

Probable confusion of business is usually a prominent factor in the disposition of cases of this class.⁶²

The courts are confused in their phraseology with reference to the character of corporate names. There can be no trademark right in a corporate name, for the conclusive reason that it is not, as such, applied to the subject-matter of commerce. In an early case Judge Deady, of Oregon, said, “The corporate name of a corporation is a trademark from the necessity of the thing,”⁶³ and this very phrase, with other dicta, has been quoted with

60—Harris v. Brown, 202 Pa. 16, 51 Atl. Rep. 586.

61—Higgins Co. v. Higgins Soap Co., 144 N. Y. 462, 39 N. E. Rep. 490, 43 Am. St. Rep. 769.

62—Drummond Tobacco Co. v. Randle, 114 Ill. 412, 2 N. E. Rep. 536.

63—Newby v. Railroad Co., Fed.

Case No. 10144, Deady, 609. “The name of a corporation has been said to be the ‘knot of its combination,’ without which it cannot perform its corporate functions.” Wallace, J., in Goodyear Rubber Co. v. Goodyear’s Rubber Mfg. Co., 21 Fed. Rep. 276.

approval in a more recent case.⁶⁴ The author has in a former section collected the judicial definitions of trademark, and it is a scientific impossibility to bring Judge Deady's dictum within the scope of either of those definitions, or to extend the definitions to include that dictum. Mr. Justice Clifford's definition may be referred to as making the author's position clearer.⁶⁵ It is entirely erroneous to treat a corporate name as being a trademark.

This error has arisen from the unfamiliarity of the courts with the essential requirements of technical trademarks, and the fact that equitable relief had to be administered in cases where the courts had no precedents at hand except in the trademark decisions, which afforded similar reasoning to support their conclusions.

The reason why equity intervenes to protect corporate names from imitation is that they are essential parts of the being of corporations, or, as expressed by the supreme court of Missouri, its name is a necessary element of the existence of a corporation.⁶⁶

As the Rhode Island court has phrased it, "The principles upon which these cases rest are that, although a corporation may be legally created, it can no more use its corporate name in violation of the rights of others than an individual can use his name, legally acquired, so as to mislead the public and to injure another."⁶⁷ The courts, therefore, will protect a corporation in the use of its name in the absence of any express statutory enactment.⁶⁸ The exercise of this power is an enforcement of the law of unfair competition as shown in the following language of Bradley, J.: "Fair competition in business is legitimate, and promotes the public good; but an un-

64—Investor Pub. Co. v. Dobinson, 72 Fed. Rep. 603, 606.

67—Armington v. Palmer, — R. I. —, 43 L. R. A. 95, 42 Atl. Rep.

65—McLean v. Fleming, 96 U. S. 245-254.

308.

66.—State v. McGrath, 92 Mo. 357.

68—Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co. of Kansas, 1 N. Y. Supp. 44; William

fair appropriation of another's business, by using his name or trademark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity."⁶⁹ This dictum is contained in the opinion in the Celluloid case, where the corporate name happened to be the trademark applied by the corporation to merchandise manufactured and sold by it. It is a self-evident proposition that a generic word embodied in a corporate name is not entitled to protection in equity. The rule was thus stated by Mr. Justice Field, in delivering the opinion of the United States supreme court in a case where the Goodyear Rubber Co. sought to restrain another corporation from using the name "Goodyear's Rubber Manufacturing Co." He said: "The name of 'Goodyear Rubber Company' is not one capable of exclusive appropriation. 'Goodyear Rubber' are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them. Thus parties united to produce or sell wine, or to raise cotton or grain, might style themselves wine company, cotton company, or grain company; but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles and to publish the fact to the world. Names of such articles cannot be adopted as trademarks, and be thereby appropriated to the exclusive right of any one, nor will

Rogers Mfg. Co. v. Rogers & Spurr Industrial Mutual Deposit Co. v. Mfg. Co., 11 Fed. Rep. 495; Cellu- Central Mutual Deposit Co., —
loid Mfg. Co. v. Cellonite Mfg. Co., Ky. —, 66 S. W. Rep. 1032.
32 Fed. Rep. 94; Investor Pub. 69—Celluloid Mfg. Co. v. Cellon-
Co. v. Dobinson, 72 Fed. Rep. 603; ite Mfg. Co., 32 Fed. Rep. 94.

the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name."⁷⁰

In his latest utterance upon this subject, the United States Supreme Court speaking through Mr. Chief Justice Fuller says "the principle that one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right, is sustained by the discussion in *Columbia Mill Co. v. Al-*

70—Mr. Justice Field, in *Goodyear Co. v. Goodyear Rubber Co.*, 128 U. S. 598-602; reversing s. c., 21 Fed. Rep. 276. Thus in an action by one fire insurance company to restrain another from the use of the word "Continental" in its corporate name, the court said: "The distinguishing feature of the names of the two incorporated companies is the word 'Continental.' It is the use of this word by the defendant which the complainant seeks to enjoin. It is the contention of the complainant that, by reason of the long-continued use of this word by it, and the fact that it has built up a large and lucrative business under this distinguishing name, it has secured a property right in said word 'Continental,' in connection with its incorporated name, and it is entitled to the exclusive use of the word 'Continental,' in connection with its insurance business, in the sections of the country where it is engaged in such business. Upon the showing made by the complainant, it might be entitled to the relief sought, were the distinguishing word of its corporate name such a one as could be

exclusively appropriated in the designation or conduct of a business by a person, firm or corporation. The word 'continental' is in general and prevalent use, and means pertaining to or characteristic of a continent. As applied to or designating an insurance company, it would be descriptive of the bounds within which such company carried on its business. The scope of the business carried on by many insurance companies is continental in extent. A term which can be truthfully used by many in the description of a business or occupation cannot be exclusively appropriated by any one of them. The word 'continental' is a generic term, and it is not the policy of the law to permit the exclusive appropriation of words or terms which are generic; that is, which pertain to a class of related things, and which are of general application. The right to use such words should remain vested in the public." *Meek, J.*, in *Continental Ins. Co. v. Continental Fire Ass'n.* 96 Fed. Rep. 846-848; affirmed, 41 C. C. A. 326, 101 Fed. Rep. 255. To the same effect see *Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44.

corn (150 U. S. 460), and is, we think, necessarily applicable to all names *publici juris*.”⁷¹

A foreign corporation cannot, by application to a court in the state in which a new corporation is being organized, secure an injunction restraining the formation of the new corporation under the same corporate name as that of the plaintiff. But in dismissing a bill brought for such a purpose, Judge Gresham said: “I do not say what may be done if the defendants succeed in creating their corporation bearing the complainant’s name, and a suit shall be brought by the complainant to prevent individuals claiming to be officers or managers of such corporation from interfering with the complainant’s business.”⁷²

In conclusion, there is no practical difference, so far as equitable rights and remedies are concerned, between corporate names and the name of a copartnership or an individual. As said by Mr. Justice Bradley, on circuit, in dealing with the names of corporations plaintiff and defendant, “the fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known, and are to be dealt with precisely as if they were the names of private firms or partnerships.”⁷³

And in a similar case, the Supreme Court of Illinois has said, “Even if the corporate names of the two corporations are somewhat similar, yet, in the absence of any intent, act, or artifice to mislead dealers in the market or the public at large as to the identity of the corporations,

71—Howe Scale Co. v. Wyckoff Seamans & Benedict, 198 U. S. 118; citing American Cereal Co. v. Eli Pettijohn Cereal Co. 72 Fed. Rep. 903; 76 Fed. Rep. 372; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494; Monarch v. Rosenfeld, 19 Ky. Law Rep. 14, 39 S. W. Rep. 236.

72—Lehigh Valley Coal Co. v. Hamblen, 23 Fed. Rep. 225, 226.

73—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94-97. To the same effect, see Baker v. Baker, 53 C. C. A. 157, 115 Fed. Rep. 297; Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118.

the Elgin Creamery Company has the same right to use its corporate name in the transaction of its business that the Elgin Butter Company has to use its corporate name. It would seem that the same rule should apply to corporations in this regard that obtains in respect to natural persons; and, in the absence of any fraudulent intention or act, or any contract to prohibit it, every natural person has the absolute right to his own name in his own business.”⁷⁴

As to the use of a proper name of an incorporator as part of the corporate name, Judge Lochren has stated the rule as follows: “While any person has the right to use his own name in the conduct of his business, in describing the articles of his manufacture, and which he is dealing in, he has not the right to use the name of any other dealer; and it is well settled by the authorities that a corporation has not the right to use the name of one of its incorporators for the purpose of unfair competition with an older dealer, where it is likely to do him injury, and that it will not be permitted to use that name if it is the name by which the older article is usually called for and described.”⁷⁵

A corporation cannot, by securing a license from or employing a person bearing the desired proper name, so use that name as part of its corporate name as to maintain an unfair competition with an older business employing the name.⁷⁶

Under a penal statute of Illinois providing a punishment for any person, company or association not incorporated, assuming “a corporate name,” relief in equity has been denied individuals doing business as “Aetna

74—Baker, J. in *Elgin Butter Thread Co.*, 135 Fed. Rep., 177, Co. v. *Elgin Creamery Co.*, 155 Ill. 179.

127; 40 N. E. Rep. 616.

76—*Garrett v. T. H. Garrett &*

75—*J. & P. Coats v. John Coates Co.*, 78 Fed. Rep. 472, 24 C. C. A. 173.

Iron Works.”⁷⁷ And in another instance it has been held that individuals doing business as “Hazleton Boiler Company” could not convey the right to use said name.⁷⁸ In the former case, the rule is broadly laid down that, in that state a copartnership can have no property in a name importing a corporation.

In the latter case, it was held by the Supreme Court of Illinois that a foreign corporation had no standing in the courts of Illinois to contest the right of an Illinois corporation to use the same name. Judge Jenkins has remarked that this holding “is not in accord with the decisions of the federal and of other state courts.”⁷⁹

§ 70. “**Secondary meaning**” defined.—Of late years the expression “secondary meaning” has been frequently employed in opinions in cases of unfair competition. The expression has come to indicate a meaning that may be “secondary” either in point of intent, or in point of time.

Thus, in a leading English case, Lord Macnaghten said:

“The appellants concede—they cannot, indeed, any longer dispute—that everybody who makes belting of camel hair, is entitled to describe his belting as “Camel-hair Belting,” provided he does so fairly. But they contend, and I think with reason, that neither Banham nor anybody else is entitled to steal Reddaway’s trade under color of imparting accurate and possibly interesting information. Practically the only difference which the un-

77—Clark v. Aetna Iron Works, Mfg. Co., 17 C. C. A. 576, 70 Fed. 44 Ill. App. 510. Rep. 1017; Publishing Co. v. Dob-

78—Hazleton Boiler Co. v. Haz- binson, 72 Fed. Rep. 603; Higgins
zelton Tripod Boiler Co., 142 Ill. Co. v. Higgins Soap Co., 144 N. Y.
494; 30 N. E. Rep. 339. 462, 39 N. E. Rep. 490, 27 L. R. A.

79—The Peck Bros. & Co. v. Peck 42, 43 Am. St. Rep. 769; Holmes,
Bros. Co., 51 C. C. A. 251, 113 Fed. Booth & Hayden v. Holmes, Booth
Rep. 291, 302; citing Celluloid & Atwood Mfg. Co., 37 Conn. 278,
Mfg. Co. v. Cellonite Mfg. Co., 32 293, 9 Am. Rep. 324.
Fed. Rep. 94; Rogers Co. v. Rogers

expected turn in the evidence has made is this: the case now comes under the second branch of the proposition laid down by Lord Justice James; if 'Camel-hair Belting' had kept its place as a fanciful term, it would have fallen under the first. The learned counsel for the respondents maintained that the expression 'Camel-Hair Belting,' used by Banham, was the 'simple truth.' Their proposition was that, 'where a man is simply telling the truth as to the way in which his goods are made, or as to the materials of which they are composed, he cannot be held liable for mistakes which the public may make.' That seems to me to be rather begging the question. Can it be said that the description 'Camel-Hair Belting,' as used by Banham, is the simple truth? I will not call it an abuse of language to say so, but certainly it is not altogether a happy expression. The whole merit of that description—its one virtue for Banham's purposes—lies in its duplicity. It means two things. At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair. Abroad, to the German manufacturer, to the Bombay mill owner, to the up-country native, it must mean Reddaway's belting; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."⁸⁰

Here, both in point of time and point of intent, "Camel-Hair" meant primarily belting having camel's hair as a component.

Where the mark in its first application is a valid trademark, "the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of

80—Reddaway v. Banham (1896), App. Cas. 199.

protection or make it the common property of the trade."⁸¹

Where, on the other hand, the mark in the first instance is generic, because merely descriptive or geographical, or the name of a person, and under that mark a particular trader has occupied the market, a subsequent invasion of the market by another using the mark may (though it does not necessarily) constitute unfair competition; but no matter how long the use continues, the mark will never become a technical trademark.⁸²

The rule has been frequently applied and illustrated. It has been admirably stated by Judge Lurton in the following terms:

"That a descriptive word or sign or symbol, descriptive from popular use in a descriptive sense, may acquire a secondary significance denoting origin or ownership, is true. But this secondary significance is not protected as a trademark, for a descriptive word is not the subject of a valid trademark; the only office of a trademark being to indicate origin or ownership. When a descriptive or geographical word or symbol comes by adoption to have a secondary meaning denoting origin, its use in this secondary sense may be restrained, if it amounts to unfair competition. In such case, if the use of it by another be for the purpose of palming off the goods of one as and for the goods of another, a court of equity will interfere for the purpose of preventing such a fraud. But this kind of relief depends upon the facts of each case, and does not at all come under the rules applicable to the infringement of a trademark."⁸³

As to the secondary meaning of geographical names,

81—Brown, J., in *Burton v. Putting Scale Co.*, 55 C. C. A. 459, Stratton, 12 Fed. Rep. 696, 702. 118 Fed. Rep. 965, 968.

82—*Brennan v. Emery - Bird -* 83—*Vacuum Oil Co. v. Climax Refining Co.*, 56 C. C. A. 90, 120 Fed. 532, 108 Fed. Rep. 624, 627; *Computing Scale Co. v. Standard Com-* Rep. 254, 256.

Mr. Justice Brown has said, "geographical names often acquire a secondary significance indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced, which enables the owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced, or of passing off the productions of one person as those of another."⁸⁴

The general doctrine has been stated with admirable conciseness by Judge Lurton, as follows: "When the word is incapable of becoming a valid trademark, because descriptive or geographical, yet has by use come to stand for a particular maker or vendor, its use by another in this secondary sense will be restrained as unfair and fraudulent competition, and its use in its primary or common sense confined in such a way as will prevent a probable deceit by enabling one maker or vendor to sell his article as the product of another."⁸⁵

§ 71. Words of double meaning.—In connection with the subject of "secondary" meanings, we may consider, briefly, the decisions concerning the appropriation to trade uses of the class of words having double mean-

84—*La Republique Francaise v. Saratoga Vichy Spring Co.*, 191 U. S. 427, 435, 48 L. ed. 247, 252. To the same effect see *Elgin National Watch Co. v. Loveland*, 132 Fed. Rep. 41, 47; *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, 53 N. E. Rep. 141.

85—*Computing Scale Co. v. Standard Computing Scale Co.*, 55 C. C. A. 459, 118 Fed. Rep. 965, 967. Citing *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537, 549, 11 Sup. Ct. 396, 34 L. ed. 997; *Chemical Co. v. Meyer*, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. ed. 247; *Mill Co. v. Alcorn*, 150 U. S. 460, 14 Sup. Ct. 151, 37 L. ed. 1144; *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. ed. 118; *Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 21 Sup. Ct. 270, 45 L. ed. 365; *Bennett v. McKinley*, 13 C. C. A. 25, 65 Fed. Rep. 505.

ings, being in one sense arbitrary and in another descriptive.

A careful search of the decisions involving words of this character fails to disclose a clearer statement of the correct rule than is embodied in the following language of Judge Wallace: "No principle of the law of trademark is more familiar than that which denies protection to any word or name which is descriptive of the qualities, ingredients, or characteristics of the article to which it is applied. An exclusive right to the use of such a word, as a trademark, when applied to a particular article or class of articles, cannot be acquired by the prior appropriation of it, because all persons who are entitled to produce and vend similar articles are entitled to describe them, and to employ any appropriate terms for that purpose. Whether a word claimed as a trademark is available because it is a fanciful or arbitrary name, or whether it is obnoxious to the objection of being descriptive, must depend upon the circumstances of each case. The word which would be fanciful or arbitrary when applied to one article may be descriptive when applied to another. If it is so apt, and legitimately significant of some quality of the article to which it is sought to be applied, that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it cannot be the subject of a monopoly. On the other hand, if it is merely suggestive, or is figurative only, it may be a good trademark, notwithstanding it is also indirectly or remotely descriptive."⁸⁶

In the opinion quoted from, the word "instantaneous" was held to be aptly descriptive of one of the qualities of the goods to which it was applied. In a later case it has been held that the words "Queen," or "Queen Quality," as applied to shoes, are not so descriptive as to preclude their exclusive appropriation as a "tradename,"

86—Bennett v. McKinley, 13 C. C. A. 25, 65 Fed. Rep. 505, 506.

Judge Severens apparently using the word "trade-name" as synonymous with "trademark."⁸⁷

"It has been repeatedly ruled that a word which suggests even the composition, quality, or characteristics of an article to which it is applied may yet be a good trademark."⁸⁸

87—Thomas G. Plant Co. v. May & Woerz v. Cooke Brewing Co., 20 C. C. A. 534, 105 Fed. Rep. C. C. A. 405, 74 Fed. Rep. 229, 234, 375, 379.

88—Showalter, J., in Beadleston 142 N. Y. 467, 37 N. E. Rep. 476.

CHAPTER IV.

TRADEMARK RIGHTS IN TITLES OF BOOKS, PERIODICALS AND PLAYS.

§ 72. **Trademark in title of a book.**—Upon this subject there has been less harmony of opinion than would be expected. It has been said by the court of appeals of Maryland that “A publisher has either in the title of his work or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trademark.”¹

Mr. Browne in his learned treatise on trademarks says: “Can printed books be protected by trademarks? Yes, as mere merchandise; no, as literary productions.”² This is true, in so far as it asserts that marks or devices may be used to distinguish the product of the publisher or book dealer.³ He says further: “There seems to be no sufficient reason why the title of a book may not be deemed a valid trademark,”⁴ and thereby expresses the error contained in the careless dictum of the Maryland court quoted above. The correct view is stated in clear terms by Mr. Rowland Cox, in his note to *Clemens v. Belford*:⁵ “It is necessarily true that the name of a book is, under all circumstances, a descriptive term which means a particular thing. The book is created and given a name, and the name is added to the language as a term

1—Robertson v. Berry, 50 Md. 591; Price & Steuart, 153. related to property right in the title of a periodical publication.

2—Browne, Trademarks, sec. 116. 4—Browne, Trademarks, sec. 118.

3—Mr. Browne cites six cases in support of this proposition, neither one of which is applicable. All 5—14 Fed. Rep. 728; Cox, Manual, 685.

of description. If a copyright is taken, the owner of the copyright enjoys, as long as the privilege continues, the exclusive right to the use of the name; and when the privilege expires, the name, always a descriptive term, becomes *publici juris*. If the book is not copyrighted, the literary matter becomes *publici juris* as soon as it is published, and the name of the literary matter goes to the public as an incident of that which it describes. If there is language in some of the cases which seems to indicate that the name of a book can be protected as a trademark, reflection will demonstrate that it cannot be made good. The names of periodicals and newspapers, as distinguished from books, are protected as in the nature of trademarks; and in many instances the publications in connection with which the names have been used were proper subjects of copyright. In some cases they contained, or might have contained, articles in connection with which the statutory privilege had been acquired. But the name which has been protected has never been simply the name of a book, but always that of a constantly changing series. Thus the term 'Old Sleuth Library' was distinctly arbitrary, and never the name of a particular book or literary production, and for this reason it was in an accurate sense a trademark, and must continue to be as long as the publication was continued. But if the publication of the periodical were discontinued for a period of years, the name would cease to be arbitrary and take its place in literature as indicating a definite collection of articles, pictures, etc., and as soon as it acquired that settled meaning, it would, in the absence of copyright, become *publici juris*."

It is now established law that there is no trademark right in the title of a book. Judge Wallace stated the rule very lucidly when he said: "Neither the author or proprietor of a literary work has any property in its name. It is a term of description, which serves to

identify the work; but any other person can with impunity adopt it, and apply it to any other book, or to any trade commodity, provided he does not use it as a false token to induce the public to believe that the thing to which it is applied is the identical thing which it originally designated. If literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright laws."⁶ This doctrine is fully sustained by the later cases.⁷

§ 73. **Trademark in title of periodical.**—In 1859 Vice-Chancellor Stuart enjoined a defendant who had begun the publication of "The Penny Bell's Life and Sporting News" from publishing any newspaper under that name, or any other name in which the words "Bell's Life" should occur, the application being made by the proprietors of "Bell's Life in London." In the course of his opinion the vice-chancellor said: "This is an application in support of the right to property."⁸ Thus was distinctly recognized the right of trademark in the title of a periodical publication. Long prior to this time, however, equity had suppressed this species of piracy between publishers, the first reported case being that of *Hogg v. Kirby*, where the complainant was the proprietor of a magazine called "The Wonderful Magazine" and the defendant's publication bore substantially the same name with the addition of the words "New Series, Improved." The injunction was granted by Lord Eldon.⁹

6—*Black v. Ehrich*, 44 Fed. Rep. 793, 794.

7—*Merriam v. Holloway Pub. Co.*, 43 Fed. Rep. 450 (opinion by Mr. Justice Miller on circuit); *Merriam v. Farnous Shoe and Clothing Co.*, 47 Fed. Rep. 411 (opinion by Judge Thayer); *Merriam v. Texas Siftings Pub. Co.*,

49 Fed. Rep. 944 (opinion by Judge Shipman); *Kipling v. G. P. Putnam's Sons*, 120 Fed. Rep. 631, 57 C. C. A. 295.

8—*Clement v. Maddick*, 1 Giff. 98; 5 Jur. N. S. 592; 33 L. T. 117; Seb. 174.

9—*Hogg v. Kirby*, 8 Ves. 215; Seb. 10. Lord Eldon also re-

In the United States Chancellor Sandford was the first to recognize this right, in 1825, although he refused to enjoin the use of the title "The New York National Advocate" on the application of the proprietor of "The National Advocate," both names being applied to newspapers published in the city of New York, holding the names to be substantially different; and this notwithstanding the fact that the defendant had been the editor for the publisher who had sold "The National Advocate" to the complainant. The chancellor did not expressly hold the title of the paper to be a trademark, but treated it as part of the good-will of the printing establishment.¹⁰ Indeed he seems to have treated the subject solely from the standpoint of unfair competition, ignoring the question of technical property right, as did Chancellor Walworth in 1840 in refusing to enjoin the use of the title "New Era" on the application of complainants who published the "Democratic Republican New Era," saying *inter alia*, "There could be very little excuse for the editor of a new paper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the good-will of the latter by actually deceiving its patrons."¹¹

In 1867, however, a clear cut opinion of the court of common pleas of the city of New York recognized the property right in unmistakable terms. The plaintiffs, proprietors of the "National Police Gazette," applied for an injunction to restrain the publication of the "United States Police Gazette" by the defendants. Brady, J., said: "The title of a newspaper may be a

strained a defendant from the publication of a court calendar which he was issuing as a continuation of the complainant's work. Longman v. Winchester, 16 Ves. 269; Seb. 15.

10—Snowden v. Noah, Hopkins, Ch. R. 347; Cox, 1; Seb. 41.

11—Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

purely original one, and the proprietor for that reason entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire an exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words in common use. . . . It also appears that the plaintiffs' paper has been published weekly under that name for many years, . . . that its circulation is large and valuable, and that it was the only police gazette, *eo nomine*, published in the United States at the time of the publication of the paper complained of by them. . . . From these facts it is apparent that the plaintiffs have acquired a right connected with the publication of a newspaper called the National Police Gazette, which must be preserved against any fraud attempted to be perpetrated against them."¹²

In 1870, in the Philadelphia court of common pleas, Judge Paxson said, "the name of a newspaper is a trademark. As much so as a label stamped upon a bale of muslin."¹³ But this was mere *obiter dictum*, as the learned court was dealing with the mark and dress of a stove polish.

Subsequently the superior court of New York City, per Monell, J., said: "I do not understand that the protection which the law affords to 'trademarks,' even assuming the name of a newspaper to be a trademark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some particular manufacture or business. There can be no such property in a newspaper except, perhaps, in the name or

12—Matsell v. Flanagan, 2 Abb. Pr. N. S. 459; Cox, 367; Seb. 270.

13—Dixon Crucible Co. v. Gugenheim, 2 Brewster, 321, Cox, 559, 576.

title of the paper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trademarks, like the law of copyright, cannot be applied to a work of so fluctuating and fugitive a character."¹⁴

As late as 1881 Sir George Jessel, master of the rolls, said: "It does not appear to me that there was any invention in the combination of 'Splendid Misery,' any more than there would be in the words 'Miserable Sinner,' or anything of that kind. The adoption of the words as the title of a novel might make a trademark."¹⁵

In 1898 the appellate division of the supreme court of New York said it could not follow the reasoning of counsel "when he contends that the public, by its short way of referring to the 'Commercial Advertiser,' has given the plaintiff some kind of an undefined trademark in this popular form of speech,—a doctrine which would equally apply to a 'sobriquet' or diminutive; that its unauthorized use by the defendant, whether likely to injure the plaintiff or not, should be absolutely enjoined as an invasion of a strict property right."¹⁶

While, on the other hand, the United States circuit court for the district of New Jersey had held in 1894 that the words "Social Register," applied by a publisher to a directory of a certain locality, containing names of persons resident therein, selected with reference to the personal and social standing of such persons,

14—*Stephens v. De Conto*, 7 Robertson, 343; 4 Abb. Pr. N. S. 47; Cox, 442; Seb. 295. The learned court cites an opinion holding that a newspaper or price current cannot be copyrighted because the term science cannot, with any propriety, be applied to a work of so

fluctuating and fugitive a form. *Clayton v. Stone*, 2 Paine, 382-392.

15—*Dicks v. Yates*, L. R. 18 Ch. D. 76-88.

16—*Commercial Advertiser Ass'n v. Haynes*, 49 N. Y. Supp. 938-942.

“become a trademark, and are entitled to protection as such.”¹⁷

From our cursory view of the foregoing decisions and dicta it is plainly manifest that the right to technical trademark in the title of a periodical has been affirmed and denied with some show of reason upon each side. The subject has been ably discussed by Mr. Browne, who concludes that the name so used is a technical trademark.¹⁸ In that conclusion we must coincide, and it is well sustained by the reasoning of Mr. Rowland Cox, which we have before quoted.¹⁹ But the fact is patent that it is still a mooted question, and that the solicitor attempting to restrain piracy of this kind would better frame his bill upon unfair competition and not upon technical trademark. The New York supreme court, in its decision above referred to, says that “the fundamental doctrine upon which relief in this class of cases is afforded” is that of “misleading or the tendency to mislead, with consequent injury, actual or probable.”²⁰

In a decision of the United States Circuit Court of

17—*Social Register Ass'n v. Howard*, 60 Fed. Rep. 270, 271. The same ruling was made in *Social Register Ass'n v. Murphy*, 128 Fed. Rep. 116.

18—*Browne, Trademarks* (2d ed.), sec. 115. As instances of injunction restraining use of infringing titles of periodicals, see *Edmonds v. Benbow*, *Seton* (3d ed.), 905; *Re Edinburgh Correspondent Newspaper*, Ct. of Sess. Cas. 1st ser. I (new ed.), 407 n; *Cox, Manual*, No. 34.

19—Note to *Clemens v. Belford*, 14 Fed. Rep. 728; *Cox, Manual*, 684; *ante*, § 72.

20—*Commercial Advertiser Ass'n v. Haynes*, 49 N. Y. Supp. 938-942; citing *Bradbury v. Beeton*, 39 Law J. Ch. 57; *Ingram v.*

Stiff, 5 Jur. N. S. 947; *Lee v. Haley*, 5 Ch. App. Cas. 155; *Clement v. Maddick*, 5 Jur. N. S. 592. And to the same effect see *Snowden v. Noah*, *Hopkins*, Ch. 347; *Bell v. Locke*, 8 Paige, 75; *Tallcot v. Moore*, 6 Hun, 106; *Stephens v. DeConto*, 4 Abb. Pr. N. S. 47; *Matsell v. Flanagan*, 2 Abb. Pr. N. S. 459; *Publishing Co. v. Dobinson*, 82 Fed. Rep. 56; *Richardson & Boynton Co. v. Richardson & Morgan Co.*, 8 N. Y. Supp. 53; *Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co.*, 1 N. Y. Supp. 44; *Borthwick v. Evening Post*, L. R. 37 Ch. D. 449; *Estes v. Leslie* (2), 29 Fed. Rep. 91; *Estes v. Leslie* (1), 27 Fed. Rep. 22; *Estes v. Worthington*, 31 Fed. Rep. 154.

Appeals for the Second Circuit, rendered since the foregoing was written, it is distinctly held that the name of a periodical is a technical common-law-trademark.²¹

§ 74. **Play titles as trademarks.**—The principles stated by Judge Wallace in the language which we have heretofore quoted in reference to book titles as trademarks, “If literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright laws,” applies with equal cogency to the name by which a play is designated. But there is this distinction between the titles of plays and the titles of books; the former are comprehensive of something more than the mere title of the literary composition which is produced as a play, while the latter are strictly limited to the literary production itself. Practically, in all of the cases involving play titles with which the courts of this country have had to do, there was some scheme of production involved which represented the business enterprise of the manager, as well as the presentation of the ideas of the author. The ideas of the author again are not entirely embodied in language which reaches the audience in word sung or spoken. The “business” of the play is sometimes never reduced to writing, and in the majority of cases the production of the brain of a third person, the skilled stage manager, is of the very essence of the play, and is at times the determining factor which makes the play a success. So, in its last analysis, the name of a play is the medium which signifies to the patrons of the theatre three things: the literary production of the playwright, the artistic aid of the stage manager, and the moneyed investment as well as the skill in cast selection of the manager. And these three things disregard the accompanying investi-

21—Gannert v. Rupert, 62 C. C. A. 594, 127 Fed. Rep. 962, reversing S. C., 119 Fed. Rep. 221.

ture of costumes, scenery, and incidental music which represent the efforts of the musician, the landscape painter, the costumer, and the skilled selector of furniture and other accessories. A play title then stands for a kind of personal property which is strictly *sui generis*, the distinguishing mark by which the production is identified to the public before and after the first performance. It is manifest that a play title also carries with it a specific and unique form of goodwill to which all of the things which we have enumerated help to contribute.

The extent to which courts of equity will protect a play from piracy, aside from any question of copyright, is not yet fully determined. The cases are few in number, but are sufficient to establish the general principle that the broad doctrine of unfair competition in trade which we have considered in this book may be invoked wherever deception of the public and injury to the complainant will probably result from a refusal of the injunction. This fact is more important because of the difficulty attendant upon making out a case of copyright infringement where the subject matter involved is a dramatic composition.

In a case in which "L'Aiglon" was the play involved, and in an opinion in which he refers to that name as being a trademark for the plaintiff's organization, Judge McAdam has said, "The question, 'What's in a name' has been answered by the courts in many well-considered cases, wherein the exclusive right to a name possessed or owned by a successful business enterprise has been maintained against imitators and wrongdoers who sought, by an unauthorized use, to deceive the public and profit by the wrong. While courts have in some instances refused injunctive relief to protect the use of the title where plays were dissimilar, and the appropriation a mere coincidence (*Frohman v. Miller*, 8 Misc. Rep. 379, 29 N. Y. Supp. 1109), they have uniformly enjoined

such use where deception of the public and injury to the plaintiff were likely to follow a refusal to grant equitable aid (*Shook v. Wood*, 32 Leg. Int. 264; *Hier v. Abrahams*, 82 N. Y. 519)."²² In a later case the Supreme Court of Illinois affirmed a decree of injunction in a case where the plaintiff was the producer of the play "Sherlock Holmes" and the defendant subsequently produced a play entitled "Sherlock Holmes, Detective." In affirming the decree of injunction, the Supreme Court based the plaintiff's right to equitable relief upon the ground that the names of the respective plays were so similar that the public "would be deceived to believe that the drama of the appellant company was that which the appellee had been producing." The court expressly declined to decide whether or not the plaintiff had a trademark right or property in the words "Sherlock Holmes," basing the relief upon the general rule as to unfair competition, Judge Boggs remarking that "Equity provides a remedy to prevent such unfair and fraudulent competition among business rivals in any and all lines of legitimate trade and business."²³

22—*Frohman v. Payton*, 68 N. Y. Frohman, 202 Ill. 541, 67 N. E. Supp. 849. Rep. 391, affirming s. c., 103 Ill.

23—*Hopkins Amusement Co. v. App.* 613.

CHAPTER V.

THE LOSS OF THE RIGHT TO A TRADEMARK'S USE.

§ 75. **Laches.**—There is no laches where a complainant is only waiting to get a sufficient quantity of evidence to secure a successful prosecution of the infringer,¹ and of course none exists where the complaint has no knowledge of the fact of infringement;² and it has been distinctly held by the federal supreme court that an injunction will not generally be refused on the ground of delay alone.³ Following that decision, it was said by Judge Nixon, in the United States circuit court in the district of New Jersey: "There has been large discussion of the question how far laches, in stopping the infringement of a trademark, will deprive a complainant of the benefits of a preliminary injunction. But that discussion has been put to rest, so far as this court is concerned, by the recent decision of the supreme court in the case of *McLean v. Fleming*,⁴ where it was held that acquiescence of long standing was no bar to an injunction, although it precluded the party acquiescing from any right to an account for past profits."⁵

The rule has always been, however, that laches on the part of the owner of a trademark would be a bar

1—*Cave v. Myers*, Seton (4th ed.), 238; *Lee v. Haley*, 22 L. T. N. S. 251.

2—*Re Farina*, 27 W. R. 456; Seb. 642; *Weldon v. Dick*, L. R. 10 Ch. D. 247; 39 L. T. N. S. 467; Seb. 638; *Taylor v. Carpenter* (1), 3 Story, 458; Cox, 14; Seb. 78; *Taylor v. Carpenter* (2), 2 Wood. & M. 1; Cox, 32; 9 L. T. 514; *Gilka v. Mihalovitch*, 50 Fed. Rep. 427.

3—*McLean v. Fleming*, 96 U. S. 245.

4—*Supra*.

5—*Consolidated Fruit Jar Co. v. Thomas, Cox*, 665. And to the same effect see *La Republique Francaise v. Schultz*, 42 C. C. A. 233, 102 Fed. Rep. 153; *Sanders v. Jacob*, 20 Mo. App. 96; *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.* (4), 116 Fed. Rep. 332, 54 C. C. A. 204.

to his application for a preliminary injunction. Judge Wallace stated the rule as follows: "Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a lawsuit, and delayed legal proceedings until his patience was exhausted. When delay of the owner of a patent or trademark to prosecute infringers has been of a tendency to mislead the public or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing."⁶

In cases of unfair competition, where no technical trademark is involved, a preliminary injunction will be denied where the defendant's goods have been sold openly for many years in the package complained of.⁷

Laches which prevents recovery in one case, will not be a bar to another action of the same complainant against a subsequent infringer. Thus, in the "Hunyadi" cases, the complainant, the vendor of a Hungarian mineral water was denied relief as to the use of the word "Hunyadi" against the vendor of water from another spring in Hungary, upon the ground of laches, fourteen different Hungarian mineral waters having been marketed in the United States under the name "Hunyadi," and the complainant being estopped as to dealers in such Hungarian bitter waters by laches.⁸ Subsequently an American dealer entered the market with an artificial water to which he applied the mark

6—*Estes v. Worthington*, 22 Fed. Rep. 822. To the same effect, see *C. O. Burns Co. v. W. F. Burns Co.*, 118 Fed. Rep. 944.

7—*Von Mumm v. Steinmetz*, 137 Fed. Rep. 168.

8—*Saxlehner v. Nielson*, 179 U. S. 43, 45 L. ed. 77. Same v. *Eisner & Mendelson Co.*, 179 U. S. 19, 45 L. ed. 60.

“Hunyadi.” In affirming a decree granting the injunction, Judge Grosscup said “appellant offers a manufactured water of whose contents the public has no knowledge, and at a cost ruinous to the importation of the genuine water. The Supreme Court never meant, in our judgment, to throw around such a competitor, the protection of the estoppel indicated, or expose the public to a device under which they would drink the waters of Lake Michigan, doctored after appellant’s recipe, in the belief that they were drinking the natural waters of Hungary.”⁹

§ 76. **Laches and acquiescence distinguished.**—“Laches” and “acquiescence” are terms frequently used synonymously, or at least without due regard to their respective meanings. “Laches” imports a merely passive, while “acquiescence” implies an active assent.¹⁰ The supreme court of California has said, “‘Laches’ would strictly seem to imply neglect to do that which ought to have been done; ‘acquiescence’ a resting satisfied with or submission to an existing state of things.”¹¹

“Acquiescence—that is, assent—is tantamount to an agreement.”¹² The supreme court of the United States, by Mr. Justice Swayne, has said: “Acquiescence and waiver are always questions of fact. There can be neither without knowledge. The terms import this foundation for such action. One cannot waive or acquiesce in a wrong while ignorant that it has been committed. Current suspicion and rumor are not enough. There must be knowledge of facts which will enable the party to take effectual action.”¹³

9—Thackeray v. Saxlehner, 60 C. C. A. 562, 125 Fed. Rep. 911, 913.

10—Wood on Limitations, sec. 62.

11—Lux v. Haggin, 69 Cal. 255-269.

12—Matthews v. Murchison, 17 Fed. Rep. 760-766.

13—Pence v. Langdon, 99 U. S. 578-581. See also to the same effect, Allen v. McKeen, 1 Sumn. 276-314; Evans v. Smallcombe, L. R., 3 H. L. 249; Ramsden v. Dyson, L. R. 1 H. L. 129; Reed v. West, 47 Tex. 240.

§ 77. **Acquiescence.**—"The consent of a manufacturer to the use or imitation of his trademark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or implied, when purely gratuitous, may certainly be withdrawn; and when implied, it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license. The existence of the fact may be a proper subject of inquiry in taking an account of profits if such an account shall hereafter be decreed; but even the admission of the fact would furnish no reason for refusing an injunction."¹⁴ This dictum of Judge Duer in *Amoskeag Mfg. Co. v. Spear* is so comprehensive as to warrant its extended quotation above given. While it was held by Vice-Chancellor Wood that a plaintiff's acquiescence in the defendant's use of his mark for two years after the plaintiff had seen it publicly exhibited would disentitle him to relief,¹⁵ an injunction was granted in a case where a dissenting opinion shows that the essential feature of the mark had been used by others than plaintiff with his knowledge for more than twenty years.¹⁶ It has been held in a federal circuit court that acquiescence for a time equal to that prescribed in the statute of limitations must be shown.¹⁷ Acquiescence cannot be inferred and it is revocable if it could be.¹⁸

14—*Amoskeag Mfg. Co. v. Spear*, 2 Sandf. S. C. 599; Cox, 87. The withdrawal of gratuitous permission to use one's name may be made at the pleasure of the party granting such permission. *McCardel v. Peck*, 28 How. Pr. 120.

15—*Beard v. Turner*, 13 L. T. R. N. S. 747; Cox, 717.

16—*Gillott v. Esterbrook*, 47 Barb. 455 Cox, 340. Dissent of Ingraham, J.

17—*Taylor v. Carpenter* (2), 2 Wood. & M. 1; Cox, 32. But "laches for even less than the statutory period of limitations, aided by other circumstances, will bar a right." *Acheson, J., in Prince's Met. Paint Co. v. Prince Mfg. Co.*, 6 C. C. A. 647, 57 Fed. Rep. 938-944, where the plaintiff was held to be estopped by eight years' acquiescence.

18—*Gillott v. Esterbrook*, *supra*;

"In England the rule is stringent in trademark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trademark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant."¹⁹

§ 78. **Abandonment.**—The consideration of laches and acquiescence leads us naturally to the subject of abandonment. The first form of abandonment is by disuse of the mark. "That the right to use a trademark may be lost by abandonment or disuse is too clear to need argument or the support of authority."²⁰ But the length of time during which the mark is not used is immaterial except when it is such as, taken in connection with all the circumstances, will show the intention of its owner to abandon it.²¹ "A man who has a trademark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose he lost his trademark by not putting more goods on the market when it was glutted."²² Registration was refused in England where the applicant's mark "Emollio" had not been used by him for eleven years, and his applica-

Amoskeag Mfg. Co. v. Spear, *supra*;
Christy v. Murphy, 12 How. Pr.
77; Cox, 164; Seb. 137; Menen-
dez v. Holt, 128 U. S. 514.

19—Nixon, J., in Sawyer v. Kellogg, 9 Fed. Rep. 601.

20—Hughes, J., in Blackwell v. Dibrell, Fed. Case No. 1475, 3 Hughes, 151; 14 Off. Gaz. 633; Price & Steuart, 39; Seb. 590;

Laverne v. Hooper, Ind. L. R. 8 Mad. 149; Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376.

21—Burt v. Tucker, 178 Mass. 493, 59 N. E. Rep. 1111, 52 L. R. A. 112; Gillett v. Lumsden, 4 Ont. Law Rep. 300.

22—Chitty, J., in Monson v. Boehm, L. R. 26 Ch. D. 398-400; Cartmell, 233.

tion was opposed by one who had, in the meantime, registered the word "Emolline" as a trademark for articles similar to those upon which the applicant intended to affix his mark (perfumery).²³ Before the courts will declare an abandonment by disuse there must be satisfactory proof of intention of abandonment. It has been suggested by Chitty, J., that such intention will be gathered from the owner's acts in breaking up the moulds by which the mark is made, and taking the trade-marked article from his price lists.²⁴

It must be borne in mind, in this connection, that the defense of abandonment is not favored by the courts. One judge has said, "there is something very abhorrent in allowing such a defense to a wrong."²⁵ Although as a matter of course a trademark once abandoned may be adopted by another for the same class of merchandise,²⁶ there must be clear proof of the fact of abandonment,²⁷ and it ought to be clearly shown that such other person is adopting the same mark fairly and honestly, and not in an attempt to filch from its original owner the reputation he has obtained for it.²⁸ What act or acts will constitute an abandonment must be determined by the facts in each particular case. One English decision held that a dismissal of a bill for injunction was an abandonment of the trademark sought to be protected by the bill.²⁹

The abandonment of names used in connection with particular premises where selling or manufacturing is conducted has led to some apparent conflicts of opinion

23—*Re Grossmith*, 6 R. P. C. 180; 60 L. T. N. S. 612; *Cartmell*, 137.

24—*Monson v. Boehm*, L. R. 26 Ch. D. 398-405; *Cartmell*, 233.

25—*Woodbury, J., in Taylor v. Carpenter* (2), 2 Wood. & M. 1; *Cox*, 32.

26—*Menendez v. Holt*, 128 U. S. 514; *Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-382.

27—*Sohl v. Geisendorf*, 1 Wilson (Ind.), 60; *Seb*, 367.

28—*Royal Baking Powder Co. v. Raymond*, 70 Fed. Rep. 376-382.

29—*Browne v. Freeman*, 12 W. R. 305; 4 N. R. 476.

among the courts. Careful analysis of the facts will show that there is some semblance of harmony in the rulings. Whether a removal from the premises will constitute an abandonment of the use of the name depends on whether the name indicates the building itself, or merely the business conducted therein. Thus, "Booth's Theatre" designated the theatre and not the actor, and upon its sale by Edwin Booth he could not restrain his vendee from the use of the name, as Messrs. Jarrett & Palmer had fully advertised the fact that they were lessees and managers, and no question of fraud could be raised.³⁰ As stated by Wallace, J., in *Atlantic Milling Co. v. Robinson*: "The right to the exclusive use of a word or symbol as a trademark is inseparable from the right to make and sell the commodity which it has been appropriated to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than of the proprietor. A trademark of this description is of no value to the original proprietor because he could not use it without deception, and therefore would not be protected in its exclusive enjoyment. Such a trademark would seem to be an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence. It should be deemed to pass with a transfer of the business because such an implication is consistent with the character of the transaction and the presumable intention of the parties."³¹

30—Booth v. Jarrett, 52 How. Pr. 169.

31—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 218; citing

Dixon Crucible Co. v. Guggenheim, 3 Am. L. T. 228; Hudson v. Osborne, 39 L. J. Ch. N. S. 79; Shipwright v. Clements, 19 W. R.

So that the use of the name "Stillman" to indicate the cloth product of the Stillman Mills;³² "Old Oscar Pepper" to indicate the product of the distillery of that name;³³ "Osborne House" to designate a hotel first owned by Osborne;³⁴ "Tower Palace," designating a building, having a tower, where a clothing business was conducted,³⁵ are all held to be indicative of the premises and abandoned by the owner of the name who sells the premises or removes therefrom. It follows that a mere arbitrary name not designating the locality or building in which a business is transacted will survive a change in the location of the business.³⁶

The length of time during which a trademark is not used is, as we have seen, merely a circumstance to be considered with all the other facts in the case in determining whether there was an intention to abandon its use. Thus, defendants have been restrained from using a mark that has lain in disuse for periods of one year,³⁷ three years,³⁸ four years,³⁹ nine years,⁴⁰ ten years,⁴¹ and even twenty years.⁴² The vital question is the intention

599. See also to the same effect Hall v. Barrows, 4 DeG. J. & S. 150; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 227-234; Kidd v. Johnson, 100 U. S. 617; Leather Cloth Co. v. American Leather Cloth Co., 11 Jur. N. S. 513; Ainsworth v. Walmesley, 44 L. J. 555.

32—Carmichael v. Latimer, 11 R. I. 395.

33—Pepper v. Labrot, 8 Fed. Rep. 29.

34—Hudson v. Osborne, 39 L. J. Ch. N. S. 79.

35—Armstrong v. Kleinhaus, 82 Ky. 303.

36—Dewitt v. Mathey (Ky.), 35 S. W. Rep. 1113 (not officially reported).

37—Lemoine v. Gauton, 2 E. D. Smith, 343; Cox, 142.

38—Julian v. Hoosier Drill Co., 75 Ind. 408.

39—Burt v. Tucker, 178 Mass. 493, 59 N. E. Rep. 1111, 52 L. R. A. 112.

40—Lazenby v. White, 41 L. J. N. S. 354; Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19. An injunction was refused because plaintiff delayed action for nine years in Amoskeag Co. v. Garner, 55 Barb. 151.

41—Wolfe v. Barnett, 24 La. Ann. 97.

42—Gillott v. Esterbrook, 48 N. Y. 374.

of the owner of the mark, and the burden of establishing abandonment lies upon the party who affirms it.⁴³

There may be an involuntary abandonment of a trademark through the fact that, once distinctive, it has ceased to indicate the merchandise of the owner of the mark and has become *publici juris* because it indicates only a peculiar product or method of manufacture. This again arises from the peculiar circumstances of each case. "What is the test by which a decision is to be arrived at, whether a word which was originally a trademark has become *publici juris*? I think the test must be whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trademark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically as the right to a trademark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trademark, the right to the trademark must be gone." This extract from an opinion of Mellish, L. J.,⁴⁴ is probably the clearest explanation of the cases involving this topic. The cases turning upon this point are many.⁴⁵

43—Julian v. Hoosier Drill Co., 78 Ind. 408. This is analogous to the rule that where one sued for infringing a trademark sets up a prior right to the mark in question, it is incumbent upon him to establish his prior use by satisfactory evidence. Tetlow v. Tappan, 85 Fed. Rep. 774.

44—Ford v. Foster, L. R. 7 Ch. D. 611.

45—Lazenby v. White, 41 L. J.

Ch. 354; Lea v. Millar, Seb. 513; Seton (4th ed.), 242; Lea v. Deakin, Fed. Case No. 8154, 11 Biss. 23; Re Arbenz, L. R. 35 Ch. D. 248; Neva Stearine Co. v. Mowling, 9 Vict. L. R. 98; Sherwood v. Andrews, 5 Am. L. R. N. S. 588; Re Hall, 13 Off. Gaz. 229; Liebig's Extract Co. v. Hanbury, 17 L. T. N. S. 298; Watkins v. Landon, 52 Minn. 389-393; 54 N.

The adoption of a new label or brand is, of course, an abandonment of all the distinctive features of the old label or brand not preserved in the new one.⁴⁶

The owner of a trademark may by a practice of shipping goods bearing the mark to the same consignee, so that it may be held out to or believed by purchasers to indicate some right to the mark in the consignee, lose the exclusive right to its use.⁴⁷

The fact that a manufacturer uses his name or an additional symbol, such as a coat-of-arms, in connection with the distinctive word, does not deprive him of his trademark right in the distinctive word. Thus the manufacturer of "Eureka" shirts, which he marked "R. Ford's Eureka Shirt, London," was awarded an injunction restraining a defendant from the sale of an article marked "The Eureka Shirt."⁴⁸ The manufacturers of "Excelsior White Soft Soap" sought to enjoin the makers of "Bustard & Co.'s Excelsior White Soft Soap," and upon the motion it was held that their right to injunctive relief was not affected by the fact that the defendants had never used the word except in conjunction with their firm name.⁴⁹

A manufacturer who uses his trademark in connec-

W. Rep. 193; 19 L. R. A. 236; Marshall v. Pinkham, 52 Wis. 572; Ward v. Robinson, L. R. 9 Ch. D. 487.

Price & Steuart, 497. The mere 48—Ford v. Foster L. R. 7 Ch. D. 616; L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384. The mere addition of a coat-of-arms to a trademark (as registered in England) is not sufficient to disentitle the person using the mark to sue for an injunction. Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Hammond v. Brunner, 9 R. P. C. 301; Cartmell, 142.

fact that a name used as trademark comes into popular use in a descriptive sense does not invalidate its use as a trademark. Selchow v. Baker, 93 N. Y. 59; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547; Burton v. Stratton, 12 Fed. Rep. 696.

46—Manhattan Medicine Co. v. Wood, 108 U. S. 218; Lea v. Millar, Seton (4th ed), 242; Seb. 513.

47—Robinson v. Finlay, and 49—Braham v. Bustard, 1 H. & M. 447; 9 L. T. N. S. 199; 11 W.

tion with words indicating that his goods are the product of another maker will lose his right to have the word used as trademark protected. This was held in a case where "Eton" cigarettes were so put up as to suggest that they were of foreign manufacture.⁵⁰ But a manufacturer who uses his trademark on goods prepared for the jobbing trade, adding to or using therewith the name of the jobber, does not lose his right to the protection of the trademark, for, as said by Judge Colt: "In doing this no real deceit was practiced upon the public, because the purchaser obtained the same goods which he would have purchased if the name of the jobber had not been upon them."⁵¹ In one case it was argued by the defendants that when the plaintiffs furnished their "Excelsior" stoves to the trade and marked the dealers' names upon the stoves, they thereby permitted the dealer to hold himself out to the public as the manufacturer of the stoves. This was not a successful defense, but the court stood upon the fact that there was "nothing in connection with the names of these dealers to indicate that they are the manufacturers, and there is no evidence that any one ever supposed they were the manufacturers."⁵²

Advertisements published in the United States by

R. 1061; 2 N. R. 572; Seb. 226. The same defense was attempted where "Cottolene" was the trademark and "Cottoleo," with the defendant's name, the alleged infringement. Defendant was enjoined. *N. K. Fairbank Co. v. Central Lard Co.*, 64 Fed. Rep. 133.

50—*Wood v. Lambert*, L. R. 32 Ch. D. 247.

51—*Pike Mfg. Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896-898. "One does not lose the good will of his trade in an article of his

manufacture by placing upon it the names of his customers who are engaged in selling it, nor by the fact that the consumers know only the name and excellence of the article, and neither know nor care who makes it," *Sanborn, J.*, in *Shaver v. Heller & Merz Co.*, 108 Fed. Rep. 821-824, 48 C. C. A. 48. To the same effect, *City Brewery Co. v. Powell*, L. R. (1897), App. Cas. 710, 716; *Lichtenstein v. Goldsmith*, 37 Fed. Rep. 359.

52—*Sheppard v. Stuart*, 13 Phila. 117; *Price & Steuart*, 193.

a corporation having the exclusive sale of certain Hungarian mineral waters, to the effect that the name under which the waters were sold had become a general name for all similar waters, and that the corporation would thenceforth distinguish the particular water sold by it by a special trademark, were held not to evidence an abandonment of the original mark which was binding on the owner of the wells; Mr. Justice Brown announcing the following rule "To establish the defense of abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon. Acts which unexplained would be sufficient to establish an abandonment may be answered by showing that there never was an intention to give up and relinquish the right claimed."⁵³

In the same case, the discontinuance of two suits for infringement, brought by the selling corporation, after preliminary injunctions had been obtained, are held by the supreme court not to be binding upon the complainant in the absence of proof that the discontinuance was made with the complainant's knowledge and acquiescence.⁵⁴

There may be a constructive abandonment of specific features of a trademark, arising from a failure to enumerate such features in securing registration. If the registration shows a claim to a trademark "more limited in its description than the owner's common-law rights would otherwise be, the owner is bound by such limitation as showing what he really claimed."⁵⁵ Thus, in an application for registration of a trademark, the

53—*Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19-31; citing *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 186, 41 L. ed. 118, 125, 16 Sup. Ct. Rep. 1002; *Moore v. Stevenson*, 27 Conn. 14; *Livermore v. White*, 74 Me. 452, 43 Am. Rep. 600; *Judson v. Malloy*, 40 Cal. 299; *Hickman v. Link*, 116 Mo. 123, 22 S. W. Rep. 472.

54—*Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 34.

55—*Hawley, J.*, in *Hennessy v. Braunschweiler & Co.*, 89 Fed. Rep.

failure to claim the letter "s" as a part or feature thereof was held to be an abandonment of that feature of the mark.⁵⁶

A person who acquires a patent covering a manufactured article known by a trademark, may, during the life of the patent, enjoin an infringer even though he has ceased manufacturing the patented article.⁵⁷

664-668; citing *Kohler Mfg. Co. v. v. Diamond Steel Co.*, 85 Fed. Rep. Beeshore, 8 C. C. A. 215; 59 Fed. 637.

Rep. 572; *Richter v. Reynolds*, 8 57—*Janney v. Pan-Coast Ventilator Mfg. Co.*, 128 Fed. Rep. 121.

56—*Pittsburgh Crushed Steel Co.*

CHAPTER VI.

GOODWILL.

§ 79. **Defined.**—Goodwill, because of the various forms in which it exists, is difficult of definition. It may be personal, in which event it is the result of the labor and efforts of the person to whom it belongs and survives a change of locality. It may be local, in which event the personal efforts of those who have created or assisted in creating it have so identified it with the location that it adheres thereto and does not attach to a business subsequently established elsewhere by the same persons. Or, in the case of local goodwill, the goodwill may have largely had its origin in the natural advantages of the locality before any personal exertions have been expended upon it; as, for example, a location upon a water front peculiarly accessible and desirable as a location for the erection of a grain elevator, ship yard, pier or warehouse, where there exists a natural advantage of site before human enterprise erects the elevator or other structure. The goodwill which then arises consists of three things, the natural advantages of the site, the erection of a suitable building or structure with its proper mechanical equipment, and, finally, the good reputation that results from skilful, enterprising, and honest management of the business. The definitions of goodwill, therefore, must be read in the light of these distinctions.

“Goodwill is a modern but important growth of the law, not mentioned by some of the early writers, but given great prominence at the present time.”¹ Mr.

¹—Vann, J., in *People v. Rob-* Rep. 685; 45 L. R. A. 126.
erts, 159 N. Y. 70-80; 53 N. E.

Justice Story has defined goodwill as "the advantage or benefit which is acquired by an establishment beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account of its local position or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices."²

It would be very difficult, if indeed possible, to frame a more accurate and comprehensive definition of local goodwill. This one, as given, has been expressly and *in haec verba* adopted by the supreme court of the United States, Mr. Chief Justice Fuller prefacing his use of it by saying "there is difficulty in deciding accurately what is included under the term."³

2—Story on Partnership, sec. 99.

3—Metropolitan Bank v. St. Louis Dispatch Co., 149 U. S. 436-446. "It is the probability that the business will continue in the future as in the past, adding to the profits of the concern and contributing to the means of meeting its engagements as they come in." Sanderson, J., in Bell v. Ellis, 33 Cal. 620-625.

"Goodwill was defined by Lord Eldon in Cruttwell v. Lye, 17 Ves. 335-346, to be 'nothing more than the probability that the old customers will resort to the old place;' but Vice-Chancellor Wood, in Churton v. Douglas, Johnson, 174-188, says it would be taking too narrow a view of what is there laid down by Lord Eldon to confine it to that, but that it must mean every positive advantage that has been acquired by the old

firm in the progress of its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it the benefit of the business." Mr. Chief Justice Fuller in Menendez v. Holt, 128 U. S. 514-522.

"The goodwill of an established business, which is a common subject of contract, is nothing but the chance of being able to keep the business which has been established." Wallace, J., in Barber v. Connecticut Mutual Life Ins. Co., 15 Fed. Rep. 312, 313.

"It is property of a very peculiar and exceptional character. It is intangible property which, in the nature of things, can have no existence apart from a business of some sort that has been established and carried on at a partic-

§ 80. In particular cases.—“As applied to a newspaper, the goodwill usually attaches to its name rather than to the place of publication. The probability of the title continuing to attract custom in the way of circulation and advertising patronage, gives a value which

ular place.” Thayer, J., in *Metro-
politan Bank v. St. Louis Dispatch
Co.*, 36 Fed. Rep. 722-724.

“The goodwill of a business comprises those advantages which may inure to the purchaser from holding himself out to the public as succeeding to an enterprise which has been identified in the past with the name and repute of his predecessor.” Wallace, J., in *Knoedler v. Boussod*, 47 Fed. Rep. 465, 466. This definition was approved on appeal. *Knoedler v. Glaenger*, 55 Fed. Rep. 895-899.

“Goodwill has been defined as ‘all that good disposition which customers entertain toward the house or business identified by the particular name or firm, and which may induce them to continue giving their custom to it.’ There is nothing marvelous or mysterious about it. When an individual or a firm or a corporation has gone on for an unbroken series of years conducting a particular business, and has been so scrupulous in fulfilling every obligation, so careful in maintaining the standard of goods dealt in, so absolutely honest and fair in all business dealings that customers of the concern have become convinced that their experience in the future will be as satisfactory as it has been in the past, while such customers’ good report of their own experience tends continually

to bring new customers to the same concern, there has been produced an element of value quite as important—in some cases, perhaps, far more important—than the plant or machinery with which the business is carried on. That it is property is abundantly settled by authority, and, indeed, is not disputed. That in some cases it may be very valuable property is manifest.” Lacombe, J., in *Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17-20.

“Goodwill has been defined by this court to be ‘the favor which the management of a business wins from the public, and the probability that old customers will continue their patronage.’” McGrath, J., in *Williams v. Farrand*, 88 Mich. 473-477.

“There is considerable difficulty in defining accurately what is included under this term *goodwill*; it seems to be that species of connection in trade which induces customers to deal with a particular firm. It varies almost in every case, but it is a matter distinctly appreciable which may be preserved (at least to some extent), if the business be sold as a going concern, but which is wholly lost if the concern is wound up, its liabilities discharged, and its assets got in and distributed.” Sir John Romilly, M. R., in *Wedderburn v. Wedderburn*, 22 Beavan, 84-104

may be protected and disposed of and constitutes property."⁴

Goodwill is an appurtenant of every form of business which relies directly upon public favor. We find in the books cases in which the existence of a valuable goodwill is found as appurtenant to a wide range of mercantile pursuits; as, for example, in the business of flour and grain merchants,⁵ the manufacture of patent medicines,⁶ and of ferro plates and picture frames,⁷ the business of a stage-line,⁸ a livery-stable,⁹ a milk-route,¹⁰ a drinking saloon,¹¹ or where the owners of the goodwill were bankers,¹² bakers,¹³ glass-stainers,¹⁴ haberdashers,¹⁵ glass-blowers,¹⁶ brewers,¹⁷ hardware dealers,¹⁸ tailors,¹⁹ cheesemongers,²⁰ provision merchants,²¹ manu-

4—Metropolitan Bank v. St. Louis Dispatch Co., 149 U. S. 436-446; affirming s. c., 36 Fed. Rep. 722. To the same effect see Porter v. Gorman, 65 Ga. 11; Dayton v. Wilkes, 17 How. Pr. 510.

The goodwill and name of a newspaper may attach to the printing plant, so as to be vested in the lessee of the plant. Lane v. Smythe, 46 N. J. Eq. 443-454.

5—Menendez v. Holt, 128 U. S. 514-522.

6—Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; s. c., 139 U. S. 540.

7—Dean v. Emerson, 102 Mass. 480.

8—Pierce v. Fuller, 8 Mass. 228.

9—Herbert v. Dupaty, 42 La. Ann. 343.

10—Munsey v. Butterfield, 133 Mass. 492.

11—Howard v. Taylor, 90 Ala. 241.

12—Smith v. Everett, 27 Beavan, 446.

13—Costello v. Eddy, 12 N. Y. Supp. 236.

14—Scott v. Rowland, 20 W. R. 208.

15—Re Randall's Estate, 8 N. Y. Supp. 652.

16—Featherstonhaugh v. Fenwick, 17 Ves. 298.

17—Hall v. Hall, 20 Beavan, 139.

18—Thompson v. Andrus, 73 Mich. 551.

19—Parsons v. Hayward, 31 L. J. Ch. 666.

20—Hudson v. Osborne, 39 L. J. Ch. 79.

21—Scott v. Mackintosh, 1 V. & B. 503.

22—Turner v. Major, 3 Giff. 442.

23—Armstrong v. Bitner, 71 Md. 118; Thompson v. Winnebago County, 48 Iowa, 155.

24—Macdonald v. Richardson, 1 Giff. 81.

25—Morris v. Moss, 25 L. J. Ch. 194.

26—Potter v. Commissioners of Inland Revenue, 10 Ex. 147.

facturing chemists,²² real estate and fire insurance agents,²³ commission agents,²⁴ mercers,²⁵ paper-makers,²⁶ pencil-makers,²⁷ hotel or public-house keepers,²⁸ whisky merchants,²⁹ dyers,³⁰ dealers in works of art and artists' materials,³¹ dealers in boots and shoes,³² tobacco brokers,³³ hide dealers,³⁴ snuff makers,³⁵ upholsterers,³⁶ iron masters,³⁷ dealers in seeds, grains and plants,³⁸ carriers,³⁹ milliners;⁴⁰ and as we will see elsewhere, physicians, solicitors and attorneys may have a vendible goodwill.

It is patent that a goodwill may be created in connection with any business, enterprise, occupation or profession. The older cases expressly denied the existence of a goodwill which could be the subject of sale, in connection with the learned professions. Thus, Lord Chancellor Chelmsford, as recently as 1858, said: "The term goodwill seems wholly inapplicable to the business of a solicitor, which has no local existence, but is entirely personal, depending upon the trust and confidence which persons may repose in his integrity and ability to conduct their legal affairs."⁴¹

27—Banks v. Gibson, 34 Beavan, 566.

28—Spratt v. Jeffery, 10 B. & C. 249; Lashus v. Chamberlain, 6 Utah, 385; Elliott's Appeal, 60 Pa. St. 161; Musselman & Clarkson's Appeal, 62 Pa. St. 81.

29—Kidd v. Johnson, 100 U. S. 617.

30—Bryson v. Whitehead, 1 S. & S. 74.

31—Knoedler v. Boussod, 47 Fed. Rep. 465; Knoedler v. Glaenzer, 55 Fed. Rep. 895.

32—Curtis v. Gokey, 68 N. Y. 300.

33—Davies v. Hodgson, 25 Beavan, 177.

34—Goodman v. Henderson, 58 Ga. 567.

35—Hammond v. Douglas, 5 Ves. 539.

36—Chissum v. Dewes, 5 Russ. 29.

37—Hall v. Barrows, 4 DeG. J. & S. 150.

38—Iowa Seed Co. v. Dorr, 70 Ia. 481.

39—Cruttwell v. Lye, 17 Ves. 335.

40—Shackle v. Baker, 14 Ves. 468.

41—Auten v. Boys, 2 DeGex & Jones, 626-636. And to the same effect see Sheldon v. Houghton, 5 Blatchf. 285, 291, Fed. Case No.

That there is good reasoning in this dictum cannot be denied. In a case of later date, in Scotland, it was said "there is truly no such thing as goodwill in the case of a business carried on by a professional man, such as a physician, surgeon, or law agent, whose success depends entirely upon his own personal skill. It is quite different in the case of a trade or manufacture, where the employer may have the possession of patents or trade secrets, or may, by long exercise of his trade or manufacture in some particular locality, have drawn together skilled artisans and attracted the custom of a district to his establishment. In such a case it is not the individual skill of the employer, but the reputation which his establishment has acquired, which creates that incorporeal, but frequently valuable, estate known as the 'goodwill' of a trade. But there is no such thing in the case of a professional man. His business dies with him, and the man who comes after him in the district must depend for success upon his own exertions. It is quite true that such businesses are occasionally sold; but what is thus sold in case of a living professional man retiring from business is truly the personal recommendation which the seller gives to his former clients or patients in favor of his successor, coupled with the predecessor's own retirement from business. But where the physician or law agent is dead, nothing of the kind can take place. He has been removed by death from all possibility of competing with the new doctor or the new solicitor, and his voice being forever silenced, he cannot give any recommendation to his clients or patients."⁴²

12,748; *Craver v. Acme Harvester Co.*, 209 Ill. 483, 70 N. E. Rep. 1047, affirming *Acme Harvester Co. v. Craver*, 110 Ill. App. 413. has been held that the goodwill of an attorney was not a subject of administration. *Spice v. James*, Seb. 46; *Arundell v. Bell*, 52 L. J. Ch. 537.

42—Lord Curriehill in *Bain v. Munro*, 15 Scot. L. Rep. 260. It In an early case, however, it

While the courts have, for the reasons stated, looked with disfavor upon executory contracts for the sale of the goodwill of a professional man's practice, and have refused to decree specific performance under such contracts,⁴³ still when the sale is complete and the contract partly executed, its terms will be enforced.⁴⁴ Thus where a solicitor retired, permitting his partner to continue the use of the firm name, in consideration of an annuity to be paid him, and the continuing partner defaulted in the payment of the annuity, the contract was specifically enforced.⁴⁵

In the United States there have been frequent instances of the sale of the goodwill of a medical practitioner, and contracts for such sales have been uniformly held good.⁴⁶

§ 81. As a subject of sale.—"The goodwill of a trade is a subject of value and price. It may be sold,

was held that a contract entered into by a practicing attorney to relinquish practice, recommend his clients to his successor, that he would not practice within certain limits, and would permit the use of his name in the first name of his successor for a certain period, was good in law. (1803) *Bunn v. Guy*, 4 East, 190. And in a similar case, where a solicitor sold his practice and agreed not to practice in Great Britain for twenty years, Lord Langdale held the contract valid and binding on the vendor, and he was enjoined from attempting to resume his practice in Great Britain during the specified time. (1841) *Whittaker v. Howe*, 3 Beavan, 383.

Bevill, 1 Y. & C. Ch. 554; 6 Jur. 407; Seb. 71.

And where a member of a firm of surgeons died, it was held that the survivor could not be obliged to sell the goodwill of the practice for the joint benefit of himself and his deceased partner's estate, Vice-Chancellor Leach remarking that "such partnerships are very different from commercial partnerships." *Farr v. Pearce*, 3 Madd. 74.

43—See last note.

44—*Hanna v. Andrews*, 50 Ia. 462; *Smalley v. Greene*, 52 Ia. 241.

45—*Aubin v. Holt*, 2 K. & J. 66.

46—*Webster v. Williams*, 62 Ark. 101; 34 S. W. Rep. 537; *Bradbury v. Barden*, 35 Conn. 577; *Martin v. Murphy*, 129 Ind. 464; *Pickett v. Green*, 120 Ind. 584; *Hoyt v. Holly*, 39 Conn. 326; *Gilman v. Dwight*, 13 Gray, 356; *Dwight v. Hamilton*, 113 Mass.

But the courts have refused to decree specific performance of a contract for the sale of an attorney's practice. *Bozon v. Farlow*, 1 Mer. 459; Seb. 22; *Thornbury v.*

bequeathed, or become assets in the hands of the personal representative of a trader,"⁴⁷ or it may be mortgaged.⁴⁸

It may be of greater value than the stock of goods or plant of machinery with which the business is carried on,⁴⁹ or it may attach to the mere name of a publication and have a definite value apart from and in no wise dependent upon any tangible property.⁵⁰

It cannot be sold, by a judicial decree or otherwise, apart from the business with which it is connected.⁵¹

It may be given, together with the business with which it is connected, in payment for stock in a corporation, so that stock issued solely for such goodwill will, to the extent of its value, be issued for "property actually received" within the meaning of section 42 of the stock corporation law of the state of New York.⁵² The goodwill of a domestic corporation is property which is taxable as part of its capital stock.⁵³ That of a foreign corporation is liable to taxation "at the place where it has a market value."⁵⁴

175; *Warfield v. Booth*, 33 Md. 63; *Miller v. Keeler*, 9 Pa. Co. Ct. R. 274; *Butler v. Burleson*, 16 Vt. 176; *Tichenor v. Newman*, 186 Ill. 264, 57 N. E. Rep. 826.

But, to the contrary, see *Mandeville v. Harman*, 42 N. J. Eq. 185. In this case the covenant was as follows: "In consideration of this contract, made with him by the said Mandeville, the said Harman hereby covenants and agrees not to engage in the practice of medicine or surgery in the city of Newark at any time hereafter." The court held that the law was unsettled as to whether such a contract was or was not void as in restraint of trade, and therefore denied the preliminary injunction sought for.

47—*Tindal, C. J.*, in *Hitchcock v. Coker*, 6 Ad. & E. 428-454.

48—*Metropolitan National Bank v. St. Louis Dispatch Co.*, 36 Fed. Rep. 722, 724.

49—*Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17-20.

50—*Metropolitan Bank v. St. Louis Dispatch Co.*, 149 U. S. 436-446; *Boon v. Moss*, 70 N. Y. 465.

51—*Robertson v. Quiddington*, 28 Beavan, 529; *Metropolitan National Bank v. St. Louis Dispatch Co.*, 36 Fed. Rep. 722-724; s. c., 149 U. S. 436-446.

52—*Washburn v. National Wall Paper Co.*, 81 Fed. Rep. 17.

53—*Matter of Hondayer*, 150 N. Y. 37.

54—*People v. Roberts*, 159 N. Y. 70; 53 N. E. Rep. 685.

A stockholder (holding less than all of its stock) cannot transfer the goodwill of a corporation.⁵⁵

It is clear that the goodwill of a professional man cannot be made the subject of involuntary sale. In the language of the supreme court of Tennessee, "certainly there can be no forced sale or transfer *in invitum* of such (professional) goodwill so far as it is based upon professional reputation and standing, such as arises from the skill of physicians, dentists, attorneys, etc., whatever may be done as to such goodwill as arises out of location."⁵⁶

It must be remembered that the trademarks and the goodwill of a business are inseparable. We have seen elsewhere that a trademark can have no existence in gross. It is strictly appurtenant to the goodwill of the business in which it is used.⁵⁷ And so it has been said of goodwill that "while it is not necessarily local, it is usually to a great extent, and must of necessity, be incident to a place, an established business, or a name known to the trade."⁵⁸

In a conveyance of goodwill, however, apt words should be employed. Thus it has been held that the goodwill was not covered by a clause in a contract of partnership relating to the partnership "property, credits and effects," or "stock in trade and effects."⁵⁹ And a similar holding has been made in regard to the words "premises, stock in trade, etc.,"⁶⁰ as well as

55—Spring Valley Water Works v. Schottler, 62 Cal. 69, 118.

56—Wilkes, J., in Slack v. Sudoth, 102 Tenn. 375.

57—"As an abstract right, apart from the article manufactured, a trademark cannot be sold, the reason being that such transfer would be a fraud upon the public." Colt, J., in Morgan v. Rogers, 19 Fed. Rep. 596. And to same effect,

Witthaus v. Braun, 44 Md. 303;

Hoxie v. Chaney, 143 Mass. 592; 10

N. E. Rep. 713; Russia Cement

Co. v. Le Page, 147 Mass. 206, 17 N.

E. Rep. 304.

58—Vann, J., in People v. Roberts, 159 N. Y. 70-83; 53 N. E. Rep. 685; 45 L. R. A. 126.

59—Hall v. Hall, 20 Beavan, 139.

60—Burfield v. Rouch, 31 Beavan, 241.

where the words "estate and effects" were used in partnership articles.⁶¹

On the other hand, Lord Westbury construed the words, "stock belonging to the partnership," to include the goodwill,⁶² and other eminent judges have held goodwill to be included in the words "moneys, stocks in trade, debts, effects and things,"⁶³ and "property and effects,"⁶⁴ while Vice-Chancellor Malins said: "The sale of a business is a sale of the goodwill. It is not necessary that the word 'goodwill' should be mentioned. . . . In the sale of a business a trademark passes, whether specially mentioned or not." He accordingly held that goodwill was included in an assignment that conveyed all the assignor's interest in the partnership premises and effects, without specifically referring to the goodwill.⁶⁵ In a suit for the specific performance of a contract for the purchase of a share in a business, in which the expression "goodwill, etc." was employed, Lord Romilly was of opinion that "these words are connected together, and unite such other things as are necessarily connected with and belong to the goodwill, many of which are easily pointed out; for instance, the use of trademarks. . . . All these would be included in the words *et cetera*, and would be included in the conveyance."⁶⁶

The words "business connections and patronage" have been held to convey the goodwill.⁶⁷

In this connection it is to be noted that there are two general classes of goodwill—general and local. The

61—*Steuart v. Gladstone*, L. R. 10 Ch. D. 646.

62—*Hall v. Barrows*, 4 DeG. J. & S. 150.

63—*Rolt v. Bulmer*, Seb. 614.

64—*Reynolds v. Bullock*, 47 L. J. Ch. 773.

65—*Shipwright v. Clements*, 19 W. R. 599. But a mortgage of the

entire assets of a business does not necessarily include the goodwill. *Santa Fe Electric Co. v. Hitchcock* (New Mex.), 50 Pac. 332.

66—*Cooper v. Hood*, 26 Beavan, 293.

67—*Kellog v. Totten*, 16 Abb Pr. 35.

distinction is well-drawn in an English case, as follows: "In some classes of business, when the trade has long been carried on in a profitable manner in a particular house, and a new tenant comes in and continues to carry on the same business there, it is found by experience that many, if not all, of the customers resort there as before. This is found so regularly to happen that it has become usual to pay a money value for it, which is commonly called 'goodwill.' It may be that there may be a species of goodwill which may be the subject of bargain and sale, although not dependent on the business being carried on in any particular place; for instance, in the case of what are called 'quack-medicines.' But when we come to speak of the goodwill of a public-house, it is obvious that it is a thing which is attached to a locality."⁶⁸ In accordance with this rule, whenever the goodwill is local, in the sense of being attached to a particular house or store, it will pass with a sale of the lease of the trading premises,⁶⁹ or the sale of a public house,⁷⁰ or even a tailoring establishment.⁷¹

§ 82. **Goodwill subject to proceedings in eminent domain.**—Where the goodwill of a business transacted on particular premises has been injured by the invasion of the realty in eminent domain proceedings, the Massachusetts court has said that such goodwill of a lessee or owner "is not property for which damages can be included, and is to be considered only so far as it tends to embrace the market value of the estate that is injured."⁷²

68—*Llewellyn v. Rutherford*, L. Ch. D. 226; *Elliott's Appeal*, 60 R. 10 C. P. 456. Pa St. 161.

69—*Daugherty v. Van Nostrand*, 1 Hoff. Ch. (N. Y.) 68; *Williams v. Wilson*, 4 Sandf. Ch. 379. 71—*Parsons v. Hayward*, 31 Beavan, 199; *Chittenden v. Witbeck*, 50 Mich. 401-421.

70—*Ex parte Punnett*, L. R. 16 72—*Edmonds v. Boston*, 108 Mass. 549.

§ 83. **Goodwill in its relation to firm and other names.**—While the unity existing between goodwill and trademarks is clearly defined, the subject of trade-names or firm-names in their relation to goodwill is attended with some difficulty. The general rule has been well stated by Vice-Chancellor Wood, as follows: “The name of a firm is a very important part of the goodwill of the business carried on by the firm. A person says: ‘I have always bought good articles at such a house of business; I know it by that name, and I send to the house of business identified by that name for that purpose.’ There are cases every day in this court with reference to the use of the name of a particular firm, connected generally, no doubt, with the question of trademark. But the question of trademark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you are parting with the goodwill of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You cannot put it anything short of that. That the name is an important part of the goodwill of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm.’”⁷³ This dictum, however, is flatly opposed to the rulings of the American courts, that the sale of the goodwill of a business carries with it no right to the use of the ven-

dor's name as the name of the establishment,⁷⁴ although the purchaser may properly advertise himself as being "successor to" his vendor.⁷⁵ And the later English cases indicate that the rule has been somewhat modified in England, Justice Stirling saying, "the defendant is entitled to use the plaintiff's name in the business so long and so far as he does not by so doing expose him to any liability, but no further."⁷⁶ The American courts have very properly gone to the length of holding that, upon the withdrawal of a partner, the remaining partners will be enjoined from continuing the use of a firm name which indicates that the withdrawing partner is still a member of the firm.⁷⁷ Where the name is not a proper name, its subsequent use by the vendor of the goodwill will of course be enjoined.⁷⁸

§ 84. **Rights of vendor.**—The vendor of the goodwill of a business may, in the absence of any agreement to the contrary, re-engage in a competitive business.⁷⁹

As said by Chief Justice Bigelow in the supreme court of Massachusetts: "Whenever such is the intent of the parties, it is carried into effect by an express stipulation, which, if not in undue restraint of trade, may be valid and binding. But we know of no case where any such agreement has been raised by mere implication, arising from the sale of the goodwill of a person's trade, in connection with a particular place of business where it has been carried on."⁸⁰

74—Knoedler v. Glaenger, 55 Fed. Rep. 895; Reeves v. Denicke, 12 Abb. Pr. N. S. 92.

75—Knoedler v. Glaenger, 55 Red. Rep. 895; Weed v. Peterson, 12 Abb. Pr. N. S. 178.

76—Thynne v. Shove, L. R. (1890) 45 Ch. D. 577-582.

77—McGowan v. McGowan, 22 Ohio St. 370.

78—Drake v. Dodsworth, 4 Kas. 159.

79—Hoxie v. Chaney, 143 Mass. 592-596; 10 N. E. Rep. 713, 58 Am. Rep. 149; Trego v. Hunt, 65 L. J. Ch. 1.

80—Bassett v. Percival, 87 Mass. (5 Allen), 345-347; and to the same effect see Porter v. Gorman, 65 Ga. 11; Knoedler v. Boussod, 47 Fed. Rep. 465; Knoedler v. Glaenger, 55 Fed. Rep. 895; Bergamini v. Bastien, 35 La. Ann. 60, 48 Am. Rep. 216; White v. Jones,

In a later case involving the sale of the goodwill of a medical practice, the same court distinguished the facts from those in the case quoted from, and held that a sale of this kind of goodwill contained by implication a covenant not to re-engage in the medical practice in the same locality.⁸¹

An English writer has said, "As the decisions at present stand, the title to this section is to some extent misleading, inasmuch as the legal position of the assignor of a business, after he has parted with it, is in no way different from that of any other member of the public, provided, of course, that he has not bound himself by additional restrictive covenants."⁸² Even in the absence of express stipulation, good faith requires of a party who has sold the goodwill of his business that he should do nothing which tends to deprive the purchaser of its benefits and advantages. It is clear that he has no right to hold himself out as continuing the business which he sold to the plaintiff, or as carrying on his former business at another place to which he has removed.⁸³ In other words, in every case of the sale of a goodwill the vendor must not enter into an unfair competition with his purchaser. What will con-

1 Abb. Pr. N. S. 337; *Howe v. Searing*, 6 Bosw. 354; *Crutwell v. Lye*, 17 Ves. 335; *Dayton v. Wilkes*, 17 How. Pr. 516; *Hanna v. Andrews*, 50 Ia. 462; *Cottrell v. Babcock Mfg. Co.*, 54 Conn. 138; *Costello v. Eddy*, 128 N. Y. 650; *Williams v. Farrand*, 88 Mich. 473; *Jackson v. Byrnes*, 103 Tenn. 698, 54 S. W. Rep. 984; *Holbrook v. Nesbit*, 163 Mass. 120; 39 N. E. Rep. 794; *Grimm v. Walker*, 45 Iowa, 106; *Smith v. Gibbs*, 44 N. H. 335; *Moody v. Thomas*, 1 Disney 294; *Washburn v. Dosch*, 68 Wis. 436, 32 N. W. Rep. 551; *Bradford v. Peckham*, 9 R. I. 250; *Rupp v.*

Over, 3 Brewst. 133; *Moreau v. Edwards*, 2 Tenn. Ch. 347; *Palmer v. Graham*, 1 Pars. Eq. Cas. 476; *Findlay v. Carson*, 97 Iowa, 537, 66 N. W. Rep. 759; *Drake v. Dods-worth*, 4 Kansas, 135; *Ranft v. Reimers*, 200 Ill. 386, 60 L. R. A. 291, 65 N. E. Rep. 720.

81—*Dwight v. Hamilton*, 113 Mass. 175.

82—Allan on Goodwill, p. 32.

83—*Hoxie v. Chaney*, 143 Mass. 592-597, 10 N. E. Rep. 713; *Hall's Appeal*, 60 Pa. 458, 100 Am. Dec. 584; *Knoedler v. Glaenger*, 5 C. C. A. 305, 55 Fed. Rep. 895.

stitute such unfair competition must be determined in the light of all the facts in each particular case.

§ 85. **Covenants not to re-engage in business.**—As we have seen, the mere sale of a goodwill does not carry with it by implication a covenant that the vendor will not re-engage in the same business. Consequently, such covenants must be expressed in terms, and the construction of such covenants is a matter of law. While, as we have seen, the goodwill itself will be passed by the conveyance of the business, without special mention, the agreement of the vendor not to re-engage in the same business should be as explicit, both as to time and as to the territory, as the circumstances of the case will permit. A frequent defense to an action, based upon covenants not to re-engage in business, is that the contract is void at common-law as being an unreasonable restraint of competition in trade. The general rule of the common-law is stated by Mr. Bishop to be as follows: "An agreement, without limitation, not to carry on a particular trade, which is lawful and beneficial to the community and to the individual, is void as against public policy."⁸⁴

A covenant not to re-engage in business will not be implied from the vendor's covenant in the bill of sale "to warrant and defend the sale of the said property and interest, as herein stated."⁸⁵

84—Bishop on Contracts, Section 515.

85—Costello v. Eddy, 12 N. Y. Supp. 236. Agreements upon dissolution are construed by the same rules as other contracts, with a view of ascertaining the actual intent in the minds of the parties. Thus in a covenant which read "the said Rivers covenants that he will not engage in the manufacture

of furniture so long as said Bagby continue such business," it was held that Bagby's conveyance of the business to a corporation was a discontinuance of the business by him, and Rivers was entitled to resume the furniture business if he saw fit. Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

86—Welz v. Rhodius, 87 Ind. 1; Spier v. Lambdin, 45 Ga. 319.

A verbal agreement not to engage in a rival business does not come within the statute of frauds. It may be valid when made as collateral to and distinct from a lease of premises, provided the parol agreement is made in consideration of the execution of the written lease.⁸⁶ But in an action at law upon a contract of sale, such collateral parol agreement cannot be shown or recovered on.⁸⁷

A contract not to re-engage in business must, like any other contract, be founded on a sufficient consideration or it will not be enforced.⁸⁸ And the plaintiff in an action upon such a contract must not be guilty of any breach on his part, or he will be denied relief in equity.⁸⁹

A covenant not to re-engage in business may not specify the territory in which the vendor is precluded from doing business. If from all the circumstances of the case it appears that it was the intention of the party to limit the territory to a town, county or state, the contract will be so construed, and the vendor will be enjoined from continuing or re-entering business in the territory so fixed.⁹⁰

The courts of late years have relaxed the old rules so that the restrictive covenant may be unlimited as to area. "It cannot be said that the early doctrine that contracts in general restraint of trade are void, without regard to circumstances, has been abrogated. But it is manifest that it has been much weakened, and that the foundation upon which it was originally placed has, to a considerable extent at least, by the change of circumstances, been removed."⁹¹

87—Costello v. Eddy, 12 N. Y. Supp. 236; Herbert v. Dupaty, 42 La. Ann. 343. lis v. Shaffer, 38 Kas. 492; Johnson v. Moss, 45 Cal. 515.

88—Onondaga Co. Milk Association v. Wall, 17 Hun, 494. 90—Hubbard v. Miller, 27 Mich. 15.

89—Cassidy v. Metcalf, 1 Mo. App. 593-601; s. c. 66 Mo. 519; Hol- 91—Andrews, J., in Diamond Match Co. v. Roeber, 106 N. Y. 473-484. The cases are reviewed at length in this opinion.

The subject of contracts in restraint of trade is outside of the scope of this book, but the following extract from the opinion of Mr. Justice Bradley concisely covers the principles which govern the construction of all covenants of the kind under consideration: "There are two principal grounds on which the doctrine is founded, that a contract in restraint of trade is void as against public policy. One is, the injury to the public by being deprived of the restricted party's industry; the other is, the injury to the party himself by being precluded from pursuing his occupation and thus being prevented from supporting himself and his family. It is evident both these evils occur when the contract is general, not to pursue one's trade at all, or not to pursue it in the entire realm or country. The country suffers the loss in both cases; and the party is deprived of his occupation, or is obliged to expatriate himself in order to follow it. A contract that is open to such grave objection is clearly against public policy. But if neither of these evils ensue, and if the contract is founded on a valid consideration and a reasonable ground of benefit to the other party, it is free from objection and may be enforced.

"In accordance with these principles it is well settled that a stipulation by a vendee of any trade, business or establishment, that the vendor shall not exercise the same trade or business, or erect a similar establishment within a reasonable distance, so as not to interfere with the value of the trade, business or thing purchased, is reasonable and valid. In like manner a stipulation by the vendor of an article to be used in a business or trade, in which he is himself engaged, that it shall not be used within a reasonable region or distance, so as not to interfere with his said business or trade, is also valid and binding. The point of difficulty in these cases is to determine what is a reasonable distance within which the prohibitory stipulation may lawfully have

effect. And it is obvious, at first glance, that this must depend upon the circumstances of the particular case; although, from the uncertain character of the subject, much latitude must be allowed to the judgment and discretion of the parties. It is clear that a stipulation that another shall not pursue his trade or employment at such a distance from the business of the person to be protected, as that it could not possibly affect or injure him, would be unreasonable and absurd. On the other hand, a stipulation is unobjectionable and binding which imposes the restraint to only such an extent of territory as may be necessary for the protection of the party making the stipulation, provided it does not violate the two indispensable conditions, that the other party be not prevented from pursuing his calling, and that the country be not deprived of the benefit of his exertions.”¹

The covenant not to re-engage in business may be entered into by the stock holders of the corporation, whose capital stock and goodwill is being conveyed to a purchaser. The sale of the stock alone does not carry with it by implication a covenant not to re-engage; indeed, the California court has held in a case where the covenant not to re-engage was supported only by the sale of stock in a corporation, that as the sale of the stock could not carry with it the goodwill of the corporation, the element of goodwill did not enter into the transaction, and the covenant was void as being in restraint of trade.²

The following agreement of stock holders made collaterally with the sale of the business and goodwill of their corporation contains a typical covenant of the kind under consideration: “This instrument witnesseth, that William Vernon Booth has purchased the

1—Oregon Steam Nav. Co. v. Windsor, 20 Wall., 64-72.

2—Merchants' Ad-Sign Co. v. Sterling, 124 Cal. 429.

plant, business and goodwill of the business of the Davis Fresh & Salt Fish Co., and has paid therefor the sum of \$17,473.14; that in making said transfer, and as an inducement to said William Vernon Booth to purchase said plant, business and goodwill and pay the sum aforesaid for the same, we each have agreed that we would not, and we now do agree, each for himself, jointly and severally with him, the said William Vernon Booth, his heirs and assigns, forever, that we will not during the next ten years, in the territory or the immediate vicinity of the territory dealt in by our company, engage or in any manner be interested in, either directly or indirectly, for ourselves or for others, the same or like kind or character of business as that heretofore conducted and now being carried on by said company, its officers, agents, employees and assigns, and that we will not, during the said period of ten (10) years, either directly or indirectly, be guilty of any act interfering with the business, its goodwill, its trade or its customers, or come in competition with the same; and we will not, jointly or severally either in firms or corporations, or as individuals or in any other way, directly or indirectly interfere with the said trade or business, or do any act prejudicial to the same or any part thereof, or interfere with the persons employed therein; the meaning hereof being that the said William Vernon Booth is buying and paying for the goodwill of the business in the largest and fullest scope of the term; and that we will not, and each agrees that he will not, do anything to interfere with or injure the said business, but will during said period, lend his aid and best influence to the promotion and advancement of the same."

It was urged in defense of a bill filed by the purchaser to restrain the share holders from the violation of this agreement, that it was void because in violation of the Anti-Trust Act of July 21, 1890. This de-

fense did not prevail because the contract did not have, upon its face, a direct relation to interstate commerce. It was further urged that the covenant was void of common-law because it was an unreasonable restraint of competition in trade. This defense also failed, inasmuch as the covenant was merely ancillary to the conveyance of the goodwill of the corporation. The general rule was announced by the court "that such stipulation is valid if it goes no farther than to support and protect the interests transferred by the contract of sale."³

§ 86. **The valuation of goodwill.**—It is manifestly a matter of great difficulty to secure an accurate valuation of goodwill. Like a trademark it has no value except as an integral portion of the business with which it is connected, and of which it is a part. We have considered some of the things that enter into goodwill, and it is obvious that its value is a thing entirely independent of the cash value of the physical assets of the business of which it is a part. In fact, goodwill is frequently sold at a valuation far in excess of the total value of all of the physical properties of the business. On the other hand, the value of a goodwill is liable to sudden and violent fluctuation as is the value of a trademark.

A single shipment of inferior goods may render the trademark under which they are packed, a thing of no value, and personal goodwill depends for its value upon the continued activity and integrity of the person or persons to whom it belongs.

Concerning the valuation of the goodwill of a partnership, the Massachusetts court has said, "While no rule can be laid down by which the goodwill of a trading partnership in all cases can be ascertained and its value fixed with mathematical precision and accuracy,

³—Severens, J., in *Davis v. A. Booth & Co.*, 65 C. C. A. 269, 131 Fed. Rep. 31, 38.

yet if it be assumed that a firm has been in existence for a time long enough to establish a business sufficiently permanent in character to include not only its customers, but the incidents of locality, and a distinctive name, these advantages constitute a going business enterprise; and it may then be said that the name and what is done under it go together, and a goodwill exists which forms an asset of commercial value in a winding up between partners. The fact that such an asset may be difficult of appraisement is no legal reason for denying to the retiring partner an appraisal, if it be proved that he is entitled to it."⁴

An English text writer says, "The usual basis of valuation is the average net profits made during the few years preceding the sale,"⁵ and in accordance with this rule, an English court has assessed the value of the goodwill of a banking business at one year's average net profits.⁶

The value of the goodwill of a professional practice has been based upon two years' net profits.⁷

It is evident that all the facts relating to the character of the goodwill, the probability of the continuance of its value, and any other matters which render its duration a matter of doubt or certainty, must be considered in an attempt to place a value upon it. Thus, where the goodwill was being conveyed in administration, the fact that the brother of the testator had been interested in the business, and could not be prevented from carrying it on in competition with a purchaser, rendered the goodwill valueless as a subject of sale by the executor.⁸ In estimating the value of the interest

4—*Moore v. Rawson*, 185 Mass. 264, 70 N. E. Rep. 64, citing *McMurtrie v. Guiler*, 183 Mass. 451, 454, 67 N. E. Rep. 358.

5—*Allan on Goodwill*, page 82.

6—*Mellersh v. Keen*, 28 Beav. 453.

7—*Featherstonhaugh v. Turner*, 25 Beav. 382.

8—*Davies v. Hodgson*, 25 Beav. 177.

of a deceased partner in the goodwill of the business, the rights of the surviving partner must be taken into account.⁹

§ 87. **Competition between vendor and vendee.**—The vendor is at liberty to lease or sell other property he may own in the neighborhood, to another person who may carry on the same business, provided there is no collusion, and the lessor has no interest in the business.¹⁰

In the absence of a covenant or statute to the contrary, the vendor may employ any fair method of soliciting trade which does not involve a false or fraudulent representation.¹¹ But the English rule and that in Rhode Island is that he cannot directly solicit from former customers.¹² No form of soliciting trade will be permitted however which tends directly to deprive the vendee of the benefit of the reputation of the business purchased by him, to take away from him the patronage which appertained to it, or to draw away the business of its habitual customers.¹³

The goodwill of the business of a decedent does not carry with it the right to use the decedent's name.¹⁴ Such goodwill is an asset to be accounted for by the personal representative, and if that representative takes

9—Smith v. Everett, 27 Beav. 446.

10—Bradford v. Peckham, 9 R. I. 250-253; Herbert v. Dupaty, 42 La. Ann. 343.

11—Holbrook v. Nesbitt, 163 Mass. 120; 39 N. E. Rep. 794, Cottrell v. Babcock, 54 Conn. 138; Vonderbank v. Schmitt, 44 La. Ann. 264; Marcus Ward & Co. v. Ward, 40 N. Y. State Rep. 792; Knoedler v. Boussod, 47 Fed. Rep. 465; Close v. Flesher, 59 N. Y. State

Rep. 283; Knoedler v. Glaenger, 55 Fed. Rep. 895, 5 C. C. A. 305.

12—Trego v. Hunt, 65 L. J. Ch. 1; L. R. (1896) A. C. 7; 12 Eng. Ruling Cases, 442; Labouchere v. Dawson, L. R. 13 Eq. 322; Zanturjian v. Boornazian, R. I., 55 Atl. Rep. 199.

13—Munsey v. Butterfield, 133 Mass. 492-495. Citing Angier v. Webber, 14 Allen 211.

14—Morgan v. Schuyler, 79 N. Y. 490; Re Randall's Estate, 8 N. Y. Supp. 652-654.

charge of the business and conducts it as his own he is chargeable with the value of the goodwill.¹⁵

Equity looks with disfavor upon any method of diverting from the purchaser of a goodwill the benefits which ought to come to him by reason of his purchase. Thus, where partners sold out their interest in the goodwill of a partnership known as the Kalamazoo Wagon Company, and then organized a corporation under the name of Kalamazoo Buggy Company, they were enjoined, at the suit of their vendee, from the use of that name; and the court held that the writ of injunction properly ran against all persons connected with the corporation.¹⁶

A statute of California provides that "One who sells the goodwill of a business thereby warrants that he will not endeavor to draw off any of the customers."¹⁷

In another case one Thomson was a partner of his brother, in Europe, and a partner of other persons in a separate establishment in New York. Both houses were dealing in "Thomson's Glove-fitting" corsets. Thomson sold out his interest in the New York house and afterward attempted to sell the corsets made by him in Europe, in the United States. He was enjoined from so doing, the court holding that, when he assigned his interest in the goodwill of the New York partnership, the good-will carried with it all his right to use the trade-mark "Thomson's Glove-fitting" in the United States.¹⁸

In a sale of a physician's practice, where the vendor, after three months, returned to the same city and opened an office fifteen rods away from, in the nearest house but one to, his former office, the supreme court of Massachusetts held his conduct to be a breach of the implied covenant "that the vendor will not himself do anything

15—Re Randall's Estate, 8 N. Y. 115; 19 L. R. A. 82. Supp. 652.

17—Cal. Civ. Code § 1776; Snow

16—Myers v. Kalamazoo Buggy v. Holmes, 71 Cal. 142.

Co., 54 Mich. 215; Brass & Iron Works Co. v. Payne, 50 Ohio St. 18—Batchellor v. Thomson, 86 Fed. Rep. 630.

to disturb or injure the vendee in the enjoyment of that which he has purchased."¹⁹

When an article of manufacture has had the manufacturer's name applied to it, and he sells his business and goodwill and "confers the authority to use his name," so applied, to his vendee, he will be enjoined from again engaging in a similar business under his own name.²⁰

A covenant by the vendor not to re-engage in business may not specify the territory in which he is precluded from doing business. If from all the circumstances of the case it appears that it was the intention of the parties to limit that territory to a town, county or state, the contract will be so construed, and the vendor will be enjoined from continuing or re-entering business in the territory so fixed.²¹ A single act or sale in the line of the business sold is not a breach of a covenant not to re-engage in a particular "business," as business is carried on by an aggregation of acts.²²

A vendor of a good-will may not do indirectly what he is forbidden, by the terms of his contract, from doing directly. So if he form a corporation to carry on his business, and the other incorporators have knowledge

19—Endicott, J., in *Dwight v. Hamilton*, 113 Mass. 175-177. Where the vendor re-engaged in the same (a mercantile) business in the same vicinity, a bill in equity brought by him to reform the contract of sale was dismissed on the ground that he had not done equity. *Cassidy v. Metcalf*, 1 Mo. App. 593-601. This decision was reversed by the supreme court of Missouri, but that court agreed with the St. Louis court of appeals in holding that "the plaintiff's conduct was not characterized by that good faith with which a party should always approach a

court of equity when asking its assistance." *Cassidy v. Metcalf*, 65 Mo. 519.

20—*Frazer v. Frazer Lubricator Co.*, 121 Ill. 147, 13 N. E. Rep. 639; *Ayer v. Hall*, 3 Brewst. 509; *Filkins v. Blackman*, Fed. Case No. 4786, 13 Blatch. 440; *Probasco v. Bouyon*, 1 Mo. App. 241.

21—*Hubbard v. Miller*, 27 Mich. 15.

22—*Parkhurst v. Brock*, Vt. 47 Atl. Rep. 1068; citing *Hoagland v. Segur*, 38 N. J. Law 237; *Turner v. Evans*, 2 El. & El. 512; *Re Horton*, 45 Law T. (N. S.) 541.

of his contract, the corporation will be enjoined from conducting business with or for the vendor.²³ And he is not at liberty to take stock in or to help to organize or manage a corporation formed to compete with his vendee,²⁴ nor may he deliver goods within the prohibited territory, although maintaining his store and making the sales without that territory.²⁵

If he re-engages in business under the pretense of acting as a broker or commission agent only, the same rule applies and he will be enjoined.²⁶ And again, the rule applies where the defendant re-engages in the prohibited business as the salaried employee of a third person, and he will be enjoined.²⁷ In a case where the vendor covenanted to make the goodwill as valuable as he could, Lord Eldon held that the vendee was not bound to take the actual profit made, but that he would "have an action of covenant, if he can establish his title to more through the default of the vendor."²⁸

Where a limit of time is fixed in the covenant against re-engaging in business, the vendor may re-engage in the business upon the expiration of the time. But where the covenant was made jointly with a conveyance of the vendor's good-will, he was restrained after he re-engaged in business from making personal solicitation of his former customers and using extracts from their books in relation to the business.²⁹

23—*Beal v. Chase*, 31 Mich. 490. *Battershell v. Bauer*, 91 Ill. App.

24—*Kramer v. Old*, 119 No. Car. 181.

1; 56 Am. St. Rep. 650.

25—*Love v. Stidham*, 18 App. D. C. 306.

26—*Richardson v. Peacock*, 33 N. J. Eq. 597.

27—*Finger v. Hahn*, 42 N. J. Eq. 606. *Emery v. Bradley*, 88 Me. 357; 34 Atl. Rep. 167; *Meyer v. Labau*, 51 La. Ann. 1726; *Boutelle v. Smith*, 116 Mass. 111; *Jefferson v. Markert*, 112 Ga. 498, 37 S. E. Rep. 758. Opposed to these cases see

28—*Scott v. Mackintosh*, 1 V. & B. 503. As a matter of course such a covenant will not be created by implication. Where the vendor conveyed the good-will of a school, it was held that the sale did not bind him by implication to exert his efforts thereafter to secure the attendance of pupils. *McCord v. Williams*, 96 Pa. St. 78.

29—*Armstrong v. Bitner*, 71 Md. 118-127.

The sale of a business and its goodwill do not, in the absence of an express agreement, entitle the purchaser to use the vendor's name, even where he covenants not to re-engage in the business for a term of years.³⁰

§ 88. **Partnership goodwill.**—Disputes as to goodwill arise most frequently between partners. The various text-writers who have treated the law of partnership have dwelt at length upon the principles of the law of goodwill which are applicable in this connection, so that for the purpose of this book a brief glance at the leading principles will suffice.

As we have seen elsewhere, every man has the right to use his own name in business, so long as he does not use it in such a way as to establish an unfair competition.

The use of the name of a withdrawing partner, as part of the firm name, in such a way as to expose him to liability or to the possibility of being sued, will be enjoined at his suit.³¹ The better rule would seem to be that in the absence of express agreement the firm name will not pass to one who purchases the assets of a partnership.³²

30—Scheer v. American Ice Co., 66 N. Y. Supp. 3.

31—McGowan v. McGowan, 22 Ohio St. 370; Peterson v. Humphrey, 4 Abb. Pr. 394.

32—Williams v. Farrand, 88 Mich. 473; 50 N. W. Rep. 446. Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. Rep. 816. This rule is not yet clearly established. Thus the supreme court of Ohio says: "Upon the dissolution of a trading copartnership its assets, including the good-will of the business, may be sold as a whole, either by the partners directly, or through a receiver under an order made by a court in a case to which they are par-

ties; and that a purchaser thereof under either method of sale is entitled to continue the business as the successor of the firm, and make use of the firm name for that purpose. And further, that when the purchaser transfers the property so acquired by him to a corporation of which he is a member, organized to succeed to the business, it may carry on the business in the same manner under a corporate name, including the name which has been used by the firm." Williams, J., in Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86-96; 43 N. E. Rep. 325, citing Brass & Iron Works v. Payne, 50 Ohio St. 115.

When one partner has been expelled from the partnership because of his violation of its articles, he will not, in the absence of contract binding him not to re-engage in the business, be enjoined from doing similar business in his own name, and soliciting patronage from customers of the old firm.³³ A surviving partner who has the right to use the firm name may enjoin his deceased partner's executor from using the firm name for his own benefit.³⁴

Upon the appointment of a receiver for the firm assets, either member of the firm will be enjoined from so using his own name as to mislead the public into the belief that he has acquired the goodwill, since such injunction is necessary to the preservation of the goodwill as part of the firm assets.³⁵

A retiring partner who has sold the other the firm property, without making mention of the goodwill, will be granted an injunction against any use of the firm name by the continuing partner which would give the public reason to believe he was still a member of the firm, to the injury of his new business.³⁶

Upon the dissolution of a partnership the partner who retains the use of the old premises may lawfully advertise the premises as being "formerly occupied by" the old firm, and either partner may advertise himself as being "formerly of" or "late of" the firm, using words that convey only the facts and have no tendency

33—Dawson v. Beeson, L. R. 24 Ch. D. 504.

34—Lewis v. Langdon, 7 Sim. 422.

35—Bininger v. Clark, 60 Barb. 113. Where a retiring partner stipulated that the continuing partner might continue the use of his name in the style of the firm, it has been held that the assignment

of the right to use the name is personal and cannot be transferred by the continuing partner to another. Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. Rep. 816; Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

36—McGowan v. McGowan, 22 Ohio St. 370.

to deceive or mislead the firm's customers or the public generally.³⁷

Where the retiring partner permits the old firm name (of which his name is a part) to be used, and makes no publication of the fact of his retirement, he is estopped from denying the copartnership, as against a creditor of the continuing partner, who has extended credit in the belief that he is still a member of the firm.³⁸

Upon administration of a partnership estate, the goodwill should be included in the appraisalment of the partnership assets, and if the surviving partner appropriates it to his own use by continuing the partnership business, he may be compelled to account for its value to the estate of the deceased partner.³⁹

Where a partner came into a partnership for a fixed period, agreeing, "to carry on business with the defendants for one year, and then to leave it in their hands," he was held to have acquired thereby no interest in the goodwill of the business.⁴⁰

Upon the retirement of a partner, if he permits the other partners to retain the old premises and continue the use of the firm name, the goodwill remains with the continuing partners.⁴¹

A retiring partner who re-engages in business will be enjoined from using the expressions "our firm", "our new store", and like matter holding out his new concern as continuing the business of the old firm.⁴²

37—*Morgan v. Schuyler*, 79 N. Y. 490; *Holbrook v. Nesbit*, 163 Mass. 120, 39 N. E. Rep. 794.

38—*Backus v. Taylor*, 84 Ind. 503; *Richards v. Hunt*, 65 Ga. 342.

39—*Rammelsberg v. Mitchell*, 29 Ohio St. 22.

40—*Van Dyke v. Jackson*, 1 E. D. Smith (N. Y.) 419; *Duden v. Maloy*, 63 Fed. Rep. 183; 11 C. C. A. 119.

In the latter case the partnership articles provided that the incoming partner's interest should be ascertained annually, and further provided for the sale of his interest to his partner on dissolution at the price ascertained in determining his share. The court held that this disposed of his property in the good-will.

41—*Menendez v. Holt*, 128 U. S. 514.

42—*Fite v. Dorman*, (Tenn.), 57 S. W. Rep. 129.

§ 89. **Remedies.**—The purchaser of a good-will whose enjoyment of it is interfered with may have his remedy either at law or in equity. These remedies are administered on the same general principles which apply to other cases of unfair competition, and which are discussed elsewhere in this book.

The jurisdiction of equity in this class of cases is predicated upon the fact that the injury is continuing, that its further operation can only be restrained by the exercise of the injunctive power of the chancellor, and that damages at law afford no adequate compensation for the injury.

If, however, the plaintiff resorts to an action at law, the measure of his damages is well defined by the supreme court of Missouri: "If plaintiffs lost less than the defendant made, they cannot recover the whole of defendant's profits; if plaintiffs lost more than the defendants made, they would not be limited to defendant's profits. What the plaintiffs have lost by the defendant's breach of covenant, and not what the defendant has gained thereby, is the legal measure of damages in this case."⁴³

The parties to a contract for the sale of a goodwill may provide in the contract for a fixed amount of damages. In the absence of fraud, the sum so fixed will be adopted as the measure of damages by the court.⁴⁴ Where the parties have so agreed upon the amount of damages, the vendee, in case of a breach of covenant, has an adequate remedy at law, and injunction will not lie.⁴⁵ The remedy is for the recovery of the sum so fixed.⁴⁶

43—Hough, J., in *Peltz v. Eichle*, 62 Mo. 171-180. And to the same effect see *Burckhardt v. Burckhardt*, 36 Ohio St. 261.

44—*Tode v. Gross*, 127 N. Y. 480-487, 13 L. R. A. 652, 28 N. E. Rep. 469, 40 N. Y. S. R. 300; *Dakin v. Williams*, 17 Wendell, 447; *Bag-*

ley v. Peddie, 16 N. Y. 469; *Wooster v. Kisch*, 26 Hun. 61.

45—*Martin v. Murphy*, 129 Ind. 464-467. Unless the defendant is insolvent, which fact will make a case for injunctive relief. *Pickett v. Green*, 120 Ind. 584.

The general doctrine that equity

Where there are no damages stipulated, and no substantial injury is proven, the plaintiff is entitled only to nominal damages.⁴⁷ "The loss of profits, if there are data from which the amount may be ascertained with reasonable certainty, the diminution in value of the property sold, all may be regarded as elements of the damages which go to make up the measure of recovery."⁴⁸

Where the defendant has re-engaged in business in violation of a covenant against his so doing, the case is one where "the law will not nicely attempt to limit the amount of reparation, but will extend the line of relief so as to embrace all the consequences of the wrongdoer's act, although quite remote from the original transaction."⁴⁹ The measure of the vendee's damages

will not interfere to restrain a person from doing an act which he has agreed not to do, when liquidated damages have been provided in case he does the act, is subject to this qualification. "The question in every case is, what is the real meaning of the contract? And if the substance of the agreement is that the party shall not do a particular act, and that is the evident object and purpose of the agreement, and it is provided that, if there is a breach of this agreement, the party shall pay a stated sum, which does not clearly appear to be an alternative which he has the right to adopt instead of performing his contract, there would seem to be no reason why a court of equity should not restrain him from doing the act, and thus carry out the intention of the parties. . . . In other words, naming a sum to be paid as liquidated damages does not in itself conclusively establish that the parties contemplated the right to do the act upon

payment of the compensation, and make an alternative agreement for the benefit of the party who has done what he had agreed not to do." Edicott, J., in *Ropes v. Upton*, 125 Mass. 258-261. It has been held in Canada that in event of a breach of such a contract the vendee has his election to enjoin the vendor or recover the amount named as liquidated damages. *Snider v. McKelvey*, 27 Ont. App. 339. 46—*Martin v. Murphy*, 129 Ind. 464.

47—*Taylor v. Howard*, 110 Ala. 468, 18 South. Rep. 311.

48—*Howard v. Taylor*, 90 Ala. 241-244; and to the same effect see *Burckhardt v. Burckhardt*, 42 Ohio St. 474, *Mitchell v. Read*, 84 N. Y. 556; *Mellersch v. Keen*, 28 Beavan, 453; *Rawson v. Pratt*, 91 Ind. 9; *Lashus v. Chamberlain*, 6 Utah, 385; *Gregory v. Spieker*, 110 Cal. 150, 42 Pac. Rep. 576.

49—*Dow v. Electric Co. (N. H.)* 41 Atl. Rep. 288, 42 L. R. A. 569.

will be the amount of profits lost during the term by reason of defendant's unlawful competition, and if, in addition, the goodwill of the business at the end of the term is worth less than it would have been but for defendant's unlawful act, the vendee is entitled to recover that amount.⁵⁰ The vendee cannot recover the profits realized by the vendor through his breach of the contract.⁵¹

For the greater part the remedies open to the owner of a goodwill whose rights are invaded are administered by courts of equity. But injury to a goodwill may be effected in many various ways, for each of which an appropriate remedy will be found either at law or in equity. Thus where a defendant's goodwill has been destroyed by a wrongful attachment, he will be allowed compensation therefor in an action for damages against the attaching creditor.⁵²

In an action at law a petition which alleges that plaintiff has purchased defendant's business and goodwill, and that the defendant agreed not to re-engage in the same line of business for two years, and that in violation of his agreement, he has re-engaged in the same line of business during such period, and thereby damaged plaintiff, has been held good on demurrer.⁵³

The action for damages for breach of contract involving goodwill is governed by the general principles involved in similar actions in trademark cases, which are considered elsewhere in this book.

A contract for the sale of a business and goodwill will be rescinded if the vendor has falsely stated facts in re-

50—*Salinger v. Salinger*, N. H., 45 Atl. Rep. 558; *Buckhardt v. Buckhardt*, 36 Ohio St. 261; *Verges v. Forshee*, 9 La. Ann. 294; *Stewart v. Challacombe*, 11 Ill. App. 379; *Moorehead v. Hyde*, 38 Iowa 382.

51—*Gregory v. Spieker*, 110 Cal. 150, 42 Pac. Rep. 576.

52—*Miller v. Beck* (Iowa), 72 N. W. Rep. 553.

53—*Erwin v. Hayden* (Texas), 43 S. W. Rep. 610.

gard to the value of the goodwill; as where he has represented that his receipts or profits from the business were greater than they actually had been,⁵⁴ or that the premises sold have brought a higher rental than they actually did.⁵⁵ And the misrepresentation has been held to rescind the contract where the misstatement was not made directly to the vendee, but to a third party who communicated it, with the vendor's knowledge, to the vendee.⁵⁶ On the other hand, the duty is imposed upon the vendee to act at once upon learning the facts which justify a rescission. Where he fails to do so he will be bound by his contract, and his remedy lies in an action for damages,⁵⁷ as he may recover damages without rescinding the contract.⁵⁸

Whenever the false representations amount to a warranty, an action for damages will lie even in the absence of proof of fraud. Otherwise the burden is upon the vendee to show that the representation was fraudulently made.⁵⁹

The measure of damages in such case is the difference between the actual value of its property at the time of the purchase, and its value if the property had been what it was represented or warranted to be.⁶⁰

Covenants against re-engaging in business may be specifically enforced, as we have seen, or the vendor may be enjoined from their violation. It has been held in England that with an action for specific performance a claim for damages may be made as an alternative.⁶¹

It has been held that a debtor's goodwill cannot be

54—*Dobell v. Stevens*, 3 B. & C. 623; *Cruess v. Fessler*, 39 Cal. 336.

55—*Lysney v. Selby*, 2 Ld. Raym. 1118.

56—*Pilmore v. Hood*, 5 Bing. N. C. 97.

57—*Dobell v. Stevens*, 3 B. & C. 623.

58—*Snow v. Holmes*, 71 Cal. 142-148.

59—*Redgrave v. Hurd*, L. R. 20 Ch. D. 1.

60—*Morse v. Hutchins*, 102 Mass. 439; *Rawson v. Pratt*, 91 Ind. 9.

61—*Hipgrave v. Case*, L. R. 28 Ch. D. 356.

reached by a creditor's bill, because it is not subject to levy, in satisfaction of their debts.⁶²

The application for injunctive relief is governed by the rules concerning similar applications in trademark cases.

A plaintiff need not allege or prove damages as a prerequisite to an injunction to restrain a defendant from re-engaging in business, in breach of a covenant between the parties.⁶³ When a vendee in applying for an injunction also asked judgment for the possession of the books and papers used by the vendor in the business in which it had engaged in violation of its covenants the order was refused because there was a remedy at law for their recovery.⁴⁶

In cases where the vendor of a goodwill is sought to be restrained from re-engaging in business in violation of his covenant, the amount in controversy is the value of the goodwill, and the federal courts cannot acquire jurisdiction unless the value of the goodwill exceeds \$2,000.⁶⁵

A violation of a covenant not to re-engage in business is a defense to a suit by the vendor upon notes given by the vendee for the purchase money.⁶⁶

Where the covenant not to re-engage is incorporated in the bill of sale, the consideration paid has been held to be not only for the stock of goods, but for the agreement not to re-engage.⁶⁷

Remedy as to infringement of tradenames identified with goodwill.—Many of the actions for breach of contract in relation to the sale of goodwill have had for

62—Lilienthal v. Drucklieb, 84 Fed. Rep. 918.

65—Lawrence v. Times Printing Co., 90 Fed. Rep. 24-28.

63—Anderson v. Rowland, 18 Tex. Civ. App. 460; 44 S. W. Rep. 911.

66—Townsend v. Hurst, 37 Miss. 679.

67—Eisel v. Hays, 141 Ind. 41, 40 N. E. Rep. 119.

64—Lawrence v. Times Printing Co., 90 Fed. Rep. 24-26.

their object the restraint of the vendor in the use of the tradename under which the business has been conducted. Where the goodwill and tradename has been sold, the subsequent use of the name by the vendor will be enjoined, even where the vendor has reserved the right to resume business under any other than the old name.⁶⁸

The relief will be granted where there has been a contract to convey the tradename and goodwill, and the consideration has been paid, though the vendor has not made a formal assignment of the goodwill and name.⁶⁹

The relief will be granted where the vendee does not continue the use of the old name, but conducts the business under his own name.⁷⁰

68—Burckhardt v. Burckhardt, 42 Ohio St. 474, 51 Am. Rep. 842. 70—Grow v. Seligman, 47 Mich. 607, 41 Am. Rep. 737, 11 N. W.

69—United States Cordage Co. v. Wm. Wall's Sons Rope Co., 35 N. Y. Supp. 978, 90 Hun, 429. Rep. 404.

CHAPTER VII.

TRADE SECRETS; RIGHT OF PRIVACY.

§ 90. **Introductory.**—"A secret in trade is fully recognized as property in equity, the disclosure of which will be restrained by injunction."¹ A contract in reference to such a secret cannot be in restraint of trade, "because the public has no rights in the secret."²

When the name applied to a secret preparation is a trademark, no one but the owner of the mark can apply it to the preparation. But if it be not a valid trademark, then the manufacture of the secret preparation, and the placing of it upon the market under the same name, is open to any one who can lawfully discover the secret process.³ But "it is settled that a secret art is a

1—Smith, P. J., in *Champlin v. Stoddart*, 30 Hun, 300-302.

2—*Morse Machine Co. v. Morse*, 103 Mass. 73-75; *Fowle v. Park*, 131 U. S. 88. *Vickery v. Welsh*, 19 Pick. 523-527. "Upon the sale of a secret process, a covenant, express or implied, that the seller will not use the process himself or communicate it to any other person is lawful, because the process must be kept secret to be of any value, and the public has no interest in the question by whom it is used."

Gray, J., in *Central Transportation Co. v. Pullman's Palace Car Co.*, 139 U. S. 24. Citing *Fowle v. Park*, 131 U. S. 88, 97; *Vickery v. Welsh*, 19 Pick. 523-527; *Peabody v. Norfolk*, 98 Mass. 452-460.

3—*Watkins v. Landon*, 52 Minn.

389; 54 N. W. Rep. 193; 19 L. R. A. 236; *Davis v. Kendall*, 2 R. I. 566; *Siegert v. Findlater*, L. R. 7 Ch. D. 801; *Comstock v. White*, 18 How. Pr. 421; *Condy v. Mitchell*, 37 L. T. N. S. 268; *James v. James*, L. R. 13 Eq. 421; *Canham v. Jones*, 2 V. & B. 218; *J. R. Watkins Medical Co. v. Sands*, 83 Minn. 326, 86 N. W. Rep. 340.

"It may also be observed, in this connection, that the word 'property,' as applied to trade secrets and inventions, has its limitations; for it is undoubtedly true that when an article manufactured by some secret process, which is not the subject of a patent, is thrown upon the market, the whole world is at liberty to discover, if it can by any fair means, what the process is, and, when discovery is

legal subject of property,"⁴ and its owner has a vested right to the secrecy of all those who occupy a fiduciary relationship to his business. So that no one who obtains knowledge of the secret by fraud or unfair means will be permitted to avail himself of the fruits of his fraud, by disclosing the secret or manufacturing under it.⁵

§ 91. **Where equity will not interfere.**—"Courts of equity will not interfere by injunction in disputes between the owners of quack medicines, meaning thereby remedies or specifics whose composition is kept secret, and which are sold to be used by the purchasers without the advice of regular or licensed physicians."⁶ And in 1817 Lord Eldon said: "I do not think that the court ought to struggle to protect this sort of secrets in medicine."⁷

Broadly stated, equity will not interfere to prevent the disclosure of secrets by means of which frauds have been committed.⁸

Then there are limits to the extent of the injunction, which will be suggested by the facts in each particular case. For example, in one case which has been frequently cited, the plaintiff was a tanner and manufacturer of leather, owning secret processes relating to the treatment of leather. Two of his former employees

thus made, to employ it in the manufacture of similar articles. In such a case, the inventor's or manufacturer's property in his process is gone; but the authorities all hold that, while knowledge obtained in this manner is perfectly legitimate, that which is obtained by any breach of confidence cannot be sanctioned." Adams, J., in *Eastman Co. v. Reichenbach*, 20 N. Y. Supp. 110-116; affirmed, 29 N. Y. Supp. 1143; 79 Hun. 188.

4—Gray, J., in *Peabody v. Norfolk*, 98 Mass. 452. To the same

effect, see *Stewart v. Hook*, 118 Ga. 445, 45 S. E. Rep. 369, 63 L. R. A. 255; *Dobson v. Graham*, 49 Fed. Rep. 17.

5—*Salomon v. Hertz*, 40 N. J. Eq. 400; *Little v. Gallus*, 38 N. Y. Supp. 487.

6—*Shiras*, Circuit Justice, in *Kohler Mfg. Co. v. Beeshore*, (2), 59 Fed. Rep. 572-574, 8 C. C. A. 215.

7—*Williams v. Williams*, 3 Mer. 157; *Seb*. 26.

8—*Follet v. Jeffreys*, 1 Sim. N. S. 1; *Gartside v. Outram*, 3 Jur. N. S. 39.

were enjoined, on his application, from disclosing any of his secret processes, but, in the absence of any proof of an express agreement of secrecy, the court refused that portion of his prayer for relief which asked that the defendants be enjoined from disclosing "where or from whom the complainant buys his materials, and to whom he sells his goods, or the prices at which he buys or sells;" the chancellor remarking that an agreement in reference to such matters "may well be regarded, in the absence of anything to the contrary in its terms, as limited in its obligation to the time of employment. . . . He (the employee), notwithstanding such agreement, might himself, after leaving the employment, use the knowledge he had obtained. He might sell to the customers of his late employer, and buy of those from whom the latter purchased, and do both in competition with him.'"⁹

§ 92. **Protection in equity.**—Equity will always act to protect trade-secrets, and this protection may be either affirmative or negative in character. In its affirmative form, relief is granted by injunction to restrain the unlawful use of such secrets. In its negative form, equity protects parties and witnesses against the compulsory disclosure of trade-secrets.

The plaintiff's witness who testifies merely to the uses and effects of a secret process is privileged from answering questions on cross-examination disclosing the ingredients of such secret process.¹⁰

Accordingly where the defense to an action for trademark infringement is that plaintiff's goods are injurious, the defendant was not permitted to examine him as to the ingredients of which his goods were composed, the court saying, "if these questions must be answered, every manufacturer will be at the mercy of any one who de-

9—Runyon, C., in *Salomon v. Hertz*, 40 N. J. Eq. 400.

10—*Moxie Nerve Food Co. v. Beach*, 35 Fed. Rep. 465.

sires to extort from him an account of his process, for an attempt to restrain an infringer would result in the disclosing of all that makes the invention valuable.”¹¹

In one of the early cases in which a property right in trade secrets was recognized, the proceeding was one brought to enforce the specific performance of a contract for the sale of the goodwill of a dyer’s business, with the exclusive use of a secret mode of dyeing. Vice-Chancellor Leach sustained the contract and directed its specific performance. In the course of his opinion he said: “Although the policy of the law will not permit a general restraint of trade, yet a trader may sell a secret of business and restrain himself generally from using that secret. Let the master, in settling the deed which is to give effect to this agreement, introduce a general covenant to restrain the use of the secret for twenty years, and a covenant, limited in point of locality, as to carrying on the ordinary business of a dyer, both parties being willing that the agreement should be so modified.”¹²

As against employees who attempt to profit by secrets of which they have obtained knowledge by reason of their employment, the right to relief in equity has always been recognized. In one of the early cases Lord Cranworth said: “There is no doubt whatever that where a party who has a secret in trade employs persons under contract, express or implied, or under duty, express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer.”¹³

11—Tetlow v. Savournin, 15 Phila. 170.

12—Bryson v. Whitehead, 1 S. & S. 74.

13—Morison v. Moat, 21 L. J. Ch. 248; Ansell v. Gaubert, Seton (4th ed.), 235; Peabody v. Norfolk, 98 Mass. 452; Weston v. Hemmons, 2 Vict. L. R. Eq. 121; Hagg

v. Darley, 47 L. J. Ch. 567; Thum Co. v. Tloczynski, 114 Mich. 149; 72 N. W. Rep. 140; Salomon v. Hertz, 40 N. J. Eq. 400; Eastman Co. v. Reichenbach, 20 N. Y. Supp. 110; 29 N. Y. Supp. 1143; 79 Hun. 188; Little v. Gallus, 38 N. Y. Supp. 487; Fralich v. Despar, 165 Pa. St. 24; Merryweather v.

In order to obtain this relief it is not necessary that the employee should have been bound to secrecy by contract. In an opinion dealing with a case of this character, Judge Williams said: "Having entered the service of complainants, and having had imparted to him their secrets, defendant was, in equity and good conscience, obliged to preserve them as sacredly as his own, and this as well without a contract as with it."¹⁴ And another court has stated the rule as follows: "By a careful reading of the various decisions upon this subject, it will be seen that some are made to depend upon a breach of an express contract between the parties, while others proceed upon the theory that where a confidential relation exists between two or more parties engaged in a business venture, the law raises an implied contract between them that the employee will not divulge any trade secrets imparted to him, or discovered by him in the course of his employment, and that a disclosure of such secrets, thus acquired, is a breach of trust and a violation of good morals, to prevent which a court of equity should intervene."¹⁵

Where there is such a contract between employer and

Moore, L. R. (1892) 2 Ch. 518; *Simmons Med. Co. v. Simmons*, 81 Fed. Rep. 163; *Stewart v. Hook*, 118 Ga. 445, 45 S. E. Rep. 369, 63 L. R. A. 255; *Sanitas Nut Food Co. v. Cemer*,—Mich.—, 96 N. W. Rep. 454; *Stone v. Goss*, — N. J. —, 55 Atl. Rep. 736.

The following contract was held valid and binding upon the defendant in *Fraich v. Despar*, *supra*:

"I, Andrew Despar, of the city of Pittsburg, state of Pennsylvania, in the employ of E. C. Fralich, a manufacturer of oils, etc., also of the said city of Pittsburg, do solemnly swear that if the said E. C.

F. makes known to me the ways and secrets of manufacturing and stilling of different kinds of oils, and of the different kinds of grease manufactured by him, that I will not use such knowledge or secrets for my own gain, nor will I ever, so long as I may live, divulge or make known in any way the knowledge I may receive while in his employ, or any part of said secret, either of mix in oils or otherwise."

14—*Simmons Med. Co. v. Simmons*, 81 Fed. Rep. 163-166.

15—*Adams, J., in Eastman Co. v. Reichenbach*, 20 N. Y. Super. 110-116.

employee, it is not objectionable as being in restraint of trade.¹⁶

The obligation of secrecy extends to every character of employment. Thus, canvassers who have accumulated materials in the course of soliciting advertisements for their employer may be enjoined from using such material for a rival publication;¹⁷ and an engine maker's clerk who had made a table of dimensions of his employer's engines was enjoined from disclosing the data so obtained.¹⁸

Where it affirmatively appears that the trade secret exists, that it has been imparted in confidence to the defendant, and that the plaintiff will be injured by the disclosure, if one is made, the defense that defendants do not intend to use or divulge the secret will not be given much weight, for the reason that under the circumstances an injunction cannot harm the defendant, and if the injunction was withheld, and the secret disclosed, the injury to the plaintiff would be one which the law is practically powerless to remedy.¹⁹

Where a designer, employed for his special skill by a manufacturer, makes the entries of formulas invented by him in the course of his employment in books of his own instead of books furnished by his employer for the purpose, the employer is entitled to the knowledge of the formulas.²⁰

The principles under consideration extend beyond the relationship of master and servant. In fact, throughout all of this book that relates to equitable remedies we are but dealing with the application of those remedies which has been made upon specific forms of fraud. The

16—*Simmons Med. Co. v. Simmons*, 81 Fed. 163; *Peabody v. Norfolk*, 98 Mass. 452.

17—*Lamb v. Evans*, L. R. (1892) 3 Ch. 462.

18—*Merryweather v. Moore*, L. R. (1892) 2 Ch. 522.

19—*Russell v. Lundeen*, 72 Off. Gaz. 420.

20—*Dempsey v. Dobson*, 174 Pa. 122, 34 Atl. Rep. 459, 32 L. R. A. 761.

cases analogous to trade secrets are many, and the language of Vice-Chancellor Turner in the leading case of *Morrison v. Moat* is applicable to all of them: "Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred."²¹

So a photographer has been restrained from making prints from a negative bearing the plaintiff's portrait;²² a lithographer, from making copies of the plaintiffs' pictures in excess of the number ordered by the plaintiffs;²³ and the exhibition of etchings, obtained by the defendant through a breach of trust, has been restrained,²⁴ as has the publication of lectures, not published or authorized to be published by the lecturer,²⁵ and the publication of private letters.²⁶

The ground for enjoining the publication of private letters has sometimes been based upon a property right in them,²⁷ and sometimes upon the ground that their publication would be painful to the writer.²⁸

21—*Morrison v. Moat*, 20 L. J. Ch. 248.

22—*Pollard v. Photographic Co.*, 40 C. D. (Eng.) 345. *Moore v. Rugg*, 44 Minn. 28, 9 L. R. A. 58, 46 N. W. Rep. 141. The negative may belong to the photographer, but he has no right of reproduction without the purchaser's consent. *Corliss v. E. W. Walker Co.*, 64 Fed. Rep. 280; *Press Pub. Co. v. Falk*, 59 Fed. Rep. 324.

23—*Tuck & Sons v. Priestler*, 19

Q. B. D. 629, *Levy v. Clements*, 175 Mass. 376; 50 L. R. A. 397.

24—*Albert v. Strange*, 2 DeG. & Sm. 652.

25—*Abernethy v. Hutchinson*, 3 L. J. Ch. 214.

26—*Earl of Lytton v. Devey*, 54 L. J. Ch. 293; *Perceval v. Phipps*, 2 Ves. & B. 19.

27—*Pope v. Curl*, 2 Atk. 342; *Woolsey v. Judd*, 4 Duer 379.

28—*Gee v. Pritchard*, 2 Swanst.

A peculiar state of facts developed in a recent case is worthy of notice. The plaintiff, a hardware dealer, had published and distributed to the trade catalogues in which the prices were marked in figures, letters and characters, according to a secret code devised by plaintiff. The defendant, who owned a copy of the catalogue, so marked with prices in secret characters, obtained a copy of the key to the code from one of the plaintiff's employees, and incorporated the secret code from the key into the catalogue. Upon this state of facts the defendant was enjoined from disclosing the information thus obtained, and a receiver was appointed to take charge of the defendant's copy of the catalogue.²⁹ This case appears to be in conflict with the English case of *Reuter's Telegram Co. v. Byron*, where the plaintiffs devised a cypher code containing cypher words indicating the names of their customers. This cypher was communicated to the defendant while he was in the employment of the plaintiffs. After he left the plaintiffs and started a rival business, he sent advertisements to their customers stating that he had their cyphers, and soliciting their custom. The court held that the defendant was guilty of no breach of trust because the cyphers were known to the customers, and the defendant could have obtained the cyphers from any of them who might choose to do business with him.³⁰ The decision of the American court seems to be correct in principle.

In every case where the plaintiff seeks protection for a trade secret, it must appear that it really is a secret. If a so-called secret process is lawfully known to others in the trade, no one will be enjoined from disclosing or

402; *Wetmore v. Scovell*, 3 Edw. Ch. 515.

29—*Simmons Hardware Co. v.*

Waibel, 1 So. Dak. 488, 47 N. W. Rep. 814, 11 L. R. A. 267.

30—*Reuter's Telegram Co. v. Byron*, 43 L. J. Ch. 661.

using it.³¹ But the fact that the secret has been the subject of a patent, since expired, which remained a mere paper patent, and dormant, does not negative the fact that it is or may be still a secret. "Many an invention and many an idea of value are doubtless to be found in the records of the patent office, but so far as public actual knowledge thereof is concerned, they might as well be non-existent."³²

Contracts relating to trade secrets are, of course, subject to the same rules of construction as other contracts. So in a case where the defendant sold a formula for making certain soap and "agreed to file and surrender his right and claims in the process and formulæ and making of said soap," and that he "would not sell any plants in the United States for the manufacture of that particular kind of soap, during the term of twenty years," it was very properly decided that the contract did not preclude him from selling or putting up any other kind of a soap plant to or for anybody else; and where he put up a soap plant for making soaps in general, and the owner of the plant then began the manufacture of the particular soap in question, there was no cause of action either as against him or the owners of the plant.³³

Employees may be enjoined from disclosing trade secrets even in the absence of an express agreement of secrecy, as we have seen, and it is no defense that the employee was a minor at the time he entered the employment.³⁴

A defendant had agreed upon entering the employment of the plaintiff as a workman, on a salary, to disclose certain secret processes known only to him. He

31—Bell & Bogart Soap Co. v. Petrolia Mfg. Co., 54 N. Y. Supp. 663-666; Bristol v. Equitable Life Assurance Society, 132 N. Y. 264; 30 N. E. Rep. 506.

33—Bell & Bogart Soap Co. v. Petrolia Mfg. Co., 54 N. Y. Supp. 663.

34—Little v. Gallus, 38 N. Y. Supp. 487.

32—Shiras, J., in Benton v. Ward, 59 Fed. Rep. 411-413.

failed to make the disclosure and left the plaintiff's employment. In defense to an application for an injunction restraining him from imparting the secret processes to others, he urged that his employment had been for no definite term. This defense did not avail in view of the fact that the plaintiff had invested in material it expected to use in connection with the secret processes. The court observed that "although the processes were not patented, yet, as they were secret, and as their secrecy was protected by the contract between the defendant and the plaintiff, the plaintiff is in a situation to insist that the defendant, who agreed to protect the secrecy of these processes, and thus preserve their value, should not be permitted to disclose them, and thus deprive the plaintiff of the valuable property which he had induced it to purchase."³⁵

Where an employe of a partnership invents a secret process for the use of the firm, either member of the firm may after dissolution use the secret process, and either member will, on the complaint of another member, be enjoined from representing himself as being the sole owner of such secret process.³⁶

Trade secrets or processes, if reduced to writing, are subject to levy and sale under a common-law writ of execution.³⁷ Where one not a party to the suit had machinery of his own, used in connection with a secret process belonging to him, on premises belonging to a corporation for which a receiver was appointed, on the facts being presented to the court the order appointing the receiver was so modified as to permit the third party to remove his machinery from the premises, and without the receiver being given the opportunity to inspect the machinery, as such inspection would lead to the dis-

35—Rumsey, J., in *National Gum* 25 N. Y. Supp. 857; affirmed, 83 & *Mica Co. v. Braendly*, 51 N. Y. Hun, 43; 31 N. Y. Supp. 857. Supp. 93-97.

37—*Hanley v. Fidelity Ins. T. & S. Co.*, 8 Pa. Dist. R. 207.

36—*Baldwin v. Von Micheroux*,

covery of the process.³⁸ Trade secrets, such as recipes or processes are proper subjects of taxation.³⁹ A false representation as to the efficiency of a secret process is ground for rescinding a contract for its sale.⁴⁰

It would seem clear, on principle, that a witness not a party to a suit would be fully protected against any attempt to compel him to disclose his trade secrets, yet we find a case holding that a *subpoena duces tecum* calling for the production of drawings by such a witness was enforced, notwithstanding his objection that the drawings related to a secret process used by him.⁴¹ This decision is unsupported by any authority. On the other hand, a defendant in an action for infringement of a process patent will not be compelled to submit to an inspection of his factory where his answer avers that his process is not that of the patent, and is his own secret, unpatented process, used from a period antedating the patent in suit.⁴² § 4908, United States Revised Statutes, a provision relating to the taking of testimony in interference cases pending in the Patent Office, provides that no witness shall be guilty of contempt for disobeying a subpoena issued by the clerk of any court of the United States, as provided for by § 4906, "for refusing to disclose any secret invention or discovery made or owned by himself." In an interference proceeding, one of the parties to the interference refused to answer an interrogatory propounded to him, placing his refusal upon the ground that the question sought to disclose a secret discovery or invention, such as is protected by § 4908. It was held that the witness was not entitled to the protection of the section for the rea-

38—Witt v. Reed Electric Co., 187 Pa. 424; 41 Atl. Rep. 317.

39—Re Brandreth, 59 N. Y. Supp. 1092; 28 Misc. Rep. 468.

40—Finley Rubber-Varnish & Enamel Co. v. Finley, N. J. Ch. 32 Atl. Rep. 740.

41—Johnson Steel Street Rail Co. v. North Branch Steel Co., 48

Fed. Rep. 191.

42—Stokes Bros. Mfg. Co. v. Heller, 56 Fed. Rep. 297.

son that the alleged secret possessed so intimate a connection with the subject-matter of the patent, that he had no right to withhold it from the public. The court said, "In applying for the patent it was his duty to disclose the most available method known to him of carrying the discovery into effect—in other words, of manufacturing his new fabric. This information, which may be used by others after his patent has expired, is an important part of the compensation which the public obtains for the temporary monopoly granted him. If he could withhold it, disclosing an inferior method simply, which he does not employ, the discovery would never become available public property, as the patent laws contemplate it shall. He would have a monopoly after his patent had expired, which would continue as long as he could conceal this material part of his discovery. I do not say that such disclosure was essential to the validity of his patent, (that question is not before me,) but the information withheld does not constitute such a secret as the section, or equity, protects."⁴³

It is no defense to an action for royalties on the manufacture of articles invented by the plaintiff and made under his direction and from dies furnished by him, that the article was not patented; "so long as the inventor holds the secret in his own possession, it is property, or a thing of value, for the transfer of which he may demand a price; and, if he passes it over to a purchaser on an agreement to pay, it is no defense to the latter to say that there is no patent."⁴⁴ One who has become bound as an employee not to divulge a trade secret, cannot defend on the ground that the secret was dishonestly procured by complainant's assignee.⁴⁵ The

43—*Dornan v. Keefer*, 49 Fed. Rep. 462, 58 Off. Gaz. 1093.

45—*Vulcan Detinning Co. v. American Can Co.*, N. J. Ch., 58

44—*Mitchell, J.*, in *Kroegher v. McConway & Forley Co.*, 149 Pa. St. 444-457; 23 Atl. Rep. 341.

Atl. Rep. 290.

general rule, however, is well settled, that "if the giving of the testimony sought, or the production of the documents called for will disclose what are characterized as 'trade-secrets,' the witness has a legal privilege to withhold it."⁴⁶ In a bill to enjoin the disclosure of a secret process, it is not necessary to state what the process is.⁴⁷

§ 93. **The right of privacy.**—Judge Cooley said "the right of one's person may be said to be a right of complete immunity; to be let alone."⁴⁸ This "right to be let alone," if extended to the unauthorized publication of the portrait of an individual, would constitute the right of privacy concerning which there has been considerable discussion of late years. To say whether that right will ever be generally recognized, would be merely a guess in the present state of the adjudications, and the guess would be much more hazardous, if one were to say whether or not the right of privacy could ever be extended to the protection of anything more than the reproduction of the portrait of an individual. As yet, there are but few decisions upon the subject, although it has been considerably discussed in legal and other periodicals.⁴⁹

The difficulty attendant upon the assertion of this right appears to reside principally in the apparent impossibility of extending the protection of equity to this "right to be let alone," to anything beyond the mere unauthorized reproduction of the likeness of an individual, without creating a species of *lese majeste*, and establish-

46—Cochran, J. in Crocker-Wheeler Co. v. Bullock, 134 Fed. Rep. 241, 245.

47—S. Jarvis Adams Co. v. Knapp, 58 C. C. A. 1, 121 Fed. Rep. 34, 40.

48—Cooley on Torts, 139.

49—"The Right of Privacy," 4

Harv. Law Rev. 193. Other articles, 32 Cent. L. J. 69; 40 Cent. L. J. 53; 49 Cent. L. J. 379; 55 Cent. L. J. 123; 57 Cent. L. J. 361; 36 Am. Law Rev. 614; 12 Yale L. J. 35; 24 Nat. Corp. Rep. 709; 25 Nat. Corp. Rep. 183, 415.

ing a judicial censorship of all critical matter relating to an individual, which happens to displease him.

Thus, Judge Parker has stated, in his recent opinion denying the existence of the right of privacy, that "the so-called 'right of privacy' is, as the phrase suggests, founded upon the claim that a man has a right to pass through this world, if he wills, without having his picture published, his business enterprises discussed, his successful experiments written up for the benefit of others, or his eccentricities commented upon, either in hand-bills, circulars, catalogues, periodicals, or newspapers; and necessarily, that the things which may not be written and published of him must not be spoken of him by his neighbors, whether the comment be favorable or otherwise."⁵⁰ This dictum calls attention to the *reductio ad absurdum* which would result if the "right to be let alone" were to be literally asserted. And at the threshold of the inquiry, it is obvious that this "right to be let alone" must be so limited as not to interfere with freedom of speech. The right of the individual to be protected against publication of false and defamatory matter is fully established, and adequately protected by the law. In going beyond the law of slander and libel, in recognition of the individual's right not to be even criticised, or commented upon, a task is being undertaken which is both delicate and difficult, if it is not, indeed, impossible. That any such right existed in the common law has been asserted, but scarcely proven. Again quoting from Judge Parker, "mention of such a right is not to be found in Blackstone, Kent, or any other of the great commentators upon the law, nor . . . does its existence seem to have been asserted prior to about the year 1890."⁵¹

Of course, the absence of precedent does not negative

50—Roberson v. Rochester Folding Box Co., 171 N. Y. 540.

51—Roberson v. Rochester Folding Box Co., 171 N. Y. 540.

the absence of a right and its corresponding remedy, but the right, about which so much has been written with the result that the only definition of it which has been formulated is contained in the words "the right to be let alone," a definition which, on its face, cannot be literally construed, and whose necessary limitation seems to be incapable of definition, must be closely scrutinized, and carefully weighed before it can secure a place in our jurisprudence.

In 1892 this right was distinctly affirmed by the supreme court of New York in a case⁵² in which an injunction issued against the execution and display at the Chicago World's Fair of a statue of Mrs. Schuyler, which statue was to be designated "The Typical Philanthropist." The proceeding was brought by a relative of Mrs. Schuyler, and the injunction issued against the members of an unincorporated association under whose auspices the display was to be made. The motion for injunction *pendente lite* was granted upon the ground that Mrs. Schuyler was not a public character because she had not placed herself before the public, either in accepting public office or in becoming a candidate for office, or as an *artiste* or *literateure*. This order being appealed from, Van Brunt, P. J., said: "While concurring with the conclusion arrived at by the learned justice below, I cannot subscribe to the doctrine which seems to pervade the opinion rendered upon the decision of the motion, that if Mrs. Schuyler had been a public character, as defined by him, this motion should have been denied. The claim that a person who voluntarily places himself before the public, either by accepting public office or becoming a candidate for office, or as an artist or literary man, thereby surrenders his personality while living and his memory when dead to the public, to be used or abused, as any one of that irre-

52—Schuyler v. Curtis, 19 N. Y. Supp. 264.

sponsible body may see fit, cannot for a moment be entertained. . . . It is urged upon the part of the appellants that even if Mrs. Schuyler were alive, and had the same objection to the defendants' proposed action that the plaintiff now has, she would be remediless and powerless. If such were the fact, it would certainly be a blot upon our boasted system of jurisprudence that the courts were powerless to prevent the unwarranted doing of things by persons who are mere volunteers, which would wound in the most cruel manner the feelings of many a sensitive nature. It is further urged that the plaintiff has no standing in court and that the fancied injury to the plaintiff complained of, if any such injury can be in any way discovered, is certainly not such an injury as the court will grant an injunction to prevent, because it is not an injury to his person, to his estate, or to his good name, and is not a violation of his privacy or seclusion, and because the plaintiff stands in the same relation to the defendants and to their project as does all the rest of the world, and in no other relation. The result of this claim is that when a person is dead there is no power in any court to protect his memory, no matter how outrageously it may be insulted. The feelings of relatives and friends may be outraged, and the memory of the deceased degraded with impunity, by any person who may desire thus to affect the living. It seems to us that such a proposition carries its own refutation with its statement. It cannot be that by death all protection to the reputation of the dead and the feelings of the living, in connection with the dead, has absolutely been lost. The memory of the deceased belongs to the surviving relatives and friends, and such relatives have a right to see that that which would not have been permitted in respect to the deceased when living shall not be done with impunity when the subject has become incapable of protecting himself. It is undoubtedly true that cases of the char-

acter now before the court are not to be found in the books. But it is probably the first time in the history of the world that the audacious claim which is here presented has ever been advanced. If it had, we have no doubt the books would have contained a record in connection with the same. The fact that the plaintiff has suffered no pecuniary damage, redress for which is sought in this action, is no answer to the application, because one of the most important departments in the jurisprudence of courts of equity is the prevention of wrongs which would be otherwise irreparable because courts of law cannot afford any remedy in damages.”¹

Upon entering judgment in the same case, Ingraham, J., calls attention to the fact that the action of the defendants was not a libel nor within the provisions of the New York constitution securing to each citizen the right to freely speak, write and publish his sentiments on all subjects.²

In a subsequent case (1893) the superior court of New York city reaffirmed the doctrines of *Schuyler v. Curtis* in the case of an actor whose portrait was to be published in connection with that of another member of his profession as the subjects of a voting contest to ascertain which was the more popular, and such publication was enjoined; the court remarking that “the courts will in such cases secure to the individual what has been aptly termed the right to be let alone.”³

In 1895 *Schuyler v. Curtis* reached the New York court of appeals, and in an elaborate opinion delivered by Judge Peckham the judgment of the lower court was reversed. In the course of his opinion, however, he says: “For the purpose we have in view it is unnecessary to wholly deny the existence of the right of privacy

1—*Schuyler v. Curtis*, 64 Hun, 594.

3—*Marks v. Jaffa*, 26 N. Y. Supp. 908, 6 Misc. Rep. 290.

2—*Schuyler v. Curtis*, 24 N. Y. Supp. 509-511.

to which the plaintiff appeals as the foundation of his cause of action. It may be admitted that courts have power in some cases to enjoin the doing of an act where the nature or character of the act itself is well calculated to wound the sensibilities of an individual, and where the doing of the act is wholly unjustifiable, and is, in legal contemplation, a wrong, even though the existence of no 'property,' as that term is generally used, is involved in the subject.

"If the defendant had projected such a work in the lifetime of Mrs. Schuyler, it would perhaps have been a violation of her individual right of privacy, because it might be contended that she had never occupied such a position towards the public as would have authorized such action by any one as long as it was in opposition to her wishes." Judge Gray in a dissenting opinion, stated, "I cannot see why the right of privacy is not a form of property, as much as the right of complete immunity of one's person."⁴ Concerning this case, the supreme court of Georgia has stated that it "settles nothing as to the existence of a right of privacy, but merely rules that if it exists at all, it is a personal right, and dies with the person."⁵

Judge Parker has said of this decision that "It is not authority for the existence of a right to privacy which entitles a party to restrain another from doing an act which, though not actionable at law, occasions the plaintiff mental distress."⁶

Pending this appeal another New York court had held that "a parent cannot maintain an action to enjoin the unauthorized publication of the portrait of an infant

4—Schuyler v. Curtis, 42 N. E. Rep. 22-24; 147 N. Y. 434; 49 Am. St. Rep. 671; 31 L. R. A. 286.

5—Pavesich v. New England Life Ins. Co., 50 S. E. Rep. 68.

6—Roberson v. Rochester Folding Box Co., 171 N. Y. 540.

child, and for damages for injury to his sensibilities caused by the invasion of his child's privacy, for the law takes no cognizance of a sentimental injury, independent of a wrong to person or property."⁷

In 1902 the New York court of appeals finally held that there was no right of privacy at law or enforceable in equity.⁸

The supreme court of Michigan in 1899 held that it had no jurisdiction to enjoin the use of the name and likeness of a deceased person used upon a label applied to a cigar named after him, so long as such publication did not amount to a libel. At the conclusion of an exhaustive review of the cases, Hooker, J., said: "This 'law of privacy' seems to have obtained a foothold at one time in the history of our jurisprudence, not by that name, it is true, but in effect. It is evidenced by the old maxim, the greater the truth the greater the libel; and the result has been the emphatic expression of public disapproval, by the emancipation of the press and the establishment of freedom of speech, and the abolition in most of our states of the maxim quoted, by constitutional provisions."

"The limitation upon the exercise of these rights being the law of slander and libel, whereby the publication of an untruth that can be presumed or shown to the satisfaction, not of the plaintiff, but of others (*i. e.*, an impartial jury), to be injurious, not alone to the feelings but to the reputation, is actionable. Should it be thought that it is a hard rule that is applied in this case, it is only necessary to call attention to the fact that a ready remedy is to be found in legislation. We are not satisfied, however, that the rule is a hard one, and think that

7—Murray v. Engraving Co., 28 N. Y. Supp. 271. ing Box Co., 171 N. Y. 538, 64 N. E. Rep. 442, reversing s. c. 71 N.

8—Roberson v. Rochester Fold- Y. Supp. 876.

the consensus of opinion must be that the complainants contend for a much harder one.”⁹

The only case in which the question of the existence of the right of privacy has been brought before the federal courts is one which the widow and children of George H. Corliss, an inventor, brought to enjoin the publication of a biographical sketch and portrait of Mr. Corliss. The plaintiffs put their case squarely upon the proposition that the proposed publication would be an invasion of the right of privacy which a court of equity should protect. There was some discussion upon the question whether Mr. Corliss was a public or a private character. The court distinctly denied the existence of any right of privacy which it could recognize, saying that under the law “one can speak and publish what he desires, provided he commits no offense against public morals or private reputation.”¹⁰ The opinion proceeds flatly on the theory that a court of equity has no power to restrain a libelous publication.¹¹ At the same time the publication of the portrait was enjoined because the original had been obtained by the defendant from the plaintiffs on certain conditions which it had not complied with.

Upon the motion to dissolve the injunction certain additional evidence had been adduced, and the court in its opinion finds the fact to be that the defendant had obtained the portrait from a photograph; and that Mr. Corliss was in fact a public character. The court says: “The distinction in the case of a picture or photograph lies, it seems to me, between public and private charac-

9—Atkinson v. John E. Doherty & Co., 121 Mich. 372, 80 N. W. Rep. 285-289.

10—Corliss v. E. W. Walker Co., 57 Fed. Rep. 434.

11—Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; Brandreth v. Lance, 8 Paige, 24; Kidd v. Horry, 28 Fed. Rep. 773.

ter. A private individual should be protected against the publication of any portraiture of himself, but where an individual becomes a public character the case is different. A statesman, author, artist, or inventor, who asks for and desires public recognition, may be said to have surrendered this right to the public."¹²

The right of privacy has been recognized by the Patent Office, and, as to portraits of living individuals, the Act of 1905 prohibits their registration without the consent of the person.¹³

In a recent opinion, the Supreme Court of Georgia, per Cobb, J., has sustained the right of privacy as of common law origin, in the following language:

"The right of privacy has its foundation in the instincts of nature. It is recognized intuitively, consciousness being the witness that can be called to establish its existence. Any person whose intellect is in a normal condition recognizes at once that, as to each individual member of society, there are matters private, and there are matters public, so far as the individual is concerned. Each individual as instinctively resents any encroachment by the public upon his rights which are of a private nature as he does the withdrawal of those of his rights which are of a public nature. A right of privacy in

12—*Corliss v. E. W. Walker Co.*, 64 Fed. Rep. 280-282.

13—Thus in a case presented to the Patent Office where the applicant sought to register the mark "Dewey's Chewies," for confectionery. The commissioner said, in response to the applicant's suggestion that "Dewey's" is not an ordinary surname: "I cannot refrain from expressing the opinion that even if it be registrable, no one has the right without the con-

sent of Dewey to appropriate it as a trademark. A living celebrity is entitled to protection from the ordinary trader." Duell, Commissioner, in *Ex parte McInerney*, 85 Off. Gaz. 149. The Act of 1905 in § 5 contains the provision "that no portrait of a living individual may be registered as a trademark, except by the consent of such individual, evidenced by an instrument in writing."

matters purely private is therefore derived from natural law."

"The *injuria* of the Roman law, sometimes translated 'injury' and at other times 'outrage,' and which," says the court, "is generally understood at this time to convey the idea of legal wrong, — was committed, not only by striking with the fists or with the club or lash, but also by shouting until a crowd gathered around one, and it was an outrage or legal wrong to merely follow an honest woman or young boy or girl; and it was declared in unequivocal terms that these illustrations were not exhaustive, but that an injury or legal wrong was committed 'by numberless other acts.' Sandar, Just. Hammond's ed. 499; Poste, Inst. of Gaius, 3d ed. 449. The punishment of one who had not committed any assault upon another, or impeded in any way his right of locomotion, but who merely attracted public attention to the other as he was passing along a public highway or standing upon his private grounds, evidences the fact that the ancient law recognized that a person had a legal right 'to be let alone,' so long as he was not interfering with the rights of other individuals or of the public."¹⁴

The decision of the Georgia Court was unanimous. Judge Parker's opinion in the case of *Roberson v. Rochester Folding-Box Co.* was concurred in by three, and dissented from by the other three judges. A comparison of the opinions of Judge Parker and Judge Cobb discloses the best arguments for and against the existence of the right of privacy; that of Judge Cobb is well reasoned, and admirably stated; that of Judge Parker is more concisely expressed, and certainly as well grounded in reason. The conservative views of Judge Parker are summed up in the following words: "The

14—*Pavesich v. New England Life Ins. Co.*, 50 S. E. Rep. 68.

legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes without his consent. In such event no embarrassment would result to the general body of the law, for the rule would be applicable only to cases provided for by the statute. The courts, however, being without authority to legislate, are required to decide cases upon principle, and so are necessarily embarrassed by precedents created by an extreme, and therefore unjustifiable, application of an old principle.'"¹⁵

15—Roberson v. Rochester Folding Box Co., 171 N. Y. 540. See S. C., 65 N. Y. Supp. 1109, 71 N. Y. Supp. 876. For the opinions of the courts below,

CHAPTER VIII.

INFRINGEMENT.

§ 94. **Of infringement generally.**—The word “infringement” is difficult of exact definition. For the purposes of the present discussion, its broadest meaning, that of the infraction or invasion of another’s trade rights, by passing off, or attempting to pass off, upon the public one’s own goods as his, may suffice. As to technical trademark infringement, it should be more narrowly defined as the infraction or invasion of any portion of the mark, symbol or device in which one has acquired a right of property, either by way of reproduction in fac-simile, or imitation. An English text-writer has thus defined it: “Infringement is the use by the defendant, for trading purposes, in connection with goods of the kind for which the plaintiff’s right to exclusive use exists, not being the goods of the plaintiff, of a mark identical with the plaintiff’s mark, or either comprising some of its essential features or colourably resembling it, so as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff.”¹ Vice-Chancellor Shadwell stated the rule to be that, if a mark contains twenty-five parts and but one is taken (*i. e.*, imitated or copied), liability has been created thereby, and there has been a technical infringement.²

1—Kerly on Trademarks (2d ed., London, 1901), p. 363. pirated.” *Filley v. Fassett*, 44 Mo. 173; *Cox*, 530; *Seb.* 313. And to

2—*Guinness v. Ullmer*, 10 L. T. 127; *Seb.* 89. “The imitation need not be exact or perfect. It may be limited or partial; nor is it requisite that the whole should be the same effect, *Braham v. Bustard*, 9 L. T. N. S. 199; 1 *Hem. & M.* 447; 11 *W. R.* 1061; 2 *N. R.* 572; *Seb.* 226.

§ 95. No trademark in form, size, material or color.—

It is a well settled rule that there can be no trademark right in the mere form, size or color³ of an article used commercially, or the form, size or color of the package containing it.⁴ It is also an established principle that there can be no trademark right in the directions, notices or usual advertising matter used upon or in description of merchandise.⁵ There has never been a deviation from this rule in the adjudication of the courts of this country. Whenever relief has been granted against an imitator or counterfeiter of either the form, size, color, method of packing, advertising, or directions used by a legitimate dealer, it has been granted upon the broad theory of regulating fraud, and not upon the narrower ground of technical trademark infringement.

There can be no technical trademark in a well known material substance, such as a tin tag impressed upon plug tobacco;⁶ nor in a method of packing merchandise;⁷ or a display card, with horizontal lettering, for hooks

3—Vieter Talking Machine Co. v. Armstrong, 132 Fed. Rep. 711.

4—Moorman v. Hoge, 2 Sawyer, 78; Harrington v. Libby, 14 Blatchf. 128; Ball v. Siegel, 116 Ill. 143; Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. 292; Sawyer v. Horn, 4 Hughes, 239; 1 Fed. Rep. 24; Manhattan Medicine Co. v. Wood, 108 U. S. 218; Re Kane & Co., 9 Off. Gaz. 105; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; Fairbanks v. Jacobus, 14 Blatchf. 337; Fed. Case No. 4608; Wilcox & Gibbs Sewing Machine Co. v. Gibbons, 21 Blatchf. 431; Brill v. Singer Mfg. Co., 41 Ohio St. 127; Re Whitaker, Newton's Dig. 130; Adams v. Heisel, 31 Fed. Rep. 279; Lorillard v. Pride, 28 Fed. Rep. 434; Davis v. Davis, 27 Fed. Rep. 490; Nuthall v. Vining,

28 W. R. 330; Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Witteman, 85 Fed. Rep. 966; Von Mumm v. Witteman (2), 33 C. C. A. 404, 91 Fed. Rep. 126; Fleischmann v. Starkey, 25 Fed. Rep. 127; Brown v. Doscher, 147 N. Y. 647-651; Charles E. Hires Co. v. Consumers' Co., 41 C. C. A. 71, 100 Fed. Rep. 809-811; Flagg Mfg. Co. v. Holway, — Mass. —, 59 N. E. Rep. 667; E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co., 136 Fed. Rep. 866, 869.

5—Candee v. Deere, 54 Ill. 462; Ball v. Siegel, 116 Ill. 143.

6—Lorillard v. Pride, 28 Fed. Rep. 434.

7—Davis v. Davis, 27 Fed. Rep. 490.

and eyes;⁸ but a fraudulent imitation of another's tin tag has been restrained;⁹ and injunctions against the fraudulent use of another's style of package and method of packing¹⁰ are frequent, in the absence of any claim to a technical trademark right in the complainant.

The courts have been averse to recognizing a trademark right in anything calculated to be useful, aside from indicating origin or ownership. So, in holding that there was no trademark right in a series of indentations in plug tobacco, so arranged as to serve as guides in cutting the plug into pieces of one ounce each, Judge Blodgett said: "One of the principles running through the law of trademarks is that there need be no utility attached to the trademark itself—that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture."¹¹

There may be combinations of form and color with other things, which will entitle the owner to relief against one duplicating his article. Thus in a case where the defendant duplicated the plaintiff's talking machine records, injunction issued against the "manufacture and sale of disk records, black or nearly black in color, with a red seal center inscribed with decoration and letters in gilt, when such records contain the shop numbers or catalogue numbers of complainant's disk records, or when the sound recording grooves thereon are copies of the grooves on complainant's disk records."¹²

Finally, it is obvious, that where the resemblance resides in particulars of packages which have become common to the trade, no relief can be granted.¹³ A mark,

8—De Long Hook & Eye Co. v. Francis Hook & Eye Co., 118 Fed. Rep. 938.

9—Lorillard v. Wright, 15 Fed. Rep. 383.

10—Washington Medallion Pen Co. v. Easterbrook, Fed. Case No. 17,246a.

11—Dausman & Drummond Tobacco Co. v. Ruffner, Fed. Case No. 3,585, 15 Off. Gaz. 559.

12—Victor Talking Machine Co. v. Armstrong, 132 Fed. Rep. 711.

13—Schenker v. Awerbach, 85 N. Y. Supp. 129.

consisting of a brown-colored-paper cigar-band of peculiar shape, has been held to be invalid, Judge McPherson saying, "Certainly the color alone could not be appropriated by the complainant as a trademark, nor the shape alone, nor the material alone; and even the combination of these three elements could not make a valid trademark, because neither singly nor in combination do they point to the complainant as the source from which the goods are derived."¹⁴

§ 96. The early adjudications.—The endeavor of the dishonest merchant to prey upon and profit by the reputation of his honest competitor is always hampered by fear of detection. If a trademark is counterfeited the counterfeit product is placed upon the market stealthily; where the offender lacks the courage to counterfeit he resorts to colorable imitations, not of his competitor's trademark, but of his methods of packing and preparing goods for sale, thus simulating a resemblance, in the words of Judge Lacombe, "sufficiently strong to mislead the consumer, although containing variations sufficient to argue about, should the designer be brought into court."¹⁵

The earliest leading case involving this form of fraudulent competition arose between rival soap manufacturers. The plaintiffs made and sold an article styled "Genuine Yankee Soap." The defendant put up a soap under the same style, imitating the size and shape of the cake, the color and material of the wrapper, and a hand-bill, as used by the plaintiffs. There was a disinclination on the part of the court to decide whether the words "Genuine Yankee" were a valid trademark, and its decision was put solely upon the ground of unfair trade, the court saying: "The defendant is engaged in

14—E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co., 136 Fed. Rep. 866, 869. 15—Collinsplatt v. Finlayson, 88 Fed. Rep. 693.

a gross and palpable endeavor, by imitating the marks and labels used by plaintiffs, to deceive the public and obtain patronage which would in all probability be attracted to the plaintiffs. . . . They have adopted, in reference to their manufacture (of an article which any and every one may manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior hand-bill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold and known as their manufacture. All this the defendant has copied, with an exactness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. . . . Without deciding whether the defendant may or may not use either of the words 'Genuine' or 'Yankee,' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or hand-bills which he is using, nor any other like labels, hand-bills, or devices, in imitation of, or simulating the labels, devices, or hand-bills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or hand-bills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."¹⁶

Mr. Rowland Cox has said,¹⁷ however, that the rule "that where the appearance of a peculiar and original package has acquired through use an understood reference to the goods of a manufacturer, and a competing manufacturer knowingly imitates the peculiar characteristics of the package, with intent to deceive the public,

16—Williams v. Johnson (1857),
2 Bos. 1; Cox, 214.

17—Cox, Manual, p. 86; note to
Williams v. Johnson, *supra*.

such imitations will be held to be an infringement of the rights of the person first using the package," can hardly be said to have found distinct expression prior to 1878, where it occurs in the opinion of Judge Wheeler in *Frese v. Bachof*.¹⁸ And, indeed, that decision, if not the earliest, is still one of the clearest in its enunciation of the rule.

§ 97. **Infringement of color.**—The cases in which an unfair competition is effected by means of infringement of color alone are naturally very few in number. Where the color involved is common to the trade, it will be disregarded in determining the issue of infringement.¹⁹ Indeed the case nearest approximating such an infringement is one in which the complainant and defendant manufactured stoves of similar external appearance, enameling the inside faces of their stoves with white enamel. On demurrer to the bill Judge Baker said: "If the question for decision were simply whether the plaintiff could acquire the sole right to use white enamel for the lining of the doors of its stoves and ranges, it would present a question whose solution would prove embarrassing. But the case made upon the bill and admitted by the demurrer is that the defendants are manufacturing stoves and ranges having white enamel doors in the similitude of those manufactured by complainant, and with the fraudulent purpose of palming them off upon the trade and the public as the stoves and ranges manufactured by the complainant. It is not necessary to determine whether the white enamel lining, which has been long and exclusively used by the complainant for the inner lining of the doors of its stoves and ranges, constitutes a trademark, or whether it does not. It is sufficient to justify the interposition

18—Seb. 603; 13 Off. Gaz. 635; 360, 119 Fed. Rep. 848, 852; Continental Tobacco Co. v. Larus & Fed. Case No. 5, 110.

19—Postum Cereal Co. v. American Health Food Co., 56 C. C. A. 727. Bro. Co., C. C. A., 133 Fed. Rep.

of a court of equity if the stoves and ranges manufactured by the defendants are purposely constructed in the similitude of those manufactured by the complainant, with the intention and result of deceiving the trade and the public, and inducing them to purchase the stoves and ranges of the defendants in the belief that they are purchasing the stoves and ranges of the complainant's manufacture. The imitative devices used upon the stoves and ranges manufactured by the defendants are alleged to be employed by them for the purpose and with the result of deceiving the public, and thereby diverting the trade of the complainant to the defendants. This they have neither the moral nor the legal right to do.''²⁰

The question of its collocation must always be considered in connection with the question of infringement by the use of color. Announcing the opinion of the federal circuit court of appeals of the second circuit, Judge Lacombe has said: "Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well, which go to make up the entire combination. Because a total change of color would so change the general appearance as to destroy resemblance to another package, it by no means follows that color alone would be sufficient to produce a general appearance, resembling another package. It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements, each differing more or less from its analogue in complainant's package, had been so collated together as to produce a general appearance calculated to delude the unwary purchaser.''²¹

20—*Buck's Stove & Range Co. v. C. C. A.* 554; reversing *s. c.*, 71 *Kiechle*, 76 Fed. Rep. 758. Fed. Rep. 295. To the same effect

21—*N. K. Fairbank Co. v. R. W. see Allen B. Wrisley Co. v. Geo. E. Bell Mfg. Co.*, 77 Fed. Rep. 869, 23 *Rouse Soap Co.*, 87 Fed. Rep. 589.

So that we find many cases in which the imitation of color has been a material element in determining the question of infringement.²² In a proper case the court will enjoin the defendant from using the color used by the plaintiff, upon the theory that the defendant must be allowed no advantage out of the trade thus obtained wrongfully, but must establish the reputation of his goods upon merit, and without benefit of the imitation.²³

It may be said that in issues of technical trademark infringement the color of the respective marks is frequently of controlling importance. Any system of registration, to be effective, ought to provide for the registration of marks in the exact coloring which it is intended to apply to the mark in use. After the English court of appeals had discussed this question,²⁴ it was

22—Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Carbolie Soap Co. v. Thompson, 25 Fed. Rep. 625; Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-438; Anheuser-Busch Brewing Co. v. Clarke, 26 Fed. Rep. 410; Landreth v. Landreth, 22 Fed. Rep. 41; Lorillard v. Wight, 15 Fed. Rep. 383; Hostetter v. Adams, 10 Fed. Rep. 838; Von Mumm v. Frash, 56 Fed. Rep. 830; Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 Fed. Rep. 289; Gail v. Wackerbarth, 28 Fed. Rep. 286; Hires v. Hires, 6 Pa. Dis. R. 285; Myers v. Theller, 38 Fed. Rep. 607; American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14; Sperry v. Percival Milling Co., 81 Cal. 252; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293; Fleischmann v. Starkey, 25 Fed. Rep. 127; Carbolie Soap Co. v. Thompson, 25 Fed. Rep. 625; C. F. Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; Johnson & John-

son v. Bauer & Black, 27 C. C. A. 374, 82 Fed. Rep. 662; reversing s. c., 79 Fed. Rep. 954; Fischer v. Blank, 138 N. Y. 251; Cox, Manual, 731; McCann v. Anthony, 21 Mo. App. 83; 38 Off. Gaz. 333; Von Mumm v. Kirk, 40 Fed. Rep. 589; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Philadelphia Nov. Co. v. Blakesley Nov. Co., 40 Fed. Rep. 588; Proctor & Gamble Co. v. Globe Refining Co., 34 C. C. A. 405, 92 Fed. Rep. 357; Johnson v. Brunor, 107 Fed. Rep. 466; Lalance & Grosjean Mfg. Co. v. National Enameling & Stamping Co., 109 Fed. Rep. 317; National Biscuit Co. v. Swick, 121 Fed. Rep. 1007; Rains v. White, (Ky.), 52 S. W. Rep. 970; Kassel v. Jeuda, 70 N. Y. Supp. 480.

23—Franck v. Frank Chicory Co., 95 Fed. Rep. 818-821.

24—Re Worthington & Co.'s Trademark, L. R. 14 Ch. D. 8-18. See also Nuthall v. Vining, 28 W. R. 330; Cartmell, 248.

enacted by Parliament that registration might be in color.²⁵

§ 98. **Infringement of size and form.**—The decision of the leading case, *Cook & Bernheimer Co. v. Ross*,²⁶ by Judge Lacombe in the circuit court of the United States for the southern district of New York, marked a distinct advance in the scientific development of the law of unfair competition. The complainant was a corporation which had acquired the sole right to bottle, at the distillery the "Mount Vernon Rye" whisky distilled by the Hannis Distilling Company, in which bottling the complainant used a bottle of distinctive form. The facts more fully appear in the opinion, a portion of which is as follows:

"Complainant, of course, has no exclusive right to the name 'Mount Vernon,' and the labels of defendants are in no sense an imitation of the labels of the complainant. Complainant's case rests solely on the form of package, which it claims has been so imitated as to make out a case of unfair competition.

"Undoubtedly, a large part of the consumption of whisky is in public drinking places, where it is dispensed to the consumer from the opened bottle. It is always desirable, therefore, for a dealer who wishes to push the sale of his own goods on their own merits to devise, if he can, some earmark more permanent than a pasted label to distinguish them. Complainant's predecessors accordingly, in March, 1890, adopted a brown glass bottle of a

25—The Patents, Designs, and Trademarks Act, 1883, sec. 67. It has been held, under this section, that the mark registered in color must be distinctive apart from its color; and as said by Kay, J.: "You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of

which the only distinction is the use of a color, because, practically, under the terms of the act, that would give you a monopoly of all the colors of the rainbow." *Re Hanson's Trademark*, 5 R. P. C. 130; L. R. 37 Ch. D. 112; 57 L. J. Ch. 173; 57 L. T. N. S. 859; 36 W. R. 134; *Cartmell*, 146.

26—73 Fed. Rep. 203.

peculiar square shape, unlike any that had theretofore been used for bottling whisky, or, indeed, so far as the evidence shows, for any other purpose. It is a form of package well calculated by its novelty to catch the eye, and be retained in the remembrance of any one who has once seen it. In order to develop and extend the business they expected to control under their agreement with the Hannis Distilling Company, complainant and its predecessors have expended more than \$50,000 in advertising its said bottling. In all these advertisements the peculiar square-shaped bottle is the chief and most prominent feature. It is not surprising, therefore, to find it stated in the moving affidavits that the shape and general appearance of the bottle has come to be principally, if not exclusively, relied on by ordinary purchasers as the means of identifying this bottling of Mount Vernon whisky from all other bottlings, the purity of which is not guaranteed by the distillers, but only by the bottler. Complainant's bottling seems to have acquired a high reputation, large and increasing quantities of it being yearly sold, at a price in excess of that obtained by other bottlers of Mount Vernon whisky.

“About December, 1895, defendants, who had been dealing in Mount Vernon whisky for many years, began first to put it up in bottles, which are Chinese copies of the peculiar square-shaped, bulging-necked bottles of the complainant. Of course they aver that this was without any intention ‘to deceive the public, or to palm off defendants’ goods for complainant’s.’ They account for the sudden appearance of their output of Mount Vernon whisky in this form as follows: ‘There was a demand for Mount Vernon whisky along in November last, and defendants sought a convenient and useful package in which to place their product upon the market, and purchased a stock of bottles of the square form for that purpose, without making a special design therefor, and in the open market;’ and allege that ‘such bottles can

be purchased of reputable bottle manufacturers from molds used for some time last past.' This last averment may well be true. The industry of defendants' counsel has marshaled here an array of square-shaped bottles filled with whisky, which shows that for some time imitations of complainant's bottle have been on the market. But there is not a word of proof to trace back any one of these bottles to a period anterior to the adoption of the square shape by complainant's predecessor as a distinctive form of package. Despite defendants' denials,—and they only deny intent to deceive the public, not intent to use a form of package just like complainant's,—the court cannot escape the conviction that they found the square-shaped bottle 'convenient and useful,' because it was calculated to increase the sale of their goods; and that such increase, if increase there be, is due to the circumstance that the purchasers from defendants have a reasonable expectation that the ultimate consumer, deceived by the shape, will mistake the bottle for one of complainants'. This is unfair competition within the authorities, and should be restrained. Injunction *pendente lite* is granted against the further use of the square-shaped, bulging-necked bottle as a package for Mount Vernon whisky."

There never existed a valid reason why a manufacturer should not be protected in the use of a package so peculiar and distinctive in size and shape as not to interfere with the packing methods of the trade generally. In this respect the law of trademarks fell short in the recognition it should have extended to tradesmen, who, like the Cook & Bernheimer Company in the case last mentioned, chose to distinguish their wares by distinctive packing. On account of this deficiency in the law, occasional hardships were inflicted upon honest tradesmen and the dishonest competitor went unwhipped of justice.¹ But the amount of fraudulent trading effected

1—*Enoch Morgan's Sons Co. v. Troxell*, 89 N. Y. Supp. 292.

by means of this form of imitation was sure to evoke the ruling of the leading case in time, and there are numbers of other cases in which an imitation of size and form has been a moving ground of injunction.² The remedy has in some cases been held to be dependent upon proof that the public has actually been deceived by the defendant's package.³ It has been expressly held, indeed, that "there is no unfair competition, apart from the infringement of a patent or trademark, unless the competing person so makes or marks his goods or conducts his business that purchasers of ordinary caution and prudence, and not those who are exceptionally dull, are likely to be misled into the belief that his goods are the goods of somebody else."⁴ But it is the probability of deception, and not proof that customers have actually been deceived, that controls or should control in all cases of unfair competition as well as in cases of technical trademark infringement. A learned English judge has asked: "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do?"⁵ Where the form and size of a package have be-

2—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809; Apollinaris Co. v. Brumler, Cox, Manual, 429; Hostetter v. Adams, 10 Fed. Rep. 838; Sawyer v. Kellogg, 7 Fed. Rep. 720; Sperry & Co. v. Percival Milling Co., 81 Cal. 252; Noera v. Williams Mfg. Co., 158 Mass. 110; Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205; Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Hildreth v. McDonald, 164 Mass. 16; 49 Am. St. Rep. 440; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293.

3—Hildreth v. D. S. McDonald Co., 164 Mass. 16; 41 N. E. Rep. 56, 49 Am. St. Rep. 440.

4—Allen, J., in Dover Stamping Co. v. Fellows, 163 Mass. 191; 40 N. E. Rep. 105, 28 L. R. A. 448; 47 Am. St. Rep. 448; citing Gilman v. Hunnewell, 122 Mass. 139; Singer Mfg. Co. v. Wilson, 2 Ch. D. 434-447; Brill v. Singer Mfg. Co., 41 Ohio St. 127; 52 Am. Rep. 74; Robertson v. Berry, 50 Md. 591; 33 Am. Rep. 328. To the same effect, Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Witteman, 85 Fed. Rep. 966; affirmed, 91 Fed. Rep. 126, 33 C. C. A. 404.

5—Lindley, L. J., in Slazenger v. Feltham, 6 R. P. C. 538.

come common to a trade, resemblance in either or both of these particulars is not actionable.⁶

In all of this class of cases the general rule of trademark law applies, that it is immaterial whether the goods sold by the defendant are inferior or superior to those of the plaintiff. Thus in an early case Judge Morris said: "What we decide is that whether the complainant has a trademark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labeled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color and label, no person has the right to use the complainant's form of package, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality."⁷

In connection with this branch of our subject, it should be noted that, in the absence of a patent, every one is at liberty to reproduce merchandise or machinery made by another. In the language of the Massachusetts court, "in the absence of a patent, the freedom of manufacture cannot be cut down under the name of preventing unfair competition."⁸ In an earlier case, it was said that "apart from these (*i. e.*, patents for inventions or designs) any one may make anything in any form, and may copy with exactness that which another has produced, without inflicting any legal injury, unless he attributes to that which he has made a false origin, by claiming it to be the manufacture of another person."⁹ In a later case, Judge Severens has thus stated the

6—Allen B. Wrisley Co. v. Geo. Co. v. Holway, Mass., 59 N. E. Rep. E. Rouse Soap Co., 87 Fed. Rep. 589. 667. To the same effect see Piaget v. Headley, 68 N. Y. Supp. 351.

7—Sawyer v. Horn, 1 Fed. Rep. 24-38. 9—Johnson, J., in Fairbanks v. Jacobus, 14 Blatch., 337, 339; Fed.

8—Holmes, C. J., in Flag Mfg. Case No. 4608, and to the same ef-

rule: "Without doubt, a party may adopt distinguishing marks to denote the origin or production as being his own, or he may adopt some other peculiar method of distinguishing his own goods, and thus retain the benefit of the good reputation which he has acquired for them. But the very idea of distinguishing them implies that it cannot be done by such universal characteristics as belong to other goods of the kind and which the general public have the undoubted right to use."¹⁰ But in making an article whose structure may be made by anyone, it is nevertheless unlawful to imitate its ensemble as made by another, with the purpose and effect of misleading the public.¹¹

§ 99. Intent and scienter.—It was at first held that equity could only administer relief ancillary to that offered by the courts of law. It is, indeed, difficult to apprehend on what ground this reluctance to interfere in trademark cases arose. The only explanation vouchsafed is, that when chancery undertook to act it was "exercising a jurisdiction over legal rights."¹² But whether at law or in equity, the doctrine of the common law prevailed, that the defendant must be shown to have guilty knowledge or fraudulent intent.¹³

In 1838 the rule was distinctly announced that courts of equity "will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant."¹⁴ This rule is now uni-

fect, see *Dover Stamping Co. v. Fellows*, 163 Mass. 191; 40 N. E. & Cr. 1-14.

12—*Motley v. Downman*, 3 Mylne & Cr. 1-14.
13—*Singleton v. Bolton*, 3 Doug. 293; *Morrison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4 Man. & G. 357; *Taylor v. Ashton*, 11 M. & W. 402; *Rodgers v. Nowill*, 5 C. B. 109; *Myers v. Baker*, 3 H. & N. 802; *Sykes v. Sykes*, 3 B. & C. 541; 5 D. & R. 292.

10—*Globe-Wernicke Co. v. Fred Macey Co.*, 56 C. C. A. 304, 119 Fed. Rep. 696, 704.

11—*Globe-Wernicke Co. v. Brown & Besly*, 57 C. C. A. 344, 121 Fed. Rep. 90.

14—*Millington v. Fox*, 3 Mylne & Cr. 338.

versally recognized in technical trademark cases.¹⁵ It is unnecessary to show that the defendant knew that his trademark resembled any other trademark,¹⁶ and it follows that it need not be shown that he knew whose mark his resembled;¹⁷ and, the intent of the defendant being immaterial, the fact that he intended to infringe plaintiff's rights will not entitle the plaintiff to relief if the defendant's acts do not amount to trademark infringement or unfair competition.¹⁸

There is a line of demarkation, to be noted in this regard, between the class of unfair trade cases which involves a technical trademark and that which does not. Where a plaintiff establishes by competent proof his title to the specific trademark, infringement is shown by comparison with the defendant's mark. The resemblance of the defendant's mark creates a presumption of fraud.¹⁹

15—Glenny v. Smith, 2 Drew. & Sm. 476; 11 Jur. N. S. 964; 13 L. T. N. S. 11; 13 W. R. 1032; 6 N. R. 363; Seb. 247; Filley v. Fassett, 44 Mo. 173; Cox, 530; Seb. 313; Amoskeag Mfg. Co. v. Garner (1), 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541; Seb. 314; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; Singer Mfg. Co. v. Wilson, 3 App. Cas. 376-391; Colman v. Crump, 70 N. Y. 573; 16 Alb. L. J. 352; Seb. 579; Shaw v. Pilling, 175 Pa. St. 78-87; Wotherspoon v. Currie, L. R. 5 H. L. 508-517; McLean v. Fleming, 96 U. S. 245-253; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; C. F. Simmons Med. Co. v. Mansfield Drug Co., 93 Tenn. 84; Elgin Nat. Watch Co. v. Illinois Watch Case Co. (2), 179 U. S. 665-674; Cravenette Co. v. Benjamin, 105 Fed. Rep. 621; American Grocer Pub. Co. v. Grocer Pub. Co., 25 Hun, 398.

16—Kinahan v. Kinahan, 15 Ir. Ch. 75; Orr-Ewing & Co. v. Grant, 2 Hyde, 185; Singer Mfg. Co. v. Loog, 18 Ch. D. 412; Harrison v. Taylor, 11 Jur. N. S. 408; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Burgess v. Hills, 26 Beavan, 244; Regis v. J. A. Jaynes & Co., 185 Mass. 458, 70 N. E. Rep. 480.

17—Cartier v. Carlile, 31 Beavan, 292.

18—Kann v. Diamond Steel Co., 89 Fed. Rep. 706-712. "An intention to injure, if no injury be done, constitutes no ground for relief." Jenkins, J., in *G. W. Cole Co. v. American Cement & Oil Co.*, 65 C. C. A. 105, 130 Fed. Rep. 703, 711, citing § 76 of the first edition of this book, and *Centaur Co. v. Marshall*, 38 C. C. A. 413, 97 Fed. Rep. 785; *Postum Cereal Co. v. American Health Food Co.*, 56 C. C. A. 360, 119 Fed. Rep. 848, 852.

19—"A trademark, clearly such, is in itself evidence, when used by

But where the plaintiff has no trademark there is no basis of comparison such as existed in the former case, because there is no technical property right in the plaintiff. Mere resemblance between the goods of the parties may or may not be sufficient to establish the right to injunction. It must be established that the defendant is unfairly competing with the plaintiff; his fraud must be proven directly or by inference. In a recent opinion Judge Baker says: "While the idea of fraud or imposition lies at the foundation of the law of technical trademarks as well as the law of unfair competition, it must be borne in mind that fraud may rest in actual intent shown by the evidence, or may be inferred from the circumstances, or may be conclusively presumed from the act itself. In the case of unfair competition the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while in the case of the use by one trader of the trademark or trade-symbol of a rival trader, fraud will be presumed from its wrongful use."²⁰

And the United States supreme court states the rule to be that "the deceitful representation must be made out or be clearly inferable from the circumstances."²¹

§ 100. **What persons liable.**—With the establishment of the rule that *mala mens* need not be shown,²² it followed that liability for infringement was extended to

a third party, of an illegal act. It is of itself evidence that the party intended to defraud and to palm off his goods as another's." Mr. Justice Bradley in *Putnam Nail Co. v. Bennett*, 43 Fed. Rep. 800. And to the same effect, *Boston Diatite Co. v. Florence Mfg. Co.*, 114 Mass. 69; *McLean v. Fleming*, 96 U. S. 245; *Menendez v. Holt*, 128 U. S. 514; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537.

20—*Church & Dwight Co. v. Russ*, 99 Fed. Rep. 276-279.

21—*Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537-551, followed in *Gorham Mfg. Co. v. Emery-Bird-Thayer Co.*, 43 C. C. A. 511, 104 Fed. Rep. 243, 244.

22—*Wotherspoon v. Currie*, L. R. 5 H. L. 508-517; *Saxlehner v. Siegel-Cooper Co.*, 179 U. S. 42.

many persons who, in the absence of that doctrine, could not be reached by the owner of the pirated mark. "All persons in any way connected with the infringement of a trademark are responsible to the owner for the injury done to his rights."²³

§ 101. **Of labels, generally.**—The dress of a commercial article usually embodies a label. The consequence is that the cases refer to labels, frequently, as though they were a distinct factor in the law of unfair competition, to be treated as an entity, regardless of the presence or absence of trademark material upon them. Thus Vice-Chancellor Van Fleet, in the Court of Chancery of New Jersey, has said, "If we speak with accuracy, these labels cannot be called 'trademarks,' but they serve substantially the same purpose. They are the marks by which the complainant's goods are distinguished in the markets from all like goods put upon the market by other persons, and are, for that reason, according to many decisions, just as much under the protection of the law as trademarks are. The law protects them for the same reasons, and in exactly the same way, that it does trademarks. The leading principle of the law on this subject is that no man should be permitted to sell his goods on the reputation which another dealer has established in the market for his goods, and this principle applies with equal force to the case where the goods of such other dealer are known in the market by a label, as it does to the case where they are known by a mark which is strictly a trademark. No dealer can lawfully adopt the label of another dealer, or one so near like it as to lead the public to suppose that the article to which it is affixed was put upon the market by such other dealer."²⁴

23—Hawley, J., in *Hennessy v. following Miller Tobacco Manufactory Co. v. Commerce*, 45 N. J. Herrmann, 89 Fed. Rep. 669-670.

24—Wirtz v. Eagle Bottling Co., Law 18, 24.
50 N. J. Eq. 164, 24 Atl. Rep. 658;

§ 102. The engraver or manufacturer of the label.—

The rule that equity will enjoin one who participates in the production of an infringing mark or label was first established in *Guinness v. Ullmer*, in 1847, in which case the plaintiffs were brewers of porter, and the defendants, who were engravers, engraved plates to be used in printing labels in imitation of the plaintiff's label.²⁵ This decision was followed in 1855 by a case in which a printer printed and sold labels which were fac-similes of the plaintiff's labels, and the piracy was enjoined;²⁶ and the rule is now extended to include one who deals in counterfeit labels, though he does not manufacture them.²⁷

In 1877 a label printer was enjoined by the superior court of New York from the manufacture of labels which were colorable imitations of plaintiff's. In affirming the decision of the lower court the New York court of appeals announced that it is not necessary in such a case "to establish a guilty knowledge or fraudulent intent on the part of the wrong-doer."²⁸ It is now the settled rule

25—*Guinness v. Ullmer*, 10 L. T. 127; Seb. 89.

26—*Farina v. Silverlock*, 1 K. & J. 509; 3 Eq. Rep. 883; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532; 6 DeG. M. & G. 214; 26 L. J. Ch. 11; 2 Jur. N. S. 1008; 27 L. T. 277; 4 W. R. 731; 52 Leg. Obs. 342; 30 L. T. 242; 31 L. T. 39; 4 K. & J. 650; Seb. 130. See also to the same effect, *Colman v. Crump*, 70 N. Y. 573; *Cuervo v. Jacob Henkell Co.*, 60 Off. Gaz. 440; 50 Fed. Rep. 471; *Moxie Nerve Food Co. v. Beach*, 33 Fed. Rep. 248; *De Kuyper v. Witteman*, 23 Fed. Rep. 871; *Hildreth v. Sparks Mfg. Co.*, 99 Fed. Rep. 484.

27—*Hennessy v. Herrmann*, 89 Fed. Rep. 669; *Cantrell & Cochrane, Ltd., v. Wittemann*, 109 Fed. Rep. 82.

28—*Colman v. Crump*, 70 N. Y. 573-578; affirming s. c., 40 N. Y. Super. Ct. (8 J. & S.) 548; Seb. 579. The court of appeals in this case further says (per Allen, J.): "It is an infraction of that right (*i. e.*, the right to a trademark) to print or manufacture, or put on the market for sale and sell for use, upon articles of merchandise of the same class as those upon which it is used by the proprietor, any device or symbol which by its resemblance to the established trademark will be liable to deceive the public and lead to the purchase and use of that which is not the manufacture of the proprietor, believing it to be his." From which Mr. Cox makes this deduction: "The distinction would seem to be that where the facts of the case

that "the mere act of printing and selling labels in imitation of the complainant's might be innocent, and, without evidence of an illicit purpose, would not be a violation of the complainant's rights."²⁹ Judge Thayer, however, held that the court would presume fraudulent intent where counterfeit labels were manufactured and sold and advertised for sale by the defendant.³⁰

Where a person induces a manufacturer to make for him goods marked with the trademark of a third person, the manufacturer can hold him liable for all money paid and expense incurred by the manufacturer in compromising a suit brought against him by the owner of the trademark.³¹

Where both parties are in a similar business, one will be enjoined from buying up the empty bottles or other packages used by the other.³²

§ 103. Of counterfeiting trademarks.—A counterfeit mark is one which is a fac-simile (*e. g.*, an exact copy or reproduction) of a genuine trademark. Counterfeiting may be accomplished either by using forged fac-simile trademarks, or by using genuine trademarks upon goods substituted for those of the owners of the trademarks; as by refilling bottles, boxes or other packages bearing trademarks after their original contents have been consumed.

show that the printer of the labels contemplated their use upon goods not made by the owner of the mark, the court will interfere whatever the intent; but where the purpose was that they should be honestly used in such manner as to be tantamount to an application of the mark by its owner, the courts will decline to interfere." Note to *Farina v. Silverlock*, Cox, Manual, 130.

29—Wallace, J., in *De Kuyper v.*

Witteman, 23 Fed. Rep. 871; Cox, Manual, 694.

30—*Carson v. Ury*, 39 Fed. Rep. 777; Cox, Manual, 709. See also *Von Mumm v. Wittemann*, 85 Fed. Rep. 966.

31—*Dixon v. Fawcus*, 9 W. R. 414; 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; Seb. 194.

32—*Evans v. Von Laer*, 32 Fed. Rep. 153; *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. Rep. 388.

§ 104. **Of imitation of trademarks.**—An imitation is a mark so contrived as to resemble an established trademark. The imitation is actionable only in cases where, upon comparison, the court determines that the difference is “merely colorable,”³³ or as stated by Vice-Chancellor Wood: “In every case the court must ascertain whether the differences are made *bona fide* in order to distinguish the one article from them, whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colorable.”³⁴

§ 105. **Colorable imitation.**—As to what constitutes colorable imitation, some apparent diversity of opinion arises in the cases. In the opinion of Vice-Chancellor Wood from which we have quoted in the foregoing section, he says: “Resemblance is a circumstance which is of primary importance for the court to consider, because if the court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading.”³⁵ But this dictum is not convincing, because if the resemblance is not, in fact, calculated to mislead, the fact that it was adopted for the purpose of misleading is wholly immaterial.

Thus it has been held repeatedly that where there is no imitation of the essential part of the trademark, a resemblance in particulars common to the trade is not an infringement.³⁶

33—Davis v. Kendall, 2 R. I. 566; Cox, 112; Seb. 103.

34—Taylor v. Taylor, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124.

35—Taylor v. Taylor, *supra*.

36—Portuondo v. Monne, 28 Fed. Rep. 16; Price & Steuart, 1115; Ball v. Siegel, 116 Ill. 137; 56 Am. Rep. 766; Re Horsburgh, 53 L. J.

Ch. 237; Tucker Mfg. Co. v. Boyington, 9 Off. Gaz. 455, Fed. Case No. 14229; Thornton v. Crowley, 47 N. Y. Super. Ct. 527; Price & Steuart, 455; Coats v. Merrick, 36 Fed. Rep. 324, 45 Off. Gaz. 347; Marshall v. Hawkins, 4 N. Z. L. R. Sup. Ct. 59; Stachelberg v. Ponce (2), 128 U. S. 686.

§ 106. **The test of probability of deception.**—The variance of opinion as to what constitutes colorable imitation arises from the standard adopted by the different courts as to the tendency of the alleged infringement to deceive the cautious, ordinary or unwary customer. It is never necessary to establish actual deception. Lord Westbury said that it was not “necessary for relief in equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant’s mark under the belief that they were the manufacture of the plaintiffs, provided the court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other.”³⁷ Accordingly it is no defense to show that all the persons purchasing goods bearing the simulated mark were aware that the goods were not of the plaintiff’s manufacture,³⁸ or that the maker of the spurious goods, or the jobber who sells them to retailers, informs those who purchase that the article is spurious or an imitation;³⁹ the reason being that there is no assurance that the retailer will give the same cautionary information to his customers.⁴⁰

37—*Edelsten v. Edelsten*, 1 DeG. J. & S. 200; 9 Jur. N. S. 479; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300; and to the same effect see *Monro v. Smith*, 13 N. Y. Sup. 708; *Cox*, Manual, 724; *Dixon v. Fawcus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; 9 W. R. 414; *Re Christiansen’s Trademark*, 3 R. P. C. 54; *Cartmell*, 95; *Compania General de Tobacos v. Rehder*, 5 R. P. C. 61; *Cartmell*, 103; *Orr-Ewing v. Johnston*, 7 A. C. 219; 51 L. J. Ch. 797; 46 L. T. 216; 30 W. R. 417; *Cartmell*, 249; *Seb*, 646; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, 9 R. P. C. 503; (1892) 2 Q. B. 639; 67 L. T. 301; *Braham v. Bustard*, 9 L. T. N. S. 199; 1 Hem.

& M. 427; 11 W. R. 1061; 2 N. R. 572; *Seb*, 226; *Filley v. Fassett*, 44 Mo. 168; *Seb*, 313; *Abbott v. Bakers & Confectioners Tea Ass’n*, W. N. 1871, p. 207; W. N. 1872, p. 31; *Seb*, 379; *Osgood v. Allen*, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; *Seb*, 410; *Job Printers’ Union of Chicago v. Kinsley*, 107 Ill. App. 654.

38—*Edelsten v. Edelsten*, 9 Jur. N. S. 479; 1 DeG. J. & S. 185; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300.

39—*Coats v. Holbrook*, 2 Sandf. Ch. 586; *Seb*, 79.

40—*Chappell v. Davidson*, 2 K. & J. 123; 8 DeG. M. & G. 1; *Seb*, 136.

So where the defendant claimed that the goods bearing the false mark were for his own family's use, he was enjoined;⁴¹ and where the defendants contended that they did not deal in the goods bearing the fraudulent mark, but only acted as forwarding agents, they were enjoined.⁴²

It is always the presumption, however, that the consuming purchaser has no opportunity of comparing the conflicting marks; and this presumption is an important element in passing upon the probability of the defendant's mark effecting deception.⁴³

There is the further presumption which has been recognized judicially, that the consuming purchaser is "apt to act quickly, and is therefore not expected to exercise a high degree of caution."⁴⁴

§ 107. The degree of resemblance which constitutes infringement.—It follows from the principles which we have reviewed that the question of infringement may be treated from the standpoint of the degree of approximation between the conflicting marks. The rule for applying this test has been thus expressed: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trademark so resembling that of another trader as that ordinary purchasers buying with ordinary caution, are likely to be misled. Where the similarity is sufficient to create a false impression in the public mind, and is of a character to mislead and

41—Upmann v. Forester, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28; Cartmell, 331.

42—Upmann v. Elkan, L. R. 12 Eq. 140; 40 L. J. Ch. 475; 24 L. T. N. S. 869; 19 W. R. 867; L. R. 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131; Seb. 369.

43—Pillsbury v. Pillsbury-Washburn Co., 64 Fed. Rep. 841; 12 C. C. A. 432; Manufacturing Co. v. Trainer, 101 U. S. 51-64; Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883.

44—Paris Medicine Co. v. W. H. Hill Co., 102 Fed. Rep., 148-151; 42 C. C. A. 227.

deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right to redress."⁴⁵

When the rule is stated in this way, it comes back to the original question, the degree of care expected of the consuming purchaser.

The application of this rule has sometimes gone far afield from the ancient rule that if a mark contained twenty-five parts, and but one was taken by the defendant, it constituted infringement. Thus in a Missouri case the plaintiff's mark for cigars was the name "Union Station" and the picture of a building known by that name. The defendant's label had a smaller picture of the same building, and the words "The Gilpin-Union Station." Each party displayed his own name or initials on the package. The facts recited in the opinion make out a typical case of technical trademark infringement, yet the court denied the relief sought solely on the ground of the differences in the labels, though the conceded facts show the defendant to have appropriated all of the technical trademark matter of the plaintiff's label.⁴⁶

§ 108. The degree of care expected of the purchaser.—Mr. Justice Clifford expressed the rule in these words: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trademark so resembling that of another trader as that ordinary purchasers buying with ordinary caution are likely to be misled."⁴⁷ But further, in the same opinion, he

45—McAdam, J., in *Jerome v. ney Cigar Co.*, 158 Mo. 158, 59 S. Johnson, 59 N. Y. Supp. 859, quoting the first two sentences from 47—McLean v. Fleming, 96 U. S. 245-251; following the language of Lord Cranworth in *Seixo v. Pro-*

Mr. Justice Clifford in *McLean v. Fleming*, 96 U. S. 245. *vezende*, L. R. 1 Ch. D. 192. See

46—*Nicholson v. Wm. A. Stick-*

bases the decision explicitly upon the ground that the defendant's package "is well calculated to mislead and deceive the *unwary*."⁴⁸

There are many instances of similar dicta. We have heretofore referred to the assertion of Vice-Chancellor Shadwell, who said that "If a thing contains twenty-five parts, and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud."⁴⁹ It is at this point that we can secure probably the most striking proof of the manner in which the law of trademarks and the law of unfair competition overlap each other. True, the function of the trademark is to distinguish the goods to which it is applied, and whose origin or ownership it indicates. True that the purpose of an intentional infringement is to draw away the trade secured by the infringed mark for the benefit of the owner of the infringing mark. That infringement is to be determined, not by the question whether any substantial part of the trademark is copied or duplicated by the infringing mark, but by the tendency of the pirated mark to deceive (whether the careful, ordinary or unwary purchaser is immaterial), is an anomaly in our jurisprudence. But the courts have persisted in disregarding the technical composition and detail of trademarks, and have invariably applied the test of tendency of the suspected mark to deceive. The test ignores the absolute right of property which exists in a lawful trademark, and gives the owner of such a mark no other or further rights than are given the plaintiff who uses

also Popham v. Wilcox, 14 Abb. Pr. N. S. 206; 38 N. Y. Super. Ct. 274; 66 N. Y. 69; 23 Amer. Rep. 22; Seb. 425; Dawes v. Davies, Seb. 426.

48—McLean v. Fleming, 96 U. S. 245, at page 256.

49—Guinness v. Ullmer, 10 L. T. 127. See also Leather Cloth Case, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873; Popham v. Wilcox, 66 N. Y. 69.

only generic terms to designate his wares and perforce relies upon the doctrines of unfair competition.⁵⁰

The broad rule as stated above by Mr. Justice Clifford has been elaborated by other courts. In some cases no reference is made to the care and caution expected to be exercised by the purchasing public,⁵¹ while in others it is held that it must be shown that the mark employed bears such resemblance to the complainant's trademark "as to be calculated to mislead the public generally who are purchasers of the article;"⁵² sometimes it has been expressed as the deception of "the ordinary mass of purchasers;"⁵³ or, as by the Massachusetts court, that injunction will not lie "unless the form of the printed words, the words themselves, and the figures, lines and devices, are so similar that any person, with such reasonable care and observation as the public generally are capable of using and may be expected to exercise, would mistake the one for the other."⁵⁴ The irreverent layman could not fail to note the remarkable elasticity of the rule as thus

50—Lord Westbury evidently was impressed with this thought when he said, "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is a test of the invasion by the defendant of the plaintiff's right of property; for there is no injury if the mark used by the defendant is not such as is mistaken, or is likely to be mistaken, by the public for the mark of the plaintiff; but the true ground of this court's jurisdiction is property." *Hall v. Barrows*, 4 DeG. J. & S. 150.

51—*Ransome v. Bentall*, 3 L. J. Ch. N. S. 161; Seb. 53; *Taylor v. Carpenter* (3), 2 Sandf. 603; 11 Paige, 292; Cox, 45; Seb. 84; *Coffeen v. Brunton*, 5 McLean, 256; Cox, 132; Seb. 109; *Shrimpton v.*

Laight, 18 Beav. 164; *Hardy v. Cutter*, 3 Off. Gaz. 468; *Heinz v. Lutz*, 146 Pa. 592, 23 Atl. Rep. 314.

52—*Walton v. Crowley*, Fed. Case No. 17133, 3 Blatchf. 440-447; *Compania de Tabacos v. Rehder*, 5 R. P. C. 61; *Cartmell*, 103.

53—*Blackwell v. Wright*, 73 N. C. 310-313; *Crawshay v. Thompson*, 4 Man. & G. 357; 5 Scott N. R. 562; 11 L. J. C. P. 301; Seb. 72.

54—*Gilman v. Hunnewell*, 122 Mass. 139-148. It is only fair to note that this case was improperly brought as a trademark case, and is treated as such by the court, whereas the facts show that injunctive relief could only have been granted, if at all, to restrain the unfair competition of the defendant. It has been held else-

laid down.⁵⁵ And we find a court of repute holding that "it is the unwary, and not the wary, who are to be protected, as most likely to be taken in by the counterfeit;"⁵⁶ and another saying that equity "should presume that the public makes use of the senses of sight and hearing, and that it is possessed of a sufficient amount of intelligence to note the difference these senses convey;"⁵⁷ and Sir George Jessel saying: "I am not, as I consider, to decide cases in favor of fools and idiots, but in favor of ordinary English people, who understand English when they see it."⁵⁸

The English courts have devoted much time to speculating whether "most Englishmen" would mistake the defendant's mark for the plaintiff's, or whether if the mark failed to deceive "most Englishmen" it still might mislead "the ordinary native purchaser in Bombay where the goods go," as has actually been done in the opinion of one court.⁵⁹ Under the doctrine so stated, I will not be protected by injunction in a case where the defendant has not copied my trademark sufficiently in detail to deceive "most Englishmen," but if my goods are sold to natives of Africa I may have an injunction against him if he engages in that trade.

where, however, that the relief will not be granted where the defendants' acts are such as could deceive only a careless purchaser. *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.*, 88 Fed. Rep. 694. But this decision was reversed on appeal; s. c., 42 C. C. A. 376, 102 Fed. Rep. 327-332.

55—Substantially the same *dictum* is to be found in *Ball v. Siegel*, 116 Ill. 137-146; citing *Popham v. Cole*, 66 N. Y. 69.

56—*Swift v. Dey*, 4 Robertson, 611; *Cox*, 319; *Seb.* 245. And Judge Benedict has said: "It is no answer to say that the ultimate purchaser was ignorant or un-

wary." *Von Mumm v. Frash*, 56 Fed. Rep. 830-839. The following cases have held that the right to relief depends only upon a degree of resemblance calculated to deceive the careless and unwary. *Colman v. Crump*, 70 N. Y. 573, 578; *McCann v. Anthony*, 21 Mo. App. 83; *Wirtz v. Eagle Bottling Co.*, 50 N. J. Eq. 164, 24 Atl. Rep. 658.

57—*Munro v. Tousey*, 129 N. Y. 38.

58—*Singer Mfg. Co. v. Wilson*, L. R. 2 Ch. D. 434; quoted with approval, *Munro v. Smith*, 13 N. Y. Sup. 708.

59—*Wilkinson v. Griffith*, 8 R. P. C. 370-374.

If we were to undertake to deduce a general rule from the cases it would be that the test is the likelihood of deception of the consuming purchaser;⁶⁰ and in applying this test all doubts are to be resolved in favor of the complainant.⁶¹

§ 109. Infringement must be by use on same class of goods.—The English Patents, Designs, and Trade-mark Acts, 1883 to 1888, provide that the application for registration must state the particular goods or classes of goods in connection with which the applicant desires the trademark to be registered.⁶² A similar provision exists in the act of congress of 1905.⁶³ Aside from these provisions as to registration, it is self-evident that there can be no infringement unless the two marks are used on the same class of goods;⁶⁴ though in this country, owing to the absence of the exact classifications used in the English registration practice, it is probably more exact to say that the marks must be used upon goods of so similar description that goods bearing the defendant's mark may be taken for the manufacture of the plaintiff; as where the plaintiff adopted the words "Lone Jack" to designate smoking tobacco manufactured by him, and

60—*Allegretti Chocolate Cream Co. v. Keller*, 85 Fed. Rep. 643; *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693; *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 23 C. C. A. 554, 77 Fed. Rep. 869-877; *Hansen v. Siegel-Cooper Co.*, (1), 106 Fed. Rep. 690-691; *Kostering v. Seattle Brewing & Malting Co.*, 116 Fed. Rep. 620, 54 C. C. A. 76.

61—*Anheuser-Busch Brewing Ass'n v. Piza*, 24 Fed. Rep. 149-151. That injunction will be granted if the resemblance is "calculated to deceive the unwary, the incautious, or the ignorant purchaser," see *Cauffman v. Schuler*, 123 Fed. Rep. 205.

62—Patents, Designs, and Trade-marks Act, 1883, Part IV, sec. 62, subsec. 3.

63—Act of 1905, § 1.

64—*Re Rabone*, Seb. 642; *Re Jelly, Son & Jones*, 51 L. J. Ch. 639; *Re Whiteley*, 43 L. T. N. S. 627; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Hall v. Barrows*, 4 DeG. J. & S. 150; *Hart v. Colley*, 7 R. P. C. 93; L. R. 44 Ch. D. 193; 59 L. J. Ch. 355; *Cartmell*, 154; *Jay v. Ladler*, 6 R. P. C. 136; L. R. 40 Ch. D. 649; 60 L. T. 27; 37 W. R. 505; *Cartmell*, 184; *Colman v. Crump*, 70 N. Y. 573; *Hecht v. Porter*, 9 Pac. C. L. J. 569; *Société Anonyme v. Baxter*, 14 Blatchf.

the defendant applied the same words to cigarettes. The court gave as its reason for enjoining the defendant that he was holding out his cigarettes as containing the plaintiff's tobacco.⁶⁵ And where the defendants were selling shirts under the name of "Wamyesta" and advertising them as made of "Wamyesta," they were enjoined from using that designation at the instance of the Wamsutta Mills, whose product was known as "Wamsutta" muslin, and was not used by defendants in the manufacture of their shirts.⁶⁶ Where the complainants used the words "Collins & Co." upon metal articles of their manufacture, but did not manufacture shovels, the defendants were enjoined from placing those words on shovels, they having exported shovels so marked to Australia, where the complainants marketed a portion of their output.⁶⁷ In a recent case Judge Bradford said: "Pale ale and half-and-half must, as against an infringer of a trademark for the former, be treated as malt liquors substantially similar to each other and belonging to the same class. Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrong-doer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."⁶⁸ Where the plaintiff was the manufacturer of "Omega Oil," a liniment extensively advertised as a remedy for skin and scalp diseases, a defendant who began to manufacture and sell a soap named "Omega Oil Medicated Soap," advertised by defendant as a remedy for diseases of

261, Fed. Case No. 8099; Amos-
keag Mfg. Co. v. Garner, 55 Barb.
151; George v. Smith, 52 Fed. Rep.
830; Air-Brush Mfg. Co. v. Thayer,
84 Fed. Rep. 640.

65—Carroll v. Ertheiler, Cox,
Manual, 669, 1 Fed. Rep. 688.

66—Wamsutta Mills v. Allen, 12

Phila. 535.

67—Collins Co. v. Oliver Ames &
Sons, 18 Fed. Rep. 561. See also
to same effect, Eno v. Dunn, L. R.
15 A. C. 252.

68—Bass, Ratcliff & Gretton
(Ltd.) v. Feigenspan, 96 Fed. Rep.
206-211.

the skin and scalp, an injunction was granted the plaintiff on the authority of the "Lone Jack" case, Judge Blanchard saying that "The adoption of the words 'Omega Oil' by defendant was calculated to deceive the public into the belief that plaintiff's article was being put up for sale in another form, at least into the belief that the soap was placed on the market by plaintiff or by its consent."⁶⁹

It is the necessary converse of the rule under consideration that it is no defense to an action for trademark infringement that the defendant used the mark in application to another class of merchandise before the plaintiff began his use of the mark. Thus where a defendant had applied the word, "Epicure" to canned peaches and canned tomatoes, that fact did not avail as a defense, where the plaintiff was the first to apply the word to canned salmon, and the defendant afterwards began to apply it to canned salmon. In his opinion, Judge Coxe observes: "The reasoning of some of the authorities would indicate that the defendants had a right to use the brand in connection with other fruit and vegetables, analogous to tomatoes and peaches, but to assert that they have the right to use it on all canned goods is carrying the doctrine far beyond any reported case. Beer and nails do not belong to the same class of merchandise because both are sold in kegs."⁷⁰

In a recent case in which the complainant's mark was applied to baking soda and saleratus, and the defendant's to baking powder, Judge Baker held the parties' goods to be in the same class because they were handled generally by the same class of dealers and purchased by the same class of customers; either is indifferently used to accomplish the same object; so that they come in direct competition with each other in sale and use. In that

69—Omega Oil Co. v. Weschler,
71 N. Y. Supp. 983, 984.

70—George v. Smith, 52 Fed.
Rep. 830-832.

case the rule is announced that "goods are in the same class whenever the use of a given trademark or symbol on both would enable an unscrupulous dealer readily to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trademark, or with his authority and consent."⁷¹

§ 110. The value of proof of fraudulent intent.—So much is said of fraudulent intent in the decisions that it is proper to discuss it in this place, in its relation to infringement. As we have seen, equity will restrain the use of the infringing mark without regard to the intent of the defendant. It is, however, a matter of practical importance to establish the deliberate fraud of the defendant where it exists. It was distinctly held by Lord Westbury that an account would only be given with the injunction in respect of any user by a defendant after he had become aware of the prior ownership;⁷² and in another case, where defendant claimed to have bought counterfeit champagne believing it to be genuine, an accounting was denied because of the absence of proof of guilty knowledge.⁷³ And the fraudulent intention of the defendant must be shown in an action at law,⁷⁴ or at least to support the recovery of punitive damages.⁷⁵ But the rule is fixed both in England and the United States that proof of fraudulent intent, or actual deception of the public, are alike unnecessary in actions in equity, in technical trademark cases; nor is it necessary in cases of trademark infringement or unfair competition to prove actual deception of purchasers where there is shown "a manifest liability to deception."⁷⁶

71—Church & Dwight Co. v. 3 Mylne & Cr. 338; Weed v. Peterson, 99 Fed. Rep. 276-280. 12 Abb. Pr. N. S. 178.

72—Edelsten v. Edelsten, 1 DeG. 74—Edelsten v. Edelsten, *supra*. J. & S. 185. 75—Faber v. D'Utassey. 11 Abb.

73—Moet v. Couston, 33 Beav. Pr. N. S. 399; Marsh v. Billings, 7 578. See also Rose v. Loftus, 47 Cush. 322; Cox, 118.

L. J. Ch. 576; Millington v. Fox, 76—Fuller v. Huff, 43 C. C. A.

§ 111. **The manner of establishing fraudulent intent.**—The inspection of the two marks in controversy is the main test of the alleged resemblance,⁷⁷ although the testimony of expert witnesses familiar with the trade and the habits of customers is of weight.⁷⁸ So, for example, where the plaintiff's mark was a tin star, and the defendant's a tin buzz-saw, both affixed in use upon plug tobacco, the court could have small difficulty in inferring fraudulent intent.⁷⁹ Among other matters considered by the courts as probative of the defendant's intent are false representations of securing awards at an exhibition;⁸⁰ the fact that defendant, who adopted as a mark for his factory the words "Norfolk House," previously used by plaintiff, kept the publication of that name out of a city directory;⁸¹ and the circumstance that defendant removed his place of business into the same locality as the plaintiff,⁸² or is dealing in other fraudulent goods.⁸³

A curious instance of facts regarded as indicia of fraud is to be found in a case where a plaintiff whose name, originally "Dr. J. W. Trust," had been changed to "Dr. T. F. Gouraud," was the manufacturer of cos-

453, 104 Fed. Rep. 141, 145, reversing *Fuller v. Huff*, 99 Fed. Rep. 439; *Manitowoc Malting Co. v. Milwaukee Malting Co.*, 119 Wis. 543, 97 N. W. Rep. 389.

77—*Drummond v. Tinsley*, 52 Mo. App. 10; *Liggett & Myers Tob. Co. v. Finzer*, 128 U. S. 182-184; *Weyman v. Soderberg*, 108 Fed. Rep. 63-65.

78—*Drummond v. Tinsley*, *supra*.

79—*Liggett & Myers Tob. Co. v. Sam Reid Tob. Co.*, 104 Mo. 53.

80—*Cave v. Myers, Seton* (4th ed.), 238; *Seb.* 304.

81—*Rodgers v. Rodgers*, 31 L. T. N. S. 285; *Seb.* 442.

82—*Elgin Nat. Watch Co. v. Illinois Watch Case Co.*, 89 Fed.

Rep. 487, 488; reversed on other grounds, 35 C. C. A. 237, 94 Fed. Rep. 667; *Fullwood v. Fullwood* (1), W. N. 1873, p. 93; W. N. 1873, p. 185; *Seb.* 42. See also to same effect, *Lee v. Haley*, 21 L. T. N. S. 546; 18 W. R. 181; L. R. 5 Ch. D. 155; 39 L. J. Ch. 284; 22 L. T. N. S. 251; 18 W. R. 242; *Viano v. Baccigalupo*, 183 Mass. 160, 67 N. E. Rep. 641; *Church v. Kresner*, 49 N. Y. Supp. 742; *International Society v. International Society*, 59 N. Y. Supp. 785.

83—*Chas. E. Hires Co. v. Consumers' Co.*, 100 Fed. Rep. 809-812, 41 C. C. A. 71.

metic styled "Gouraud's Oriental Cream," and the defendants, his sons, who had retained the name Trust, engaged in the sale of a cosmetic which they named "Creme Orientale, by Dr. T. F. Gouraud's Sons;" the court holding from these facts that the statement of the relationship, though truthful, was made with fraudulent intent.⁸⁴ The use on defendant's label of fictitious medals of award has been treated as evidence of fraudulent intent.⁸⁵

As most of these badges of fraud have been referred to by the courts because of their determining influence in cases of unfair competition, we will consider them at length in that connection. Those we have mentioned are illustrative, however, of the class of facts pertinent to be shown in cases of technical trademark infringement, and to prove which is important for the reasons and purposes above referred to.

§ 112. Infringing by refilling trademarked packages.—There is no doubt that one who furnishes liquors (or any other class of goods) with the expressed purpose that the goods so sold are to be used in refilling genuine packages whose original contents have been removed will be dealt with as an infringer and enjoined in equity.⁸⁶ The refilling of genuine packages will be restrained,⁸⁷ even where the package, a bottle bearing a name blown in the glass, is used for a similar article, in connection with a label not resembling that borne by

84—*Gouraud v. Trust*, 3 Hun, 627; Seb. 460.

85—*Bolen & Byrne Mfg. Co. v. Jonasch*, 60 N. Y. Supp. 555.

86—*Hostetter Co. v. Brueggeman-Reinart Distilling Co.*, 46 Fed. Rep. 188; *Cox, Manual*, 729; *Hostetter Co. v. Wm. Schneider Co.*, 107 Fed. Rep. 705; *Hostetter Co. v. Conron*, 111 Fed. Rep. 737; *Samuel Bros. & Co. v. Hostetter Co.*, 55 C. C. A. 111, 118 Fed. Rep.

257. Compare *Hostetter v. Fries*, 17 Fed. Rep. 620, in which defendants compounded a substance to be used in making *Hostetter's Bitters*, and sold it with directions for so using it, but injunction was denied. This decision is entitled to no weight.

87—*Evans v. Von Laer*, 32 Fed. Rep. 153; *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. Rep. 388; *Rose v. Henley*, cited at 47 L. J. Ch. 577; 38 L. T. N. S. 410; Seb. 551; Van

it originally.⁸⁸ Injunction will issue even where the refilling was done at the request of a customer.⁸⁹ Judge Thayer has enjoined a defendant from offering for sale an imitation of Hostetter's Bitters in bulk with advice to customers to refill bottles originally containing the genuine compound, with the spurious article.⁹⁰ In this class of cases "the burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."⁹¹

§ 113. Infringement by refitting and reselling worn trademarked articles.—Akin to refilling trademarked packages are cases where, a part of a trademarked article having worn out in service, the parts are replaced and the article sold without removing the trademark, and where this replacement of parts is made by the owner of the trademark, identity being substantially retained, no fraud is effected. Otherwise, if the replacement is made by a stranger.⁹² The Massachusetts court has refused to enjoin the manufacture of stove castings

Hoboken v. Mohns & Kaltenbach, 112 Fed. Rep. 528; Pontefact v. Isenberger, 106 Fed. Rep. 499; Hiram Ricker & Sons v. Leigh, 77 N. Y. Supp. 540; Eckhart v. Consolidated Milling Co. 72 Ill. App. 70; Scott v. Standard Oil Co., 106 Ala. 475.

88—Evans v. Von Laer, 32 Fed. Rep. 153; Hostetter v. Anderson, 1 V. R. (W. A'B. & W.) Eq. 7; 1 Anst. Jour. 4; Seb. 652; Rose v. Loftus, 47 L. J. Ch. 576; 38 L. T. N. S. 409; Seb. 608. See *contra*, Welch v. Knott, 4 K. & J. 747; 4 Jur. N. S. 330; Seb. 157.

89—Barnett v. Leuchars, 13 L. T. N. S. 495; 14 W. R. 166; Seb. 253.

90—Hostetter v. Brueggeman-

Reinert Co., 46 Fed. Rep. 188; Cox, Manual, 729; cited and followed in Hostetter v. Sommers, 84 Fed. Rep. 333. These cases overrule Hostetter v. Fries, 17 Fed. Rep. 620, where Judge Wallace refused to enjoin defendants who prepared and sold an extract, giving instructions to their customers for making "Hostetter's Bitters" from the extract. The rule stated in the text is followed in Myers v. Theller, 38 Fed. Rep. 607-609; Hostetter Co. v. Martinoni, 110 Fed. Rep. 524.

91—Coxe, J., in Hostetter Co. v. Comerford, 97 Fed. Rep. 585; and to the same effect see Hostetter Co. v. Bower, 74 Fed. Rep. 235.

92—General Electric Co. v. Re-New Lamp Co., 128 Fed. Rep. 154.

used to replace worn parts of a plaintiff's trademarked stoves.⁹³

§ 114. **Infringement by applying a manufacturer's trademark to goods of his to which he does not intend its application.**—In *Hennessy v. White*, the defendants bottled brandy, purchased in casks from plaintiffs, and applied to such bottling a label which was a colorable imitation of that used by plaintiffs to designate a higher grade of brandy sold by them in bottles only. The court, by Molesworth, J., said: "I think a new feature which has not been present in any other case, and is, therefore, not touched by the language of the other cases, is one which I ought to act upon here; that is, that the makers of articles of different qualities are entitled to brand their best article in a particular way to show the superior value they put upon it." Stowell, C. J., in the same case, in the Victoria supreme court, states the rule more broadly: "If a brandy different from that which the manufacturer bottled is put into bottles and sold as the manufacturer's bottled brandy, the fact that it is the manufacturer's bulk brandy does not make the sale less an imposition."⁹⁴ There can be no doubt of the right of the manufacturer or selector to designate goods of a certain grade bottled or packed by him by a distinctive trademark, and that no one purchasing goods in bulk from him can thereby acquire the right to pack or bottle such goods under the trademark of the vendor used only upon his packing or bottling. Whether the bulk goods are better than or inferior to the trademarked goods is utterly immaterial except as bearing upon the question of damages.⁹⁵

93—*Magee Furnace Co. v. Le Barron*, 127 Mass. 115.

Seb. 651; *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585.

94—*Hennessy v. White*, 6 W. W. & A'B. Eq. 216-221; Seb. 650. See also to same effect *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225;

95—See the case in which a person purchasing pens from a manufacturer removed the labels and substituted others marked with a

"It is manifest that the sale of merchandise in bulk by a manufacturer does not justify the vendee in using on his retail packages the label which the manufacturer uses upon the same merchandise only when prepared by himself on smaller packages for the retail trade,"⁹⁶ but he is at liberty to so mark them as to truthfully indicate the manufacturer.⁹⁷ Where bulk goods were sold without limitation as to the manner in which they were to be re-sold, the effect of the sale was held to be "to invest the defendants (vendees) with the title to the article, and with the right to divide it into small packages, as (they) might see fit, and sell the same as originating from the plaintiff, according to the fact."⁹⁸

§ 115. Substitution.—By "substitution," as used here, is meant the substitution by a retail merchant of goods other than those called for by a purchaser. In its narrower sense it is confined to the retail merchant who commits the offense. In its broader sense it includes the manufacturer of the substituted goods in cases where he has so prepared the goods as to make the substitution possible, and for the purpose and with the intent that they may be substituted.¹ Of such manufacturers the superior court of New York, by Barrett, J., said: "The law of trademarks has been gradually expanding so as to meet just such cases. The courts, in a long and unbroken line of decisions, have endeavored to uphold and enforce commercial morality, and have afforded their protection to honest enterprise and skill."² As to the

numeral indicating another grade of pen made by the same manufacturer. *Gillott v. Kettle*, 3 Duer, 624; Cox, 148.

96—Taft, J., in *Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585-592.

97—*Russia Cement Co. v. Katzenstein*, 109 Fed. Rep. 314.

98—Wheeler, J., in *Russia Ce-*

ment Co. v. Frauenhar, 126 Fed. Rep. 228.

1—*Enoch Morgan's Sons Co. v. Wendover*, 43 Fed. Rep. 420.

2—*Morgan Sons Co. v. Troxell, Cox, Manual*, 674. The New York court of appeals, treating this case as purely a technical trademark case, reversed it in 89 N. Y. 292. If there had been considered

retailer who performs the actual substitution, there is no question that he will invariably be enjoined from repetitions of his offense.³

The law as to substitution is admirably embraced in the language of Judge Lacombe: "A court of equity will not allow a man to palm off his goods as those of another, whether his misrepresentations are made by word of mouth, or more subtly, by simulating the collocations of details of appearance by which the consuming public has come to recognize the product of his competitor."⁴

The sale of an imitation article without misrepresentation will not be enjoined. Where the article was a bitters made in imitation of Hostetter's Bitters, but the defendant had sold the goods without any misrepresentation of their identity and without suggesting their adaptability for substitution, injunctive relief was refused.⁵

False oral representations that defendant's goods are those of the complainant will be enjoined,⁶ though where the defendant's affidavits contradict those of the plaintiff concerning such representations preliminary injunction will be denied,⁷ and the proof must be clear on final hearing to entitle plaintiff to the relief sought.⁸

§ 116. The use of misleading signs and circulars enjoined.—The use of misleading business signs will be

by the appellate court the doctrines we have now under discussion, the decision of the lower court would have been affirmed. *Taendsticksfabriks Aktiebolaget Vulcan v. Myers*, 11 N. Y. Sup. 663; *Avery v. Meikle*, 81 Ky. 75; *Cox*, Manual. 686, and cases cited elsewhere in this chapter.

3—*Saxlehner v. Eisner & Mendelson Co.*, 88 Fed. Rep. 61-70; *Munro v. Smith*, 13 N. Y. Sup. 708; *N. K. Fairbanks Co. v. Dunn*, 126 Fed. Rep. 227.

4—*Enterprise Mfg. Co. v. Landers, Frary & Clark*, 65 C. C. A. 587, 131 Fed. Rep. 40, 241; affirming 124 Fed. Rep. 923.

5—*Hostetter Co. v. Van Vorst*, 62 Fed. Rep. 600.

6—*Weber Medical Tea Co. v. Kirchstein*, 101 Fed. Rep. 580.

7—*Lavanburg v. Pfeiffer*, 52 N. Y. Supp. 801.

8—*Lavanburg v. Pfeiffer*, 66 N. Y. Supp. 39.

restrained in equity, whether or not such signs are fixed before a particular place of business, or are distributed through the trade. The general rule has been thus stated by the Chancellor of Upper Canada in a case involving the use of signs bearing words "The Golden Lion" used upon a dry goods establishment: "Where it is clear to the Court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the Court should say to him 'Remove that sign; its use by you may, as you intend, damage the plaintiff. It cannot be necessary or valuable to you for any other purpose. You have your choice of many signs which, as a mere attraction, or to give your store a marked designation, must answer a fair business purpose equally well.' " " 9

It will be noted that in the foregoing case the deception employed consisted in duplicating the tradename in which the plaintiff's business was conducted. The same principle has been applied by a New York Court in granting equitable protection to a flag design used in newspaper advertising by a real estate auctioneer. The advertising device which was employed was the representation of a flag having an ornamentation of stars, fancifully arranged along its upper and lower edges. The defendant duplicated this device in his newspaper advertising matter, and there was testimony tending to show that persons had actually been deceived into believing that the defendant's advertising was that of the plaintiff.¹⁰

9—Walker v. Alley, 13 Grant Up. Can. Ch. 366.

10—Johnson v. Hitchcock, 3 N. Y. Supp. 680.

In the latter case, therefore, the signs were not used upon a place of business. In a Missouri case, equitable relief was granted to a brewing company in the use of white muslin signs of peculiar size and lettering which had been distributed both by the plaintiff and the defendant brewing companies to the retail trade throughout the city of St. Louis. The decree in the lower court was for the plaintiff. The St. Louis Court of Appeals, in reversing the decree directing the injunction for the plaintiff, said: "The correct decision of the case at bar depends upon the finding of two propositions: was the imitation of the plaintiff's signs by defendant merely the result of an accident; or was it the result of a pre-conceived design to mislead the public into the belief that the plaintiff's beer was being sold at the defendant's place of business? Was the imitation of the sign close enough to bring about such a deception?"¹¹

The more usual cases are those of signs bearing similar tradenames exhibited on competing stores in the same vicinity, in which the sign of the later comer is enjoined if calculated to mislead the public into the false belief that they are patronizing the older establishment.¹²

Circulars containing false statements.—The usual remedy by injunction against unfair competition will be granted where a competitor issues circulars calculated to deceive customers into the false belief that the goods of the parties are identical.¹³ The relief has been granted where the defendant's circulars were sent to the plaintiff's customers and recited that defendant had there-

11—American Brewing Co. v. St. Louis Brewing Co. 47 Mo. App. 14, 20. Caton College Co., (Minn.) 92 N. W. Rep. 958.

12—Miskell v. Prokop, 58 Nebr. 628, 79 N. W. Rep. 552; Nolan Bros. Shoe Co. v. Nolan, 131 Calif. 271, 63 Pac. Rep. 480; Ricard v. 13—Brown v. Braunstein, 83 N. Y. Supp. 1096; Van Stan's Stratena Co. v. Van Stan,—Pa.—, 58 Atl. Rep. 1064. For a form of injunction in such a case see Bunker v. Ken- na, Price & Stewart 883.

tofore distributed the goods, and that the defendant's manufacturing was done in part at the plaintiff's street address.¹⁴

Similarly, the use of display signs calculated to deceive the public into patronizing one competitor in the belief that they are patronizing the other, will be enjoined,¹⁵ as will the publication of circulars calculated to induce the false belief that a book published by complainant was fraudulent.¹⁶

§ 117. **Infringement by a dissimilar word or mark.**—The general rule is that there may be infringement even in the absence of exact similarity between the marks.¹⁷

In 1866 Lord Cranworth said in a leading case: "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device."¹⁸ This dictum was elicited in a case where the

14—American Novelty & Mfg. Co. v. Manufacturing Electrical Novelty Co., 73 N. Y. Supp. 755.

15—Cady v. Schultz, 19 R. I. 193, 32 Atl. Rep. 915; Duke v. Cleaver, (Tex.) 46 S. W. Rep. 1128.

16—Halstead v. Houston, 111 Fed. Rep. 376.

17—Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883. "What degree of resemblance is necessary is, from the nature of things, a matter incapable of definition *a priori*. All that courts of justice can do is to say that no trader can adopt a trademark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled." Lord Cranworth in *Seixo v. Provezende*, L. R. 1 Ch. D. 192.

18—*Seixo v. Provezende*, *supra*; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

The doctrine of the leading case applies to all cases where the goods of a particular dealer or manufacturer have become known by a name derived from his trademark. *Anglo-Swiss Condensed Milk Co. v. Metcalf*, L. R. 31 Ch. D. 454; 55 L. J. Ch. 463; 34 W. R. 345; 3 R. P. C. 28; *Cartmell*, 48; *Re Speer's Trademark*, 4 R. P. C. 521; 55 L. T. N. S. 880; *Cartmell*, 317; *Re Baschiera's Trademark*, 33 S. J. 469; *Re La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 436; L. R. (1894) 1 Ch. D. 61; 11 R. P. C. 142; *Wilkinson v. Griffith*, 8 R. P. C. 370; *Cartmell*, 344; *Morgan Envelope Co. v. Wal-*

plaintiff sold wine in casks stamped with the device of a crown and an eagle, and the initials "B. S." on the head of the cask, and a crown, the word "Seixo" and a date at the bung hole, from which the wine had acquired the name "Crown Seixo;" while the defendants sold wine in casks stamped on the head and at the bung hole with the device of a crown, the initials "C. B.," the words "Seixo de Cima," and figures "1861." The defendants were enjoined notwithstanding the fact that the marks were not similar.

Under this rule, plaintiffs who made a certain beer to which they applied the device of a bull-dog's head were granted an injunction against the use by competing dealers of a label similar in shape to the plaintiffs' and bearing a terrier's head. There was no resemblance between the labels beyond the similarity in shape, but the plaintiffs' beer had come to be known as "Dog's Head Beer," and the use of a dog's head upon similar merchandise by the defendants was manifestly for the purpose of passing off their beer as being the plaintiffs'.¹⁹ It is self-evident that a trademark may be infringed by a mark entirely different, but suggesting to customers and the public the same word or idea. Thus when an English house had used in India a trademark for yarn which had led the natives to call for it as "Bhe Hathi" (meaning "Two Elephant") yarn, a competing firm was enjoined from exporting yarn to India under a trademark of which the principal feature was the representation of two elephants.²⁰ On the same reasoning the word "Sportsman's" accompanied by a picture of two mounted huntsmen, used as a trademark for cherry brandy, was held to be infringed by the picture of a

ton, 82 Fed. Rep. 469; 81 Off. Gaz. 1615; Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374, 82 Fed. Rep. 662; Kann v. Diamond Steel Co., 89 Fed. Rep. 706. 19—Read v. Richardson, 45 L. T. N. S. 54; Cox, Manual, No. 698. 20—Orr-Ewing & Co. v. Johnston & Co., 40 L. T. N. S. 307; Seb. 646.

hunter standing beside his horse, and the words "Huntsman's Cherry Brandy," where the proof *aliunde* showed that the plaintiffs' liquor had become known to the public as "The Hunter's Cherry Brandy."²¹

Judge Sanborn has well said that "every suit of this character is founded on the fact that the action, or the proposed action, of the defendant has deceived, or is calculated to deceive, ordinary purchasers buying with usual care, so that they have purchased, or will probably purchase, the goods of the defendant under the mistaken belief that they are those of the complainant."²² So that each case must turn upon the peculiar facts involved. Thus where a plaintiff had for some time manufactured tennis racquets uniformly stamped at a particular place upon the handle with the words "The Demon," and the defendant began to manufacture and sell racquets of a similar design, stamped, in the corresponding place upon the handle, with the word "Demotic," the use of the word "Demotic" was restrained.²³ So the word "Curative," applied to soap, has been held to infringe the word "Cuticura," similarly applied;²⁴ and a red Greek cross has been held to be infringed by a maltese cross with a red center, each being used as a mark upon medicinal plasters.²⁵

21—*Re Barker's Trademark*, 53 L. T. N. S. 23; *Cartmell*, 72. Similar cases are *Barlow v. Johnson*, 7 R. P. C. 395; *Cartmell*, 73; *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183; *Cartmell*, 333; *Re Worthington's Trademark*, L. R. 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747; *Cartmell*, 351; *Jerome v. Johnson*, 59 N. Y. Supp. 859.

22—*Kann v. Diamond Steel Co.*, 89 Fed. Rep. 706.

23—*Slazenger v. Feltham*, 6 R. P. C. 531; *Cartmell*, 310. Thus where an anchor had been registered in England as an umbrella

trademark, the word "Ancross" for umbrellas was refused registration. *Re Thewlis & Blakey's Trademark*, 10 R. P. C. 369.

24—*Potter Drug & Chemical Corp. v. Miller*, 75 Fed. Rep. 656.

25—*Johnson & Johnson v. Bauer & Black*, 27 C. C. A. 374, 82 Fed. Rep. 662; reversing same case, 79 Fed. Rep. 954. In his opinion Judge Jenkins said: "It sufficiently appeared by the testimony that the goods of the appellant have come to be known, and are offered, ordered and sold, as 'Red Cross Plasters;' and we cannot but think that the maltese

Other instances in which the courts have declared a word or words used as a trademark to be infringed by a different word or words will be found instructive. For the convenience of the reader they are tabulated in alphabetical order.

The Trademark.

"Abacus."
 "Alba."
 "Anvil."
 "Apollinaris."
 "Black Diamond."
 "Bovilene."
 "Burgess."
 "Canadian Club Whiskey."
 "Cascarets."
 "Cascarets."
 "Cashmere Bouquet."
 "Celluloid."
 "Chartreuse."
 "Chatterbox."

Held to be infringed by

"Arcade."²⁶
 "Antique."²⁷
 "Anchor."²⁸
 "Apollinis."²⁹
 "Diamond Gem."³⁰
 "Bovina."³¹
 "Burgiss."³²
 "Canadian Rye Whiskey."³³
 "Cascara."³⁴
 "Castorets."³⁵
 "Violets of Cashmere."³⁶
 "Cellonite."³⁷
 "Chasseurs."³⁸
 "Chatterbook."³⁹

cross adopted by the appellee, in so far as it contains a red circle, has a tendency to promote confusion, and will interfere with the legitimate trade of the appellant. . . . The red cross speaks to the eye, and the article being known by that designation speaks also to the ear by that name."

26—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

27—Ibid.

28—Ibid.

29—Apollinaris Co. v. Herrfeldt, 4 P. R. 478; Apollinaris Brunnen v. Somborn, 14 Blatchf. 380; Fed. Case No. 496.

30—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

31—Lockwood v. Bostwick, 2 Daly, 521.

32—Burgess v. Hills, 26 Beavan, 244.

33—Walker v. Mikolas, 79 Fed. Rep. 955.

34—Sterling Remedy Co. v. Gorey, 110 Fed. Rep. 372.

35—Sterling Remedy Co. v. Spermine Remedy Co. 50 C. C. A. 657, 112 Fed. Rep. 1000.

36—Colgate v. Adams, 88 Fed. Rep. 899.

37—Celluloid Mfg. Co. v. Cellonite Mfg. Co. 32 Fed. Rep. 94.

38—A. Bauer Co. v. Order of Carthusian Monks, 56 C. C. A. 484 120 Fed. Rep. 78, 80.

39—Estes v. Leslie, 29 Fed. Rep. 91.

The Trademark.

"Clark's O. N. T."
 "Cocaine."
 "Cocoatina."
 "Coe's Superphosphate
 of Lime."
 "Corona."
 "Cottolene."
 "Cupola."
 "Cyclops Machine
 Works."
 "Doric."
 "Derby."
 "Duplex."
 "Economy."
 "Egyptian Deities."
 "El Destino."

 "Electro-Silicon."
 "Excelsior."
 "Flor de Margaretta."

Held to be infringed by

"Clark's N. E. W."⁴⁰
 "Cocaine."⁴¹
 "Cocaotine."⁴²
 "Andrew Coe's Super-
 phosphate of Lime."⁴³
 "Corinth."⁴⁴
 "Cottoleo."⁴⁵
 "Composite."⁴⁶
 "Cyclops Iron Works."⁴⁷

 "Delos."⁴⁸
 "Derwent."⁴⁹
 "Deluxe."⁵⁰
 "Economic."⁵¹
 "Egyptian Amasis."⁵²
 "El Divino" and "El
 Destinacion."⁵³
 "Electric-Silicon."⁵⁴
 "Excellent."⁵⁵
 "Margarita."⁵⁶

40—Clark Thread Co. v. Armistage, 21 C. C. A. 178, 74 Fed. Rep. 936.

41—Burnett v. Phalon, 9 Bos. 192.

42—Schweitzer v. Atkins, 37 L. J. Ch. 847.

43—Coe v. Bradley, Fed. Case No. 2941, 9 Off. Gaz. 541.

44—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

45—N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

46—Keuffel & Esser Co. v. H. S. Crocker Co., *supra*.

47—Hainque v. Cyclops Iron Works, 136 Calif. 35, 68 Pac. Rep. 1014.

48—Keuffel & Esser Co. v. H. S. Crocker Co. 118 Fed. Rep. 187.

49—Derby Dry Plate Co. v. Polard, 2 Times L. R. 276.

50—Keuffel & Esser Co. v. H. S. Crocker Co., *supra*.

51—Ibid.

52—Anargyros v. Egyptian Amasis Cigarette Co. 66 N. Y. Supp. 626.

53—Pinto v. Trott, 8 P. R. 173.

54—Electro-Silicon Co. v. Trask, 59 How. Pr. 189, followed in Same v. Levy, 59 How. Pr. 469.

55—Volger v. Force, 71 N. Y. S. 209.

56—Benedictus v. Sullivan, 12 P. R. 25.

The Trademark.

"Genuine Durham Smoking Tobacco," with the picture of a bull.

"German."

"German Household Dyes."

"Germea."

"Gold Dust."

"Golden Crown."

"Gothic."

"Guinness."

"Home."

"Home Brand."

"Honeymoon."

"Hostetter Bitters."

"Hostetter & Smith."

"Humphrey's Homeopathic Specifics."

"Junket Tablets."

"Ky's Criterion."

Held to be infringed by

"The Durham Smoking Tobacco," with the picture of a bull's head."⁵⁷

"Germania."⁵⁸

"Excellent German Household Dyes."⁵⁹

"Germ."⁶⁰

"Gold Drop."⁶¹

"Golden Chain."⁶²

"Ionic."⁶³

"Genuine."⁶⁴

"Home Delight."⁶⁵

"Home Comfort."⁶⁶

"Honeycomb."⁶⁷

"Host-Style Bitters."⁶⁸

"Holsteter & Smyte."⁶⁹

"Reeves' Imported Homeopathic Specifics."⁷⁰

"Junket Capsules."⁷¹

"Ky's Credential."⁷²

57—Blackwell v. Armistead, 3 Hughes, 163; Fed. Case No. 1474.

58—Walter Baker & Co. v. Baker, 77 Fed. Rep. 181.

59—Oppermann v. Waterman, 94 Wis. 583; 69 N. W. Rep. 569.

60—Sperry v. Percival Milling Co., 81 Cal. 252.

61—N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 42 C. C. A. 376, 102 Fed. Rep. 327; reversing s. c., 88 Fed. Rep. 694.

62—Parlett v. Guggenheimer, 67 Md. 542; 10 Atl. Rep. 81.

63—Keuffel v. Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

64—Guinness v. Heap, Seb. 617.

65—New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.

66—Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed. Rep. 359.

67—Kentucky Distilleries & Warehouse Co. v. Wathen, 110 Fed. Rep. 641-644.

68—Hostetter v. Becker, 73 Fed. Rep. 297.

69—Hostetter v. Vowinkle, 1 Dill. 329, Fed. Case No. 6714.

70—Humphreys' Specific Med. Co. v. Wenz, 14 Fed. Rep. 250-253.

71—Hansen v. Siegel-Cooper Co., (2), 106 Fed. Rep. 691.

72—Kentucky Distilleries &

The Trademark.

"Lacto-Peptide."

"Landlords' Protective Bureau."

"Leopoldshall."

"Lightning Hay Knives."

"Limetta."

"Little Shop."

"Maizena."

"Manufacturers' Outlet Co."

"Maryland Club Rye."

"Mechanics' Store."

"Miller's Chicken Cock Whiskey."

"Momaja."

"Morse's Compound Syrup of Yellow Dock Root."

Held to be infringed by

"Lactopepsine."⁷³

"Landlords' Protective Department."⁷⁴

"Leopoldsalt."⁷⁵

"Lightning Pattern Hay Knives."⁷⁶

"Limette."⁷⁷

"Little Antique Shop."⁷⁸

"Maizharina."⁷⁹

"Taunton Outlet Co."⁸⁰

"Maryland Jockey Club Rye."⁸¹

"Mechanical Store."⁸²

"Miller's Game Cock Rye."⁸³

"Mojava."⁸⁴

"Dr. Morse's Improved Yellow Dock and Sarsaparilla Compound."⁸⁵

Warehouse Co. v. Wathen, 110 Fed. Rep. 641-644.

73—Carnrick v. Morson, L. J. N. of C. (1877), p. 71.

74—Koebel v. Chicago Landlord's Protective Bureau, 210 Ills. 176, 71 N. E. Rep. 362; affirming Chicago Landlords' Protective Bureau v. Koebel, 112 Ill. App. 21.

75—Radde v. Norman, L. R. 14 Eq. 348.

76—Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

77—Drewry & Son v. Wood, 127 Fed. Rep. 887.

78—Crawford v. Lans, 60 N. Y. Supp. 387.

79—Glen Cove Mfg. Co. v. Ludeking, 22 Fed. Rep. 823; 23 Blatchf. 46.

80—Samuels v. Spitzer, 177 Mass. 226, 58 N. E. Rep. 693.

81—Cahn v. Gottschalk, 2 N. Y. Supp. 13.

82—Weinstock, Lubin & Co. v. Marks, 109 Cal. 529.

83—G. G. White Co. v. Miller, 50 Fed. Rep. 277.

84—American Grocery Co. v. Sloan, 68 Fed. Rep. 539.

85—Alexander v. Morse, 14 R. I. 153.

The Trademark.

"Mottled German Soap."
with circle, moon and
stars.

"Moxie."

"Moxie Nerve Food."

"Nickel-In."

"Normal."

"Old Crow."

"Old Mill Soap."

"Pancoast."

"Paragon."

"Pepto-Mangan."

"Portland."

"Pride."

"Pride of Rome."

"Roberts' Parabola
Gold - Burnished
Sharps."

"Rogers."

Held to be infringed by

"S. W. McBride's Ger-
man Mottled Soap,"
with a crescent and
star.⁸⁶

"Noxie."¹

"Standard Nerve
Food."²

"Nickel-Saved."³

"Normandy."⁴

"White Crow."⁵

"Old Stone Mill Soap."⁶

"Pan-coast."⁷

"Pebble."⁸

"Pepto-Manganate of
Iron and Cascara."⁹

"Famous Portland."¹⁰

"Pride of Syracuse."¹¹

"Pride of the Home."¹²

"William Clark & Sons'
Parabola Gold-Burn-
ished Sharps."¹³

"RoDgers."¹⁴

86—Proctor v. McBride, Fed. Case No. 11441.

1—Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248.

2—Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205.

3—Schendle v. Silver, 70 N. Y. Sup. Ct. 330, 18 N. Y. Supp. 1.

4—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

5—W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421; 25 Misc. Rep. 20.

6—Swift & Co. v. Brenner, 125 Fed. Rep. 826.

7—Janney v. Pan-Coast Ventila-
tor & Mfg. Co., 128 Fed. Rep. 121.

8—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

9—M. J. Breitenbach Co. v. Spangenberg, 131 Fed. Rep. 160.

10—Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788.

11—Hier v. Abrahams, 82 N. Y. 519.

12—Ft. Stanwix Canning Co. v. Wm. McKinley Canning Co., 63 N. Y. Supp. 704.

13—Roberts v. Sheldon, 8 Biss. 398; Fed. Case No. 11916.

14—International Silver Co. v. Rodgers Bros. Cutlery Co., 136 Fed. Rep. 1019, 1021.

The Trademark.

"Roy Watch-Case Co."

"Sanitas."

"Sapolio."

"Sapolio."

"Sawyer's Crystal Blue
and Safety Box."

"Shawknit."

"Shrewsbury, Marshall
& Co. Patent
Thread."

"Simplicity."

"Six Little Tailors."

"Serosis."

"Southern Company, St.
Louis."

"Star."

"Stark."

"Steinway."

"Stephens."

"Stuart's Dyspepsia
Tablets."

Held to be infringed by

"Camm-Roy Watch-Case
Co."¹⁵

"Condisanitas."¹⁶

"Saphia."¹⁷

"Sapho."¹⁸

"Sawin's Soluble Blue
and Pepper Box."¹⁹

"Seamless."²⁰

"Schrewsbury - Marchal
Patent Thread."²¹

"Simplicity."²²

"Six Big Tailors."²³

"Sartoris."²⁴

"Southwestern, St.
Louis."²⁵

"Lone Star."²⁶

"Star."²⁷

"Steinberg."²⁸

"Steel Pens."²⁹

"Dr. Stewart's Dyspep-
sia Tablets."³⁰

15—Roy Watch-Case Co. v. Camm-Roy Watch Case Co., 59 N. Y. Supp. 979.

16—Sanitas Co. v. Condry, 4 P. R. 195.

17—Enoch Morgan's Sons Co. v. Schwachofer, 5 Abb. Pr. N. C. 265.

18—Enoch Morgan's Sons Co. v. Whittier-Coburn Co., 118 Fed. Rep., 657.

19—Sawyer v. Kellogg, 7 Fed. Rep. 720, 9 Fed. Rep. 601.

20—Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707; 21 Blatchf. 1.

21—Marshall v. Ross, L. R. 8 Eq. 651.

22—Keuffel & Esser Co. v. H. S.

Crocker Co., 118 Fed. Rep. 187.

23—Mossler v. Jacobs, 65 Ill. App. 571.

24—Little v. Kellam, 100 Fed. Rep. 353.

25—Southern White Lead Co. v. Cary, 25 Fed. Rep. 125.

26—Hutchinson v. Covert, 51 Fed. Rep. 832, 61 Off. Gaz. 1017.

27—Gardner v. Bailey, Seb. 365; Fed. Case No. 5221.

28—Steinway v. Henshaw, 5 P. R. 77.

29—Stephens v. Peel, 16 L. T. N. S. 145.

30—Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243, 33 C. C. A. 280.

The Trademark.

"Sunlight."
 "Swan."
 "Tonge's."
 "Trafford."
 "Uneeda."
 "Universal."
 "Vitae-Ore."
 "Wamsutta."
 "Warren."
 "Welcome."
 "Willoughby Lake."
 "Yusea."
 "55."

Held to be infringed by

"American Sunlight."³¹
 "Black Swan."³²
 "Tung's."³³
 "Stafford."³⁴
 "Iwanta."³⁵
 "University."³⁶
 "Vitalizing Ore."³⁷
 "Wamyesta."³⁸
 "Warranted."³⁹
 "Welcome A. Smith."⁴⁰
 "Willoughby Ridge."⁴¹
 "U-C-A."⁴²
 "35."⁴³

It follows that a word may infringe a symbol, or *vice versa*. Thus the figure of Columbia is an infringement of the word "Columbia," previously applied to the same class of merchandise.⁴⁴ But the use by a plaintiff of a conventional diamond-shaped design has been held not to confer a trademark right in the word "diamond," Judge Adams remarking: "If the complainant's goods had ever been known in the trade as 'diamond steel,' or

31—Lever Bros. v. Pasfield, 88 Fed. Rep. 484.

32—*Ex parte* Caire, 15 Off. Gaz. 248.

33—Tonge v. Ward, 21 L. T. N. S. 480.

34—Smith v. Carron Co., 13 P. R. 108.

35—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

36—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

37—Noel v. Ellis, 89 Fed. Rep. 978.

38—Wamsutta Mills v. Allen, 12 Phila. 535.

39—Frost v. Rindskopf, 42 Fed. Rep. 408.

40—Lever Bros. Ltd., Boston Works v. Smith, 112 Fed. Rep. 998.

41—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

42—Welsbach Light Co. v. Adam, 107 Fed. Rep. 463.

43—Collins v. Reynolds Card Mfg. Co., 7 Abb. N. C. 17, Price & Steuart, 262.

44—Morgan Envelope Co. v. Walton, 82 Fed. Rep. 469; 81 Off. Gaz. 1615. In this connection, see Kann v. Diamond Steel Co., 89 Fed. Rep. 706, and Re Thewlis & Blakey's Trademark, 10 R. P. C. 369.

generally as 'diamond' goods, it would undoubtedly be protected in the use of the word 'diamond' as a trade-name, even though such word nowhere appeared in connection with the symbol of a conventional diamond forming its trademark. Its use by a competitor, either as its corporate name or tradename for its product, under such circumstances would undoubtedly tend to deceive, and fall within the condemnation of the cases of complainant's counsel. See, especially, *Johnson v. Bauer*, 82 Fed. Rep. 662." ⁴⁵

The addition of other symbols, words or initials to the trademark of another will not operate to avoid a charge of infringement. "No one who has counterfeited a legitimate trademark and applied the spurious symbol in competition with the genuine can avoid the charge of infringement by showing that the false mark has in practice been so accompanied, on labels, capsules or otherwise, by tradenames, designations, descriptions or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may affect the nature or measure of the relief to be granted, cannot defeat a suit for infringement." ⁴⁶

In the absence of proof of any deception of the public, the courts have not been inclined to declare a different mark an infringement unless the similarity was close. Thus it has been held that the word "Pudding" does not infringe the word "Puddine;" ⁴⁷ that the word "Bacocuro" does not infringe the word "No-to-bac;" ⁴⁸ that the mark "B. & S." does not infringe the mark

45—Pittsburg Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637-642. 47—Clotworthy v. Schepp, 42 Fed. Rep. 62.

46—Bradford, J., in *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206-212. 48—Sterling Remedy Co. v. Eureka Chem. & Mfg. Co., 80 Fed. Rep. 105, 25 C. C. A. 314.

"S. B.;"⁴⁹ that the mark "Filofloss," applied to silk, is a valid trademark notwithstanding the prior use of the mark "Filoselle" applied to silk of a different character;⁵⁰ that the mark "Beeshore One-Night Cough Cure" does not infringe the mark "One Night Cure;"⁵¹ that the mark "Elastic Tolu" does not infringe the mark "Sappota Tolu;"⁵² that the mark "Star" and an uncolored tin star is not infringed by "Starlight" and a red paper star;⁵³ that "Everyday Soap" was not so clearly infringed by "Everybody's Soap" as to warrant a preliminary injunction;⁵⁴ that the mark "Cuticura" is not infringed by the mark "Cuticle;"⁵⁵ that the mark "Grape-nuts" is not infringed by the mark "Grain-Hearts;"⁵⁶ that the mark "Yama-Mai" is not infringed by "Ma-mie;"⁵⁷ that "Weber" applied to pianos, is not infringed by "Webster;"⁵⁸ that "Hurricane" is not infringed by "Tempest;"⁵⁹ that "B. T. Babbitt's Trademark Best Soap" is not infringed by "P. T. Butler's Trademark Best Soap;"⁶⁰ that the name "Social Register" applied to a directory is not infringed by the words "Newport Social Index;"⁶¹ that the name "Vichy" was not infringed by "Lithia-Vichy," there being numerous artificial vichy waters upon the mar-

49—Burt v. Smith, 71 Fed. Rep. 161-163.

50—Rawlinson v. Brainard & Armstrong Co., 59 N. Y. Supp. 880; 28 Misc. Rep. 287.

51—Kohler Mfg. Co. v. Beeshore, (2), 59 Fed. Rep. 572-576, 8 C. C. A. 215.

52—Adams v. Heisel, 31 Fed. Rep. 279.

53—Liggett & Myers Tobacco Co. v. Finzer, 128 U. S. 182.

54—Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357; 34 C. C. A. 405.

55—Potter D. & Chem. Corp. v.

Pasfield Soap Co. (1), 102 Fed. Rep. 490; Same v. Same (2), 106 Fed. Rep. 914, 46 C. C. A. 40.

56—Postum Cereal Co. Ltd. v. American Health Food Co., 109 Fed. Rep. 898.

57—Boessneck v. Iselin, 82 N. Y. Supp. 164.

58—Foster v. Webster Piano Co., 13 N. Y. Supp. 338.

59—Hurricane Patent Lantern Co. v. Miller, 56 How. Pr. 234.

60—Babbitt v. Brown, 68 Hun 515.

61—Social Reg. Assn. v. Murphy, 128 Fed. Rep. 116.

ket;⁶² that the mark "Rough-on-Rats" was not infringed by "Rough on Skeeters," the goods not being in competition,⁶³ that the book title "Farthest North, Nansen," was not infringed by "The Fram 'Expedition.'"⁶⁴ While the word "Muffler" is closely similar to "Mufflet," and the latter is a valid trademark for neck-scarfs, the use of the former cannot be enjoined because it is aptly descriptive of the article to which it is applied.⁶⁵

It is important to note in this connection the expression of Lord Cranworth, that "It would be a mistake to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use."⁶⁶

And another rule is that a defendant cannot evade the charge of infringement by "showing that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways."⁶⁷

§ 118. Patent office rulings on similarity of alleged conflicting marks.—The decisions of the several commissioners of patents as to similarity and dissimilarity of marks alleged to be conflicting or identical are frequently instructive and valuable as illustrations. In the language of Allen, Commissioner, "The question of anticipation by a prior registered mark may be tested by the question of infringement. The doctrine of the patent law that that which would infringe if later in date will anticipate if earlier is applicable to questions of

62—*La Republique Francaise v. Schultz*, (4) 115 Fed. Rep. 196.

63—*Wells v. Ceylon Perfume Co.*, 105 Fed. Rep. 621.

64—*Harper v. Lare*, 93 Fed. Rep. 989; *Harper & Bros. v. Lare*, 43 C. C. A. 182, 103 Fed. Rep. 203.

65—*Hygienic Fleeced Underwear Co. v. Way*, C. C. A., 137 Fed. Rep. 592, 595.

66—*Seixo v. Provezende*, L. R. 1 Ch. D. 192.

67—*Lord Watson in Singer Mfg. Co. v. Loog* (3), 8 App. Cas. 39.

trademark, for it involves only the question of substantial identity.”⁶⁸

In the following cases registration was refused upon a prior-registered mark because of the similarity adjudged by the Commissioner to exist between them:

The Applicant's mark

“Colonial.”
 “Dyspepticide.”
 “Liveroid.”
 “Maple Leaf.”
 “Nitro-Hunter.”
 “Pepko.”
 “Satin Skin.”
 “Sagafoam.”
 “Telegraphphone.”
 “Velva.”

Rejected on

“Colonial Dame.”⁶⁹
 “Dyspeptique.”⁷⁰
 “Liveraid.”⁷¹
 “Silver Leaf.”⁷²
 “Nitro.”⁷³
 “Pep-Kola.”⁷⁴
 “Satinette.”⁷⁵
 “Sea Foam.”⁷⁶
 “Telegraphophone.”⁷⁷
 “Velvet.”⁷⁸

§ 119. **Miscellaneous matters relating to infringement.**—In the cases of infringement it is manifest that the policy of the law is clear, and that difficulty in determining questions of infringement arises only out of the facts.

It was asked in the English House of Lords, “How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?”⁷⁹

68—*Ex parte* Keystone Chamois Co., 101 Off. Gaz. 3109.

69—Allen B. Wrisley Co. v. Buck, 95 Off. Gaz. 2483.

70—*Ex parte* Foley & Co., 87 Off. Gaz. 1957.

71—*Ex parte* Dr. Harter Med. Co., 106 Off. Gaz. 1779.

72—*Ex parte* Vogel & Son, 99 Off. Gaz. 2321.

73—*Ex parte* W. B. Belknap & Co., 105 Off. Gaz. 745.

74—*Ex parte* Sutton, 108 Off. Gaz. 291.

75—Wood v. Hinchman, 110 Off. Gaz. 600.

76—*Ex parte* Sodafoam Baking Powder Co., 96 Off. Gaz. 1239.

77—*Ex parte* Hutchins, 100 Off. Gaz. 1330.

78—*Ex parte* Willard Chem. Co., 107 Off. Gaz. 1972.

79—Lord Watson in Johnson v. Orr-Ewing, H. L. 7 App. Cas. 219.

Analogies will, however, frequently be found in the adjudicated cases which may assist in classifying the character of infringement under consideration.

Infringements which display the name or initials of the defendant are none the less infringements if any substantial portion of the mark is taken from the plaintiff's mark.⁸⁰ This principle has been applied to a case where the defendant had washed plaintiff's labels off his bottles, leaving only the marks blown or moulded in the glass, and had pasted his own labels upon the bottles,⁸¹ although in similar cases, where the name of the defendant was conspicuously displayed on the new label, injunction was refused.⁸² But the fact that the defendant does display his name upon his goods is always to be considered as a circumstance in his favor.⁸³

Infringement applied to goods of equal quality.—It is settled that the fact that the defendant's goods are equal in quality to the plaintiff's is no defense to the action of infringement. As said by Judge McLean: "To entitle a complainant to protection against a false representation it is not essential that the article should be inferior in quality."⁸⁴ And in an English case involving

80—Sawyer Crystal Blue Co. v. Hubbard, 32 Fed. Rep. 388; Anheuser-Busch Brewing Association v. Clarke, 26 Fed. Rep. 410; Garrett v. T. H. Garrett & Co., 24 C. C. A. 173, 78 Fed. Rep. 472; Anheuser-Busch Brewing Association v. Piza, 24 Fed. Rep. 149; Hostetter v. Adams, 10 Fed. Rep. 838; Pepper v. Labrot, 8 Fed. Rep. 29; Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707; McCann v. Anthony, 21 Mo. App. 83; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206.

81—Hostetter v. Anderson, 1 W. W. & A'B. Eq. 7; Seb. 652; Rose v. Loftus, 47 L. J. Ch. 576; 38 L.

T. N. S. 409; Seb. 608; Rose v. Henly, Seb. 551.

82—Welch v. Knott, 4 K. & J. 747; Barret v. Gomm, 74 L. T. (Journal) 388.

83—"This is one of the important means of identification." Severens, J., in Proctor & Gamble Co. v. Globe Refining Co., 34 C. C. A. 405, 92 Fed. Rep. 357-362. And see Kann v. Diamond Steel Co., 89 Fed. Rep. 706; P. Lorillard Co. v. Peper, 86 Fed. Rep. 956-959; Blackwell v. Crabb, 36 L. J. Ch. 504; Beard v. Turner, 13 L. T. N. S. 746.

84—Coffeen v. Brunton (2), 5 McLean, 256.

the manufacture of metallic hones, Lord Denman instructed the jury that "even if the defendant's hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendant."⁸⁵ It may be regarded as settled that it is immaterial, in the language of Judge Morris, whether the defendant's goods "be better or worse in quality."⁸⁶

§ 120. **The use of letters and numerals.**—The principle that there can be trademark rights in letters or numerals cannot be considered as finally settled. *Gillott v. Esterbrook*,⁸⁷ in which the defendant was enjoined from using the numerals "303," was for a time regarded as upholding their use as a trademark, but the case is known and recognized as a case of unfair competition.⁸⁸ The leading English case, *Ainsworth v. Walsmsley*, is very similar to *Gillott v. Esterbrook*, *supra*, in that while the imitation of a series of numbers was considered as one of the elements justifying injunction, Vice-Chancellor Wood carefully distinguished them as not being a technical trademark.⁸⁹ There is no case, however, in England in which the courts have recognized "a mere numeral or combination of numerals, standing alone, as sufficiently arbitrary and distinctive to constitute a trademark,"⁹⁰ and the United States Circuit of Appeals for the Sixth circuit has flatly held that a "bare numeral" cannot be trademark.⁹¹

85—*Blofield v. Payne*, 4 B. & Ad. 410; Seb. 50. See also *Taylor v. Carpenter* (2), 2 W. & M. 1; Cox, 32; *Taylor v. Carpenter* (3), 2 Sandf. Ch. 603; *Edelsten v. Edelsten*, 1 DeG. J. & S. 185; Seb. 213.

86—*Sawyer v. Horn*, 1 Fed. Rep. 24-38. To the same effect see *Cutter v. Gudebrod Bros. Co.*, 55 N. Y. Supp. 298.

87—47 Barb. 455; Cox, 340.

88—*Browne on Trademarks* (2d ed.), sec. 228.

89—*Ainsworth v. Walsmsley*, L. R. 1 Eq. 518-527.

90—*Sebastian on Trademarks* (4th ed.), p. 79.

91—*Dennison Mfg. Co. v. Scharff Tag, Label & Box Co.*, C. C. A. , 135 Fed. Rep. 625, 628.

Of course numerals may form a part of a trademark, in combination or collocation with words, figures or designs, and many cases in which their imitation has been restrained turned upon this point;⁹² they will also be protected when used in an arbitrary and distinctive manner which conveys no idea of number, although they would probably not be so used except in collocation with designs or words.⁹³ In one case it was held that a complainant was entitled to the exclusive use of a trademark consisting of the figures $\frac{1}{2}$, only in the form, size, color and style in which it had been registered and used.⁹⁴

The strongest case holding that numerals alone may form a valid technical trademark is *Shaw Stocking Co. v. Mack*,⁹⁵ in which Judge Coxe ably reviews the decisions and argues that the rejection of numerals as trademark was invariably because of their use indicating quality rather than origin or ownership; but he finally bases the reason of his decree of injunction flatly upon the defendant's fraudulent competition.

The practical difficulty in the way of constructing a trademark from numerals alone is that the defendant could always find a multiplicity of excuses for selecting the same numerals, and the cases indicate that the courts grant ample protection to their use as against their fraudulent imitation.⁹⁶

92—*Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Lawrence Mfg. Co. v. Lowell*, 129 Mass. 325; *Humphreys' Specific Med. Co. v. Wenz*, 14 Fed. Rep. 250; *Carver v. Pinto Leite*, L. R. 7 Ch. App. 90; *Robinson v. Finlay*, L. R. 9 Ch. D. 487; *Broadhurst v. Barlow*, W. N. 1872, p. 212; *Carver v. Bowker*, Seb. 581; *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417.

93—*Kinney v. Basch*, 16 Am. Law Reg. N. S. 596; Seb. 542—

properly a case of unfair competition.

94—*Kinney v. Allen*, 1 Hughes, 106; Seb. 557; Fed. Case No. 7826.

95—12 Fed. Rep. 707. See also to the same effect *Smith & Davis Mfg. Co. v. Smith*, 89 Fed. Rep. 486.

96—*Gillott v. Kettle*, 3 Duer 624; *American Solid Leather Button Co. v. Anthony*, 15 R. I. 338; *Collins v. Reynolds Card Mfg. Co.*, 7 Abb. N. C. 17; *India Rubber Comb Co. v. Jewelry Co.*, 45 N.

Even where numerals were originally indicative of origin and ownership, if they have come to be used to indicate quality, any one having the right to make or sell the article in connection wherewith such numerals are so used may designate the article by the numerals.⁹⁷

In regard to letters, standing alone or in initial combinations, the English courts have from an early period treated them as trademarks,⁹⁸ although it appears that under the English act of 1875, 38 and 39 Vict., c. 91, Vice-Chancellor Hall has held a single letter cannot be registered as a trademark.⁹⁹

The use of a single letter would appear to be at least unsafe, although it might in the United States be regarded as a trademark; and Judge Bradford in a recent opinion suggests that a single letter or figure may be "so peculiar and unusual in form or ornamentation" as to be a valid trademark.¹

Combinations of letters, used as initials, have been frequently approved as trademarks in the American decisions,² and in the case of *Amoskeag Mfg. Co. v. Trainer*,³ in the federal supreme court, the decision,

Y. Sup. Ct. 258; *Sohl v. Geisendorf*, 1 Wills. (Ind.) 60; *Hazard v. Caswell*, 57 How. Pr. 1; *Glen & Hall Mfg. Co. v. Hall*, 61 N. Y. 226; 19 Am. Rep. 278; Seb. 443; *Humphreys' Homoeopathic Medicine Co. v. Hilton*, 60 Fed. Rep. 756.

97—*Smith & Davis Mfg. Co. v. Smith*, 89 Fed. Rep. 486.

98—*Ransome v. Bentall*, 3 L. J. Ch. 161; *Motley v. Downman*, 3 My. & Cr. 1; *Millington v. Fox*, 3 My. & Cr. 338; *Crawshay v. Thompson*, 4 M. & G. 357; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Hopkins v. Hitchcock*, 14 C. B. N. S. 65; *Hall v. Barrows*, 4 DeG. J. & S. 150; *Barrows v. Pelsall*, Seb. 530; *Re Barrows*, L. R. 5 Ch. D.

353; *Cartier v. Carlile*, 31 Beav. 292; *Cartier v. Westhead*, Seb. 199; *Cartier v. May*, Seb. 200; *Moet v. Clybourn*, Seb. 533; *Moet v. Pickering*, L. R. 8 Ch. D. 372; *Ex parte Young*, Seb. 537; *Ransome v. Graham*, 51 L. J. Ch. 897; *Bondier v. Depatie*, 3 Dorion, 233; *Re Brook*, 26 W. R. 791.

99—*Re Mitchell*, L. R. 7 Ch. D. 36; 46 L. J. Ch. 876; 26 W. R. 326; *Cartmell*, 226.

1—*Dennison Mfg. Co. v. Thomas Mfg. Co.*, 94 Fed. Rep. 651-658.

2—*Geron v. Gartner*, 47 Fed. Rep. 467; *Frank v. Sleeper*, 150 Mass. 583.

3—101 U. S. 51.

which held the letters "A C A" were not a valid trademark, was based upon the theory that those letters as used by the complainant were indicative of quality, and not of origin or ownership, as Judge Coxe has pointed out.⁴ There can scarcely be a doubt that both numerals and letters of the alphabet may sometimes be technical trademarks, and the objection to their use in that capacity has been well stated by Judge Colt in the supreme court of Massachusetts to be "the difficulty of giving to bare numbers the effect of indicating origin or ownership, and of showing that the numbers used were originally designed for that purpose."⁵ And the same practical suggestion was offered by the supreme court of Connecticut in these words: "It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, and that they have had that effect, it may not be easy to assign a reason why they should not receive the same protection, as trademarks, as any other symbol or device."⁶

A review of the cases indicates that the use of numerals or letters has been restrained sometimes on the theory that they were technical trademarks, but never where they were merely used to indicate quality;⁷ and where injunction has issued, the facts show that the infringing figures or letters were used in fraudulent competition.⁸

4—*Shaw Stocking Co. v. Mack*, 12 Fed. Rep. 707.

5—*Lawrence Mfg. Co. v. Lowell*, 129 Mass. 325; *Price & Steuart*, 418.

6—*Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Cox*, 490.

7—*Re Eagle Pencil Co.*, 10 Off. Gaz. 981; *Amoskeag Co. v. Train-*

er, 101 U. S. 51; *Stevens Linen Works v. William & John Don & Co.*, 121 Fed. Rep. 171, affirmed, —C. C. A.—, 127 Fed. Rep. 950.

8—*Ransome v. Bentall*, 3 L. J. Ch. N. S. 161; *Gillott v. Kettle*, 3 Duer, 624; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Gillott v. Esterbrook*, 47 Barb. 455; *Cox*,

In this connection it is well to note that "there can be no doubt, and indeed it is not disputed, that two letters may constitute a trademark."⁹ So the American courts have uniformly held that monograms or groups of two or more letters not indicative of quality constitute valid trademarks; thus we find that the following marks have been held valid: "A. G." applied to cigars and coffee;¹⁰ "B. B. B." applied to a medicine;¹¹ "B. B. H." applied to iron;¹² "S. B." applied to cough-drops;¹³ "G. E." applied to electric lamps;¹⁴ "G. F." applied to velvet ribbon;¹⁵ "O. F. C." applied to whiskey;¹⁶ "A. C. A." applied to ticking;¹⁷ "J. H. W." applied to boots.¹⁸ And we find that similar groups of letters and monograms have been treated as valid by the English decisions.¹⁹

§ 121. **The judicial test of infringement.**—It may be said, generally, that the courts will apply to the facts, in the class of cases that we are considering, any and all tests which are necessary to determine whether or not the competition established by the defendant is fraudulent. In delivering the opinion of the federal supreme

340; 48 N. Y. 374; 8 Am. Rep. 553; *Broadhurst v. Barlow*, W. N. 1872, p. 212; *Seb.* 411; *Kinney v. Basch*, *Seb.* 542; *Avery v. Meikle*, 81 Ky. 75.

9—*Kinahan v. Bolton*, 15 Ir. Ch. 75.

10—*Godillot v. American Grocery Co.*, 71 Fed. Rep. 873.

11—*Foster v. Blood Balm Co.*, 77 Ga. 216; 3 S. E. Rep. 284.

12—*Hall v. Barrows*, 4 DeG. J. & S. 150.

13—*Burt v. Smith*, 71 Fed. Rep. 161.

14—*General Electric Co. v. Re-
new Lamp Co.*, 128 Fed. Rep. 154.

15—*Giron v. Gartner*, 47 Fed. Rep. 467.

16—*Geo. T. Stagg Co. v. Taylor*, 95 Ky. 651, 27 S. W. Rep. 247.

17—*Amoskeag Mfg. Co. v. Train-
er*, 101 U. S. 51 (dissent of Mr. Justice Clifford). To the same ef-
fect see *Burton v. Stratton*, 12
Fed. Rep. 696; *Smith v. Imus*, 32
Alb. L. J. 455; *Frank v. Sleeper*,
150 Mass. 583, 23 N. E. Rep. 213.

18—*Walker v. Reid*, Fed. Case
No. 17084.

19—*Hopkins v. Hitchcock*, 14 C.
B. N. S. 65; *Paul v. Barrows*, 4
DeG. J. & S. 150; *Re Barrows*, L.
R. 5 Ch. D. 353; *Cartier v. Car-
lile*, 31 Beavan, 292; *Moet v. Pick-
ering*, L. R. 8 Ch. D. 372; *Frankau
v. Pope*, 11 Cape of Good Hope,
209.

court in *Coats v. Merrick Thread Co.*, Mr. Justice Brown observed: "The differences are less conspicuous than the general resemblance between the two. At the same time, they are such as could not fail to impress themselves upon a person who examined them with a view to ascertain who was the real manufacturer of the thread."²⁰ And in all cases the court will inspect not only the differences but the resemblances, as both must be considered in ascertaining whether the competition between the parties is fair or fraudulent. As said by Judge Severens: "It has been said that it is the resemblances that should be looked at, rather than the differences. But the existence of the latter negatives the former, and it is necessary to take both into view, in order to get a correct picture of the whole."²¹

Of course the defendant cannot avail himself of dissimilarities which become apparent only upon comparison of the plaintiff's and defendant's packages or marks. This is because purchasers do not have the opportunity of making comparisons. "A specific article of approved excellence comes to be known by certain catchwords easily retained in memory, or by a certain picture which the eye readily recognizes. The purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect. He acts upon the moment. He is without the opportunity of comparison. It is only when the difference is so gross that no sensible man acting on the instant would be deceived, that it can be said that the purchaser ought not to be protected from imposition. Indeed, some cases have gone to the length of declaring that the purchaser has a right to be careless,²² and that his want of caution in inspecting brands of goods with which he supposes himself to be

20—*Coats v. Merrick Thread Globe Refining Co.*, 92 Fed. Rep. Co., 149 U. S. 562. 357-362, 34 C. C. A. 405.

21—*Proctor & Gamble Co. v.* 22—It has been held on circuit

familiar ought not to be allowed to uphold a simulation of a brand that is designed to work fraud upon the public. However that may be, the imitation need only be slight if it attaches to what is most salient; for the usual inattention of a purchaser renders a good will precarious, if exposed to imposition."²³

The foregoing extract very fully expresses the character of supervision over fairness in trade exercised by our courts of equity. When an article has become known by a catchword or a peculiar package, any one seeking to use that form of package, or a mark or name that suggests the catchword, must take care to keep within the bounds of fairness in trade in so doing.²⁴

Mere colorable distinctions, so arranged as to escape notice,²⁵ the use of labels which may be removed by retail dealers, leaving the imitated marks free to effect deception,²⁶ and all the other devices and schemes of fraudulent competition disclosed by the reports, are taken into consideration in determining the right to equitable relief. One of the most important tests is the existence of similarities of detail, whether of design, form, size, color or material. Relief will always be granted when "it is manifest from a comparison (of the

that the careless purchaser will not be protected. *N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.*, 88 Fed. Rep. 694; but the case was reversed on appeal: *s. c.*, 102 Fed. Rep. 327-332, 42 C. C. A. 376. The test generally applied is, whether one "in the use of ordinary care" can be deceived. *Sartor v. Smith, Iowa*, 101 N. W. Rep. 515.

23—*Jenkins, J., in Pillsbury v. Flour-Mills Co.*, 64 Fed. Rep. 841-847, 12 C. C. A. 432.

24—*Stuart v. F. G. Stewart Co.*, 91 Fed. Rep. 243, 33 C. C. A. 480. So the use of the

word "Iwanta" has been enjoined as being a fraud upon the owner of the trademark "Uneda," both words being applied to biscuit. *National Biscuit Co. v. Baker*, 95 Fed. Rep. 135. And so of the phrase "Candy Cathartic" used by the plaintiff with the word "Cascarets" and by the defendant with the word "Cascara." *Sterling Remedy Co. v. Gorey*, 110 Fed. Rep. 372-373.

25—*Taylor v. Taylor*, L. R. 2 Eq. 290; 23 L. J. Ch. 255.

26—*Barlow v. Johnson*, 7 R. P. C. 395.

two articles in controversy) that one was copied from the other.”²⁷ The court does not search for dissimilarities, but for points of resemblance.²⁸

“Where there are found strong resemblances, the natural inquiry for the court is, why do they exist? If no sufficient answer appears, the inference is that they exist for the purpose of misleading.”²⁹

No matter what minor differences may exist in the tests of infringement applied by various courts, it has been uniformly noted that the fact that purchasers have no opportunity of comparison must be considered, and the genuine and alleged infringing marks must be judged by the court, therefore, in the light of that fact.³⁰

27—Shipman, J., in *Dixon Crucible Co. v. Benham*, 4 Fed. Rep. 527-530.

28—*Hostetter v. Adams*, 10 Fed. Rep. 838-842. Thus Judge Lacombe, in considering conflicting liquor labels, said: “Inspection of the labels must carry conviction to any unbiased and unprejudiced mind that the later label was prepared by some one who had seen the earlier one, and that it was designed, not to differentiate the goods to which it was affixed, but to simulate a resemblance to complainant’s goods sufficiently strong to mislead the consumer, although containing variations sufficient to argue about should the designer be brought into court. This is the usual artifice of the unfair trader.” *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693. In another recent case the same court says: “There are as usual a number of minor differences between the form and the dress of the two packages, which are expatiated upon in the affidavits and the brief; but no

one can look at both packages without perceiving that there are strong resemblances, which could easily have been avoided had there been an honest effort to give defendants’ goods a distinctive dress.” *National Biscuit Co. v. Baker*, 95 Fed. Rep. 135.

In referring to conflicting labels, Judge Gilbert, in a recent decision, says “these differences are such as are usually introduced where the intention is to make an unfair use of an established trademark, and at the same time so far depart therefrom as to avoid the charge of infringement.” *Kosterling v. Seattle Brewing & Malt- ing Co.*, 54 C. C. A. 76, 116 Fed. Rep. 620.

29—*Lurton, J.*, in *Paris Medicine Co. v. W. H. Hill Co.*, 102 Fed. Rep. 148-151; 42 C. C. A. 227.

30—*Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841-847, 12 C. C. A., 432; *Manhattan Med. Co. v. Wood*, Fed. Case No. 9026, 4 Cliff, 461, 108 U. S. 218; *Alleghany Fertilizer Co. v.*

In conclusion it is important to bear in mind that courts of equity have always avoided laying down any hard and fast rules by which to determine what constitutes fraud. The reason for this absence of set rules has been well stated as follows: "Were courts of equity to once declare rules prescribing the limitations of their power in dealing with it, the jurisdiction would be perpetually cramped and eluded by new schemes which the fertility of man's invention would contrive."³¹

When one who has been lawfully advertising himself as agent for a particular article has his agency revoked, he may be enjoined from the use of the word "agency" even though he continues to deal in the same articles as before;³² and the agent may enjoin the use of a label naming him as the agent for the product.³³

§ 122. Restraint of use of misleading advertisements, and the like.—The requirement of fairness in trade has led to the injunction of the use of circulars containing garbled extracts from a letter, published for the purpose of diminishing plaintiff's sales, the part of the letter published having a meaning contrary to that of the letter as a whole.³⁴ The use of the autographic signature of the defendant's former distiller has been enjoined, when the distiller had withdrawn from defendant's employment and established a competing distillery.³⁵

Woodside, Fed. Case No. 206, 1 Fed. Rep. 172-174, affirmed under same title, 48 C. C. A. 67, 108 Fed. Rep. 839.
 Hughes, 115; Sawyer v. Kellogg, 7 Fed. Rep. 721; Sawyer v. Kellogg, 9 Fed. Rep. 601; Liggett & Myers Tob. Co. v. Hynes, 20 Fed. Rep. 883; Hostetter v. Adams, 10 Fed. Rep. 838-842.

33—Coleman v. Flavel, 40 Fed. Rep. 854.

34—Halstead v. Houston, 111 Fed. Rep. 376.

31—Weinstock, Lubin & Co. v. Marks, 109 Cal. 529-539.

35—George T. Staggs Co. v. Taylor, 95 Ky. 651, 27 S. W. Rep. 247.

32—Edison v. Hawthorne, 106

§ 123. **Infringement in another jurisdiction.**—Where goods bearing an infringing mark are in possession of the defendant, within the jurisdiction, though intended for exportation, the jurisdiction of the court is complete and relief will be granted.³⁶

But where the act of infringement occurs wholly in a foreign country an entirely different question is presented, and relief has been denied even though the court had jurisdiction over the parties, and the mark involved had been registered in the United States; Judge Kirkpatrick remarking that “to hold that the branding of goods in a foreign country with a trademark registered in the United States constitutes unfair competition in trade would be but another way of extending the trademark rights of a citizen of the United States beyond the borders of the country.”³⁷

124. Trademarks of variable sound and pronunciation.—The owner of a valid trademark is, under all the authorities, entitled to equitable protection against one who subsequently adopts a mark calculated to create confusion of the goods of the respective parties.

Thus the use of the mark “Iwanta” was enjoined by Judge Lacombe because it was expressive of the same idea as “Uneeda” previously applied to biscuit,³⁸ and in a later case, where the owner of the trademark “Yusea” sought to enjoin the use of the mark “U-C-A” Judge Hazel said:

“The controlling contention in this action is whether the complainant, having a prior and exclusive right to the designation ‘Yusea,’ has thereby also obtained an exclusive right to the use of the various pronunciations

36—Orr-Ewing v. Johnson, 13 C. D. 434, 7 A. C. 219.

37—Vacuum Oil Co. v. Eagle Oil Co., 122 Fed. Rep. 105.

38—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

and the complex words or syllabic formations to which this particular word is susceptible. A moment's reflection reveals the various pronunciations and composite words to which 'Yusea' may be adapted. A trademark which is variously pronounced and distorted to suit the purposes of trade and the fancies of the manufacturer in his endeavor to catch the public eye may yet be protected, within the fair and reasonable scope of a trademark, however artfully it may be conceived. It appears from the affidavits of complainant's manager and advertising agent, the person who conceived the word, that the common pronunciation by the trade in general is as if it were spelt 'You see a,' and that the mantles manufactured by complainant, are commonly known as 'You-see-a mantles.' This is accentuated by the ordinary pronunciations that follow a casual observation of this complex word. The unique alterations in the pronunciations of the word must, I think, be regarded as incidental to its use. This perhaps enhances its value as an advertising medium. They do not change the registered designation, and the word 'Yusea' remains the dominating word in the trademark. . . The trademark, because of its variable sound and pronunciation, became more prominently known to the public, and thereby served the purpose for which it was conceived; *i. e.*, to attract the attention of the public to the original conception.'³⁹

§ 125. The effect of a plurality of marks for a single article.—It would seem obvious that a trader might acquire and own as many trademarks as he desires. It would seem that he might, if he desired, have as many different trademarks for the same article of merchandise as he saw fit. It seems perfectly clear that a trade-

mark which is valuable because it attracts custom in one community may be utterly valueless in another.

The British decisions are replete with instances of special marks used for colonial trade, the same article being sold in Great Britain under a different mark. As a matter of fact many articles of merchandise are dealt in under a plurality of marks in this country, certain marks being used in the Northern trade, and different marks on the same merchandise for the Southern and Pacific Coast trade. It would seem that the courts would be as little concerned with the number of marks owned and used by a manufacturer as they would be with the number of patents or copyrights he might own or the number of any other chattels it might please him to acquire and for which he haply has the means to pay. And yet, these views which on their face appear manifestly obvious, are in conflict with the sole decision so far rendered upon this question and to which we will now briefly advert.

In *Candee v. Deere*,⁴⁰ the complainant manufactured "Moline" plows at Moline, Illinois. On different qualities of these plows they used the marks "A. No. 1," "A. X. No. 1," "No. 1," "X. No. 1," "No. 3," and "B. No. 1." The word "Moline" being geographical, the complainant's case failed, and the letters and numbers being merely descriptive of different qualities of the plow did not help the complainant's case.

This case consequently, appears quite irrelevant to the present question; but it has been used as the basis of the decision of Judge Jenkins dealing directly with the effect of ownership of a plurality of marks used on the same article, in which he says:

"The principal question which is suggested by the bill and the evidence is whether the manufacturer of a single

40—*Candee v. Deere*, 54 Ill. App. 439.

article has the right to use, and be protected in the use of, more than one trademark for that article. I find little authority upon the subject, and have given to the question much consideration. Upon principle, I think that he cannot. A trademark must denote origin. A trademark is defined by Mr. Upton to be the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise. Upton, Trademarks, p. 9, c. 1. How can that purpose be accomplished, if a manufacturer dealing in a single article used a thousand different trademarks to designate the article and its origin? Such use necessarily produces confusion, and fails of the single purpose of the trademark, to designate with certainty the origin of the product. Certainly no manufacturer would, in regard of self-interest, indulge in such a practice; for he would thereby defeat the very purpose he sought to accomplish. This consideration has led me to the conviction that the complainant, the originator of perforated rolled toilet paper, would not do that which would blind the public mind to the originator and manufacturer of the article, and would tend to dissipate its trade. It is more probable (and the evidence, I think, sustains the conclusion) that its design was, by the various names, to distinguish between the size, shape, and quality of the paper manufactured, and that the marks were not placed thereon as indicating origin. The only authority which I have been able to find passing directly upon this question is the case of *Candee v. Deere*, 54 Ill. 439, 457. In the conclusion reached by the supreme court of Illinois upon this particular question, I fully concur. It is remarkable that, with respect to so simple a product as that in

question, it should be found that so large a number of claimed trademarks should be used by one manufacturer. A court of equity cannot be impressed by an appeal to protect that which produces infinite confusion. It may be that in the struggle for trade the whims of retailers must be consulted, and that rivalry between dealers to present something attractive to the public eye must exist; but courts of equity do not sit to indulge the whims of purchasers, or to protect one in creating confusion. They sit to protect and to enforce legal and equitable rights. If this bill can be maintained, the extent of the proprietorship of the complainant in the use of arbitrary names applied to the subject of toilet paper would be limited only by the imagination of its officers.”⁴¹

§ 126. Confusion of mail matter as test of the right to injunction.—The fact that the use of the mails is involved in the majority of commercial transactions has made the question of the confusion of mail matter one of the tests most frequently applied in cases involving firm names, corporate names, and the like, to determine whether or not the plaintiff is entitled to the relief sought. Thus, we find in a case where the Continental Insurance Company of New York, sought to enjoin the Continental Fire Association of Texas from the use of its corporate name, Judge Meek gave as one of the principal grounds for denying the relief sought that “on account of the marked dissimilarity of the addresses of the two companies, mail matter intended for one of them will hardly be misdirected or miscarried to the other.”⁴² In a more recent case Judge Kohlsaat, in enjoining the name “Liliputian Outfitters” at the instance of a com-

41—Albany Perforated Wrapping Paper Co. v. John Hoberg Co., 102 Fed. Rep. 157, 158.

42—Continental Insurance Co. v. Continental Fire Assn., 96 Fed. Rep. 846, 849.

plainant doing business as the "Liliputian Bazaar," based the right to relief upon the probable confusion of mail matter, says, "It is evident that complainant is a manufacturer and dealer, and that he does a large mail-order business, as does also defendant. It hardly needs saying that the proficiency of the mails at this date is such that every nook and corner of the nation as well as of Manitoba is as accessible as were places 50 miles away from New York a few years ago. It cannot be otherwise than that the advertising and canvassing of these two rival concerns pass and repass each other innumerable times in their journeys to the centers of trade as well as to the homes of the people—mute contestants for the favor of supplying the wants of each customer."⁴³

In a New York case, a plaintiff who was the originator of a proprietary remedy sold to the defendant his business and good-will, including the sole right to use the names "Dr. David Kennedy, of Rondout, N. Y.," and "Dr. D. Kennedy, of Rondout, N. Y." It was subsequently held that the defendant had the right to receive and open all letters addressed to the plaintiff by either of the forms of addresses named.⁴⁴

In a subsequent suit, the plaintiff sought to enjoin the defendant from receiving and opening letters addressed to him by name at Kingston, N. Y. In granting the injunction, Betts, J., said: "It ought to be an extremely difficult matter for one person or corporation to obtain the right to open and examine another person's private correspondence without his consent. There is something so repugnant in such a proposition to all our ideas of common fairness that to simply state it is to

43—Ball v. Best, 135 Fed. Rep. 434, 437.

44—Kennedy Corp. v. Kennedy, 55 N. Y. Supp. 917.

arouse antagonism thereto. I am of the opinion that this can never become the settled law of this state in any case unless it clearly and unequivocally appears that both parties at the time of making any contract, agreement, or bill of sale relating thereto clearly understood and agreed that that was to be the result of the arrangement entered into.”⁴⁵

“In *American Clay Mfg. Co. of Pennsylvania v. American Clay Mfg. Co. of New Jersey*, 198 Pa. 189, 47 Atl. 936, the plaintiff was a Pennsylvania corporation, and the defendant a corporation of New Jersey authorized to do business in Pennsylvania. Both were engaged in the same line of trade at Pittsburg, and the result was a confusion in correspondence and in the drawing and honoring of checks and drafts; and the defendants were enjoined. ‘There are two classes of cases,’ says Mitchell, J., ‘involving judicial interference with the use of names: First, where the intent is to get an unfair and fraudulent share of another’s business; and, second, where the effect of defendant’s action, irrespective of his intent, is to produce confusion in the public mind, and consequent loss to the complainant. In both cases the courts of equity administer equitable relief.’ ”⁴⁶

§ 127. **Hotel names and rights created thereby.**—As we have seen elsewhere, as a general rule, the name of a place of business will be protected as against competitors who adopt misleading signs or other advertising matter in order to divert to themselves the business established by the one first adopting the name. It is apparent that there is this distinction between the names of hotels and the names of other places of business; as to

⁴⁵—*Kennedy v. Dr. David Kennedy Corp.*, 66 N. Y. Supp. 225-229.

⁴⁶—*Archbald, J., in Van Houten v. Hooton Cocoa & Chocolate Co.*, 130 Fed. Rep. 600, 603.

other commercial enterprises there may be unfair competition between places of business located in different cities or sections, and doing a mail-order business, or transacting business generally by mail, while as to hotels, no such unfair competition can arise because there can be no confusion created by two hotels in different cities, having the same name. The names of hotels, moreover, stand in a class by themselves because of the complex character of the business involved. In one of the early cases, Campbell, J., in a case involved in the name "Irving House," drew this distinction in the following words: "We think that the principle of the rule is the same, to whatever subject it may be applied, and that a party will be protected in the use of a name, which he has appropriated, and by his skill made valuable, whether the same is upon articles of personal property which he may manufacture, or applied to an hotel where he has built up a prosperous business. . . . To make the application, if one man has, by close attention to the comfort of his guests, and by superior energy, made his hotel desirable for the traveler, and caused its name to become popular throughout the land, another man ought not to be permitted to assume the same name in the same town, and thus deprive him who first appropriated the name of some portion of the fruits of that goodwill which honestly belongs to him alone."⁴⁷ Under this doctrine, the hotel names "Columbia,"⁴⁸ "McCardel House,"⁴⁹ "Osborne House,"⁵⁰ "Vonderbank Hotel,"⁵¹ "What Cheer,"⁵² and "Woods Hotel,"⁵³ have been recognized and protected in equity.

47—Howard v. Henriques, 3 Sandf. 725.

48—Whitfield v. Loveless, 64 Off. Gaz. 442.

49—McCardel v. Peck, 28 How. Pr. 120.

50—Hudson v. Osborne, 21 L. T. N. S. 286.

51—Vonderbank v. Schmidt, 44 La. Ann. 264.

52—Woodward v. Lazar, 21 Cal. 449.

53—Woods v. Sands, Fed. Case No. 17,963.

The owners of hotels have further been protected by injunction against the unauthorized use of the name of the hotel by persons running carriages and other conveyances for the transportation of travelers. Thus the proprietor of the Irving Hotel was granted an injunction against the use of the name of the hotel by the defendant upon his coaches, and upon badges worn by his employees. In granting the injunction, Cantel, J., said, "The question is, whether the defendants have committed a fraud. I cannot doubt that their intention was to mislead, and to induce travelers to believe that they were servants of the proprietor of the Irving Hotel."⁵⁴ A similar rule was made in favor of the lessee of the "Revere House" under practically the same circumstances.⁵⁵

More recently, the supreme court of New York granted an injunction to restrain the use of the name of the "Holland House" as a trademark for cigars. At the time that the cigars so marked were placed upon the market, there was no hotel of the name open for business in the city of New York. The plaintiffs were the proprietors of a building in the course of construction, which was to be used for hotel purposes, however, and that building was well known throughout the city of New York as the "Holland House." The injunction was granted upon the ground that the defendant intended to falsely represent to the public that the cigars were in some way connected with the hotel known as the "Holland House."⁵⁶

54—Stone v. Carlan, Cox, Case No. 104.

56—Kingsley v. Jacoby, 20 N. Y. Supp. 44.

55—Marsh v. Billings, 7 Cush. 322.

CHAPTER IX.

REGISTRATION.

§ 128. **Introductory.**—The English Patents, Designs and Trademarks Act, 1883-1888, provides that there can be no institution of proceedings to prevent or to recover damages for the infringement of a trademark capable of registration unless it has been registered.¹ This provision does not occur in the acts of congress of 1881 or 1905, and could have no force or effect if it did, as there can be no valid trademark legislation by congress except under and by virtue of the commerce clause of the federal constitution (clause 3 of sec. VIII). As stated by Mr. Justice Miller: “When, therefore, congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several states, or with the Indian tribes. If not so limited, it is in excess of the power of congress.”²

§ 129. **The invalid registration acts.**—In order to obtain a substantial idea of the difficulties which have attended our national legislation upon trademarks, it is only necessary to read the text of the several enactments of congress, which are collated in the appendix to this book. The act of July 8, 1870, was based upon an entire misconception or disregard of the power resident in congress. Both it and the subsequent penal act of August 14, 1876, were framed with the evident intention of pro-

1—46 and 47 Vict., c. 57, sec. 77; *Hazzopulo v. Kaufmann*, 23 Sol. J. 819; *Goodfellow v. Prince*, L. R. 35 Ch. D. 9. 2—Trademark Cases, 100 U. S. 82.

viding a uniform trademark law for the several states. As will be seen by reference to the annotations to those acts, in the appendix, their validity was questioned and negatived upon circuit,³ and it was finally settled by the supreme court that they were unconstitutional and therefore void.⁴

§ 130. The power of congress to protect trademarks.—

“The commerce clause of the federal constitution presents the remarkable instance of a national power which was comparatively unimportant for eighty years, and which in the last thirty years has been so developed that it is now, in its nationalizing tendency, perhaps the most important and conspicuous power possessed by the federal government.”⁵

With the judicial determination that the act of July 8, 1870, was void, came the realization by congress that within the scope of authority contained in the words “The congress shall have power . . . to regulate commerce with foreign nations, and among the several states, and with the Indian tribes,” must rest the foundation for its future trademark legislation. With this fact before it, congress proceeded to the enactment of the act of March 3, 1881, embodied in the supplement to the Revised Statutes as section 322. No reason appears for the fact that under that act protection and the benefits of registration were extended only to “owners of trademarks used in commerce with foreign nations or with the Indian tribes,” and not to owners of trademarks used in interstate commerce. But such is the fact, which it was left to future legislation to remedy.⁶

3—*Leidersdorf v. Flint*, 8 Biss. 327.

4—*Trademark Cases*, 100 U. S. 82.

5—*Prentice & Egan*, Commerce Clause of the Federal Constitution, p. 1.

6—“The laws of the United

States now in force . . . relate only to trademarks specially used in commerce with foreign nations, or with the Indian tribes. Act of March 3, 1881 (21 St. at Large, ch. 137, sec. 1). They are particularly restricted so as not to give cognizance to any court of

§ 131. **The constitutionality of the present registration act.**—It is a remarkable fact that during the period from March 3, 1881, to February 20, 1905, the question of the constitutionality of the act of 1881 was never passed upon by any court.

The Court of Appeals of the 7th Circuit, speaking by Judge Jenkins, held that the validity of the act of 1881 was “fairly doubtful.”⁷

In the same case, the United States Supreme Court expressly declined to pass upon the question of constitutionality.⁸

So the act of 1881, more limited in its scope, and essentially a mere registration act, has been superseded by an act of much wider scope, while as yet the power of congress to create any enactment whatever relative to the registration of trademarks is not only undetermined, but clouded by the doubt expressed in the language of the Court of Appeals of the 7th Circuit. The labor performed by that court in the development of the law of unfair competition entitles its dictum to high respect; and because of the doubt which that court has seen fit to express, as well as the likelihood that the broad scope of the present trademark act will cause its constitutionality to be determined at no distant date, it may be well to note the argument which suggests itself as that which must be overcome if the present act is to be held constitutional.

It being conceded that the jurisdiction of congress over the subject of trademarks, if it has any at all,

the United States in an action or suit between citizens of the same state, unless the trademark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.” Wheeler, J., in *Luyties v. Hollender*, 21 Fed. Rep. 281.

7—*Illinois Watch Case Co. v. Elgin National Watch Co.*, 94 Fed. Rep., 667-669, 87 Off. Gaz., 2323, 35 C. C. A. 237.

8—*Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S., 665-667. And see *Warner v. Searle & Hereth Co.*, 191 U. S., 195-205.

aside from the treaty-making power, arises solely by authority of the commerce clause of the federal constitution, it is urged that unless trademarks themselves are the subjects of interstate commerce, the jurisdiction of congress fails.

A trademark, as we have seen elsewhere, is an incorporeal hereditament, having no independent life or existence of its own, but existing only as appendant to the good-will of a business, or as an integral part of that good-will. When the trademark is applied to an article of commerce, that article may be the subject of interstate commerce, but it by no means follows that the trademark affixed upon the article, or the package containing the article, is itself being dealt with as a subject of interstate traffic. This distinction, it has been urged, is amply supported by the language of the supreme court in *Champion v. Ames*, 188 U. S., 321, where it is said that "*Lottery tickets are subjects of traffic, and therefore of commerce.*"

The status thus fixed upon lottery tickets as the subjects of interstate commerce is curiously distinguished from policies of fire and marine insurance by the supreme court; but the language which that tribunal has more than once employed in reference to insurance policies is instructive as indicating its probable attitude toward trademarks. Thus in one of the later insurance cases, Mr. Justice McKenna says: "The contract of insurance is not an instrumentality of commerce. The making of such a contract is a mere incident of commercial intercourse."⁹

The distinction between lottery tickets and insurance policies is one which has not only baffled the layman, but aroused much discussion between members of the bar; but in the language of the supreme court in the lottery cases, and in the insurance cases, the court has uni-

9—New York Life Insurance Co. v. Cravens, 178 U. S., 389-401.

formly held that nothing which is not an instrumentality of commerce can come within the purview of the interstate commerce clause of the constitution.

In *Williams v. Fears*, 179 U. S., 270, Mr. Chief Justice Fuller has emphasized "the difference between interstate commerce or an instrumentality thereof on the one side, and the mere incidents which may attend the carrying on of such commerce on the other."

It would seem clear that the sharpest attack upon the constitutionality of the present act would be along the line of the cases referred to, and if the court determined as a matter of fact, that trademarks were mere incidents attending the carrying on of interstate commerce, it would necessarily follow that the present act, as well as its predecessor, has been founded upon a misconception of the jurisdiction of congress. Without weighing the argument, or pursuing it in the light of other decisions of the supreme court, such as those which relate to bills of lading and the like, and without venturing a personal opinion upon the merits of the argument, it will suffice to say that the present act is of extremely doubtful constitutionality, and that section 17, giving jurisdiction to certain courts over trademarks registered in accordance with the provisions of the act, without regard to the amount in controversy (a provision incorporated from section 7 of the act of 1881) offers the opportunity of readily raising the constitutional question. It is manifestly desirable that the question should be raised and finally disposed of in the near future, that it may be definitely settled.

This argument is substantially embodied in the report of the Committee on the Judiciary of the House of Representatives during the Forty-sixth Congress, as a result of the deliberations of that committee upon a resolution to amend the constitution, and a proposed bill for which the act of 1881 was subsequently substituted. The proposed amendment to the constitution is embodied

in the committee's report, a portion of which is as follows: "The bill seeks to re-enact substantially the trademark legislation of 1870 (Rev. Stat., sec. 4937-4947, inclusive) save that it is confined to foreign and interstate commerce. Its theory is that by thus separating them from interstate commerce the objections of the supreme court as to constitutionality will be removed.

"The resolution to amend the constitution is as follows:

ARTICLE XVI.

"Section 1. Congress for promotion of trade and manufacture, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trademarks.

"It is based upon the idea that such legislation, though confined to foreign and interstate commerce, is unconstitutional, or its advocates may only fear that that may be so, and wish the amendment *ex abundante cautela*, and to give confidence to those using trademarks.

"If the Congress of the United States now has power to pass such laws, the amendment would be useless. Has it that power?

"After careful consideration we are of opinion that it has not. The supreme court in the foregoing opinion avoided deciding that question. A trademark is a convenience of commerce. Its purpose is to identify the thing to be sold.

"But is no more than the guaranty in writing, or by some words, sign, or device, attached to the thing to be sold, that it is what the seller represents it to be by such writing, etc. By themselves they are not merchandise. Their only use is to attach to merchandise for such identification. They are not necessary to commerce. On the countless things sold in this country, foreign and domestic, there are no trademarks but on about 8,000.

"In *Paul v. Virginia* (8 Wallace) the court held that congressional control did not cover policies of insurance

sent from one state of the Union into another where a premium was paid therefor. They said the policies were but 'mere contracts of indemnity against loss by fire.' We think trademarks mere contracts of indemnity against loss by fraud.

"Thus the supreme court has held a contract to be within federal control in *Almy v. California*. That was a bill of lading for goods to be shipped out of the state. But that decision rested solely upon the ground that 'a bill of lading or some other instrument of the same import is necessarily always associated with every shipment of articles of commerce from the ports of one country to another. The necessities of commerce require it.' (See *Almy v. California*, 24 Howard, 170.) And that decision rests not on the power of congress over commerce, but on the prohibition against the states taxing exports, etc. The bill of lading was but evidence of the contract of shipping. Taxing it taxed the exported article. And in the *Pennsylvania Telegraph Company v. Western Union Telegraph Company* (96 U. S. 9) the court pronounced the telegraph 'one of the necessities of commerce. It is indispensable as a means of intercommunication, but especially so in commercial transactions.' We think this last case could better stand on the power 'to establish postoffices and postroads.' Yet, if put on the commerce clause, like *Almy v. California*, it is based on the necessity of the thing legislated upon to foreign or interstate or Indian commerce. As we have said, trademarks are not necessary to such commerce. But even if they were, our opinion would be unchanged. In the case of Steffens, quoted above, the court said:

" 'It is not every species of property, which is the subject of commerce, or which is used or even essential in commerce, which is brought by this clause of the Constitution (commerce clause) within the control of congress. The barrels and casks, the bottles and boxes in which

alone certain articles of commerce are kept for safety, and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of congressional legislation more than other property.'

"But while we think congress can not so legislate with regard to trademarks under the power 'to regulate commerce with foreign nations, and among the several states and with the Indian tribes' (article 1, section 8, constitution), trademarks, in commerce with foreign nations and with the Indian tribes, can be protected under the treaty-making power.'¹⁰

It therefore appears that the Act of 1881 was passed on the theory that it came within the treaty-making powers of congress. The present act cannot be sustained upon that theory; it must be sustained, if at all, as a regulation of interstate commerce.

§ 132. The advantages of registration.—The local registration statutes of the several states are too numerous and involved to be treated here.¹¹ The federal courts cannot enforce rights created by state registration, at least as to alleged infringements occurring outside the state in which registration was had.¹²

As to federal registration, Judge Hawley has said that "registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark, or in cases where it is necessary to give jurisdiction to the United States courts."¹³ As against a citizen of the same state, a registrant under that act

10—Con. Record, Vol. 10, part 2, p. 1514.

11—See Appendix H.

12—Rehbein v. Weaver, 133 Fed. Rep. 607.

13—Hennessy v. Braunschweiler & Co., 89 Fed. Rep. 664-668. Quoted

and followed in Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co., 85 Off. Gaz. 1905. To the same effect see Einstein v. Sawhill, 65 Off. Gaz. 1918; Sherwood v. Horton, Cato & Co., 84 Off. Gaz. 2018.

had not even the right to sue in a court of the United States, unless it can be shown that both the original and infringing marks are being used in commerce with foreign nations or the Indian tribes.¹⁴

The certificate of registration is only *prima facie* evidence of ownership of the trademark registered, and is not conclusive or binding upon the courts as to the right of a party to its exclusive use.¹⁵

No right is created by the registration of a generic name,¹⁶ nor by the registration of a mark unrestricted as to form or color, as "a color streak applied to or woven in a wire rope."¹⁷

The certificate of registration is only *prima facie* evidence of an admission on the part of the government that the applicant for registration is the owner of a valid trademark, is not a grant of any right or privilege, and does not, therefore, conclude a third party;¹⁸ but it is conclusive as against the registrant, as limiting and

14—Ryder v. Holt, 128 U. S. 525; Luyties v. Hollender, 22 Blatchf. 413; Schumacher v. Schwenke, 26 Fed. Rep. 816; Gravely v. Gravely, 42 Fed. Rep. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed. Rep. 493.

15—Hennessy v. Braunschweiger, *supra*; Brower v. Boulton, 53 Fed. Rep. 389; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 824-826.

In the latter case Judge Wallace observed: "The act of congress makes the registration of the mark only *prima facie* evidence of ownership. Sec. 7. The inquiry is therefore always open as to the validity of the title to a trademark evidenced by the registration. The registration could not confer a title to the trademark upon the complainant if some oth-

er corporation or individual had acquired a prior right by adoption and use; nor could it vest defendant with a title as against the complainant's common-law title. In this view the only office of a registration is to confer jurisdiction upon the court to protect a trademark when the proprietor has obtained the statutory evidence of title, and the only function of the commissioner of patents is to determine whether an applicant has a presumptive right to the trademark."

16—Liebig's Extract of Meat Co. v. Walker, 115 Fed. Rep. 822-826.

17—A Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 134 Fed. Rep. 571, C. C. A.

18—United States v. Braun, 39 Fed. Rep. 775.

restricting what he can claim as his trademark.¹⁹ Notwithstanding its registration under the act, the trademark of an insolvent will be conveyed by a general assignment for the benefit of creditors,²⁰ and it has been held under all the various bankruptcy and insolvency laws that all trademarks of the bankrupt or insolvent pass to the trustee or assignee.²¹

§ 133. The disadvantages of registration.—As indicated in the preceding section, registration under the act was held to “operate as evidence tending to show what was really claimed.”²² Judge Acheson has said “it would be a perversion of the right to registration under the act of congress, * * * and would amount to a fraud on other traders, to permit the plaintiff now to assert broader rights in the anchor as a trade symbol than his public registry in 1885 disclosed. * * * Section 10 gives no countenance to the idea that a person, availing himself of the benefits of the act, may register as his trademark a peculiar representation of a common emblem, exhibiting special and distinguishing features and a particular combination, and yet afterwards claim the emblem pure and simple, without regard to such features or combination. To tolerate this would be to defeat the very purpose of the act.”²³

In a later case, Judge Adams held that by failing to include the letter S as part of a registered mark, the

19—Kohler Mfg. Co. v. Beeshore (2), 59 Fed. Rep. 572; Richter v. Reynolds, 59 Fed. Rep. 577; 8 C. C. A. 220; Adams v. Heisel, 31 Fed. Rep. 279, 281; Kohler Mfg. Co. v. Beeshore (1), 53 Fed. Rep. 262, 264; Richter v. Anchor Remedy Co., 52 Fed. Rep. 455; Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637.

20—Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624.

21—Warren v. Warren Thread Co., 134 Mass. 247; Wilmer v. Thomas, 74 Md. 485, 22 Atl. Rep. 403.

22—Shiras, Circuit Justice, in Kohler Mfg. Co. v. Beeshore, 8 C. C. A. 215, 59 Fed. Rep. 572, 576.

23—Richter v. Anchor Remedy Co., 52 Fed. Rep. 455, 458; affirmed under the style of Richter v. Reynolds, 8 C. C. A. 220, 59 Fed. Rep. 577.

registrant "must be held to have abandoned this feature of its mark, if it had ever employed it, to the public, and thereby, to have disclaimed any exclusive right to it;"²⁴ and a similar ruling has been made by the Court of Appeals of Kentucky.²⁵ Judge Reed has very properly held that where certain parts of the mark shown and described in a registration are recited to be essential, the other parts will be held not to be part of the trademark.²⁶ It is consequently well established that registry of less than the whole trademark is tantamount to an abandonment of the remainder.²⁷

By § 28 of the Act of 1905 it is provided, "That it shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trademark, or from its manner of attachment to the article to which it is appropriated, this cannot be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice."

This section is directly modeled upon the corresponding section of the patent statutes, which is as follows:

§ 4900. "It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "pat-

24—Pittsburg Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637, 638. 26—L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624, 625.

25—Geo. T. Staggs Co. v. Taylor, 95 Ky. 651, 27 S. W. Rep. 247. 27—P. C. Weist Co. v. Weeks, 177 Pa. 412, 35 Atl. Rep. 693.

ented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented."

Under the latter section, Mr. Justice Gray has said "one of these two things, marking the articles, or notice to the infringers, is made by the statute a prerequisite to the patentee's right to recover damages against them.

Each is an affirmative fact, and is something to be done by him. * * * By the elementary principles of pleading, therefore, the duty of alleging, and the burden of proving either of these facts is upon the plaintiff."²⁸

Therefore, by registration under the Act of 1905, the registrant has this burden imposed upon him.

§ 134. **Interferences.**—The rules established by the decisions of the patent office in relation to interferences under the Act of 1881 are of value in like proceedings under the present Act. Section 3 of the Act of 1881 provided that "In an application for registration the commissioner of patents shall decide the presumptive lawfulness of claim to the alleged trademark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

§ 135. **Between a registrant and an applicant,** the burden of proof is on the applicant, for the reason that the certificate under § 7 of the act is *prima facie* evidence

28—Dunlap v. Schofield, 152 U. S. 244, 248, 38 L. Ed. 426, 427.

of ownership.²⁹ In such a case, Allen, commissioner, has held that the applicant must establish "a date of use in the United States prior to the date of the other party's registration,"³⁰ and that registration by the applicant under the Act of 1870 "amounts to nothing more than a publication."³¹

§ 136. **The preliminary statement.**—In patent interferences a formal preliminary statement is required from each of the parties. In trademark interferences the statement accompanying the application for registration performs the same functions and is treated as a preliminary statement.

The rule of the patent office in relation thereto formerly provided that each applicant and registrant would be held to the date of adoption alleged in the statement filed with his application. But even under that rule Duell, commissioner, held that evidence of use antedating that set up in the application of the party offering it may be considered and such weight given to it as "may be proper under the circumstances of the case."³² Subsequently, on an application for leave to file an amended statement, Allen, commissioner, in denying the application held that an amendment could be filed after the determination of the question of priority.³³

Manifestly, however, evidence offered to prove a date earlier than that set up in the statement must be regarded with some suspicion. In the language of Allen, commissioner, "it is to be presumed that this statement filed with the application for registration was made after proper inquiry, and while it is not binding upon the par-

29—*Sherwood v. Horton*, Cato & Co., 84 Off. Gaz. 2019; *Sibley Soap Co. v. Lambert Pharmacal Co.*, 103 Off. Gaz. 2172.

30—*Broderick & Bascom Rope Co. v. A. Leschen & Sons Rope Co.*, 100 Off. Gaz. 3011.

31—*Auerbach & Sons v. Hall & Hayward Co.*, 111 Off. Gaz. 806.

32—*Manitowoc Mfg. Co. v. Dickerman*, 57 Off. Gaz. 1721.

33—*Vanden Bergh & Co. v. Belmont Distilling Co.*, 99 Off. Gaz. 1624.

ties to an interference proceeding it is still entitled to considerable weight.³⁴

§ 137. **The issues in an interference.**—The purpose of an interference is to determine the question of priority of adoption and use as between the parties to the interference. Evidence of prior use by a stranger to the interference will not be considered.³⁵

An interference in fact exists where the marks are so similar as to be calculated to deceive the public, and are used upon classes of goods so closely related that when bearing the same mark one would suppose that they are the product of the same manufacturer.³⁶

34—Ibid.

36—B. A. Corbin & Son v. Mil-

35—Carey v. New Home Sewing Machine Co., 101 Off. Gaz. 448.

ler, Kohlhepp, Griesse & Co., 98 Off. Gaz. 1485.

CHAPTER X.

COURTS, PARTIES AND CAUSES.

§ 138. **Introductory.**—In the preceding chapters we have discussed the rights of owners or assignees of trademarks, and the wrongs occurring when these rights are infringed, or, as against persons not the owners of technical trademarks, other methods of unfair competition are resorted to. The remainder of this work will deal with the means by which infringers are restrained from a continuance of their wrongdoing and forced to make reparation for the damage they have occasioned. In this chapter we will confine our attention to the courts whose power may be invoked, the parties who may seek a remedy or against whom it may be sought, and the causes of action which may properly be brought to determine the rights of both parties.

§ 139. **Jurisdiction of United States circuit courts.**—Section 7 of the Act of 1881 provides that courts of the United States shall have original and appellate jurisdiction in cases involving a registered trademark, without regard to the amount in controversy. It has been held in this connection (prior to the statutes of 1887 and 1888, which raised the “amount in controversy” necessary to federal jurisdiction from \$500 to \$2,000) that the federal courts were not limited in their trademark jurisdiction to cases in which the defendant’s profits had exceeded five hundred dollars.¹ And a later decision has held that “The statute of 1881, which gives them (*i. e.*, owners of registered trademarks) the right to commence a suit without alleging the amount in controversy, was not

1—*Symonds v. Greene*, 28 Fed. Rep. 834.

repealed by the statutes of 1887 and 1888, which make it necessary, in order to give jurisdiction to the United States Circuit Court, that the amount involved be two thousand dollars.'"²

In cases where there is diverse citizenship it does not appear to be necessary to allege that the plaintiff uses his trademark on goods intended for commerce with foreign nations or with the Indian tribes; but it has been held that the federal courts have no jurisdiction in a trademark action between citizens of the same state unless the pleadings affirmatively show that the complainant uses his trademark on goods intended for commerce with foreign nations or with the Indian tribes.³ It was necessary, under the Act of 1881, where both parties are citizens of the same state, to aver that the defendant has applied the simulated mark to goods intended to be used in such foreign commerce, or trade with the Indian tribes,⁴ although the reasoning of one of the cases tended to show that logically no such averment in the pleadings is necessary.⁵ It is not necessary to show that either party has used the mark in commerce with foreign nations or with the Indian tribes where the parties are of diverse citizenship.⁶

Of course, in cases involving the right to an unregistered trademark, jurisdiction can only be acquired by the federal courts because of the diverse citizenship of the parties,⁷ and the amount in controversy, which must

2—*Glottin v. Oswald*, 65 Fed. Rep. Gaz. 1538; 42 Fed. Rep. 265; *Warner v. Garland & Ralston*, Federal Practice, sec. 122; *Hennessy v. Herrmann*, 89 Fed. Rep. 669.

3—*Ryder v. Holt*, 128 U. S. 525; *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 823; *Gravely v. Gravely*, 52 Off. Gaz. 1538; 42 Fed. Rep. 265; *Schumacher v. Schwenke*, 26 Fed. Rep. 818; *Luyties v. Hollender*, 27 Blatchf. 413.

4—*Gravely v. Gravely*, 52 Off.

5—*Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 823.

6—*Hennessy v. Braunschweiger & Co.*, 89 Fed. Rep. 664.

7—*Battle v. Finlay*, 50 Fed. Rep. 106; *Burt v. Smith*, 71 Fed. Rep. 161; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493.

be over \$2,000 exclusive of interest and costs; as to trademarks, their jurisdiction is concurrent with that of the state courts. By virtue of the act of congress of March 3, 1887, ch. 373, as corrected by the act of August 13, 1888, ch. 866, suit cannot be brought against a corporation for infringement of a trademark except in the district where it is incorporated.⁸

Where a bill was brought to restrain infringement of a registered trademark and to restrain the defendants from unfair competition in simulating the form, size, color and shape of cough-drops manufactured by the complainants (both parties being citizens of the same state), the United States Circuit Court of Appeals for the Second Circuit held that the fact that the trademark had not been infringed deprived the circuit court of jurisdiction, and that court had therefore erred in granting an injunction to restrain the unfair competition complained of.⁹

In a suit for injunction the "amount in controversy" is the value of the object to be gained by the bill, and not the amount of damages already suffered by the complainant.¹⁰ In actions for infringement of trademark or for unfair competition, therefore, the amount of profits sought to be recovered does not determine this jurisdictional question. In trademark cases it is the value of the trademark that determines and fixes the "amount in controversy."¹¹

In a suit for the protection of a tradename, not a trademark, from unfair competition, "it is the value of

8—*Re Keasbey & Mattison Co.*, ed.), sec. 16. Citing *Mississippi & Mo. R. R. Co. v. Ward*, 2 Black, 485; *Market Co. v. Hoffman*, 101 U. S. 112; *Symonds v. Greene*, 28 Fed. Rep. 834; *Whitman v. Hubbell*, 30 Fed. Rep. 81.

9—*Burt v. Smith*, 71 Fed. Rep. 161. To the same effect see *Goldstein v. Whelan*, 62 Fed. Rep. 124; *Luyties v. Hollender*, 30 Fed. Rep. 632.

10—*Foster*, Federal Practice (2d

11—*Symonds v. Greene*, 28 Fed. Rep. 834; *Hennessy v. Hermann*, 89 Fed. Rep. 669.

that name, as measured by the damages to it, not only present but prospective, which determines the amount in controversy.¹²

This must be specifically pleaded, because "the requisite value of the matter in controversy is a jurisdictional fact, and it must necessarily be averred in the declaration or bill. There are no presumptions in favor of the jurisdiction of the federal courts, as they are specially constituted with jurisdiction in certain cases; and the facts upon which it rests must appear in some form in the record of all suits prosecuted before them. They have no jurisdiction except such as the statute confers."¹³

Thus where a tradename (not a technical trademark) is alleged to be of a certain value, but there is no averment that the defendant's acts will, unless restrained, tend to destroy it or put its value in jeopardy, the bill is demurrable.¹⁴

When the parties are citizens of different states, so that the case comes within the general grant of jurisdiction in the first part of the act of March 3, 1887, the defendant, by entering a general appearance in a suit brought against him in a district of which he is not an

12—Archibald, J., in *Draper v. Skerrett* (2), 116 Fed. Rep. 206, 207.

13—Garland & Ralston, *Federal Practice*, sec. 122.

14—"The durmurrer raises also a question of jurisdiction. The bill alleges that complainant's tradename, 'Winchester,' is worth in excess of \$5,000, but makes no charge as to the amount of present or prospective damage to complainant arising out of defendant's action, excepting the statements that defendant's acts are calculated to deceive and mislead intending purchasers of complainant's prod-

uct, 'to the great loss, injury and damage' of complainant, and that unless such acts of defendant are checked 'the reputation of the complainant and its rifles will still further suffer great and irreparable damage.' There is no averment that complainant's tradename will be destroyed, nor that it is in jeopardy. The court cannot assume, in the absence of allegations to that effect, that the tradename will be destroyed, or that complainant's damages are in excess of \$2,000." *Kohlsaat, J., in Winchester Repeating Arms Co. v. Butler Bros.*, 128 Fed. Rep. 976.

inhabitant, waives the right to object that it is brought in the wrong district.¹⁵ But a corporation, by doing business or appointing a general agent in a district other than that in which it is created, does not waive its right, if seasonably availed of, to insist that the suit should have been brought in the latter district.¹⁶

The Court of Appeals of the district of Columbia had no jurisdiction of trademark cases under section 3 of the law of 1881.¹⁷

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts cannot entertain such an action arising between citizens of the same state except in so far as the respondent's wrongful acts affect commerce with foreign nations or the Indian tribes; at least that is the express holding of the circuit court of appeals for the seventh circuit.¹⁸

§ 140. **Jurisdiction of the state courts.**—The state courts have a jurisdiction concurrent with that of the federal courts in trademark cases.¹⁹ It may, at times, be advisable for a non-resident plaintiff who has secured state registration for his mark or label to sue in the state court in preference to the federal court; this will be determined by the character of the matter for which state

15—*Re Keasbey & Mattison Co., Elgin Nat. Watch Co.*, 94 Fed. Rep. 160 U. S. 221-229. 667, 672, 35 C. C. A. 237.

16—*Re Keasbey & Mattison Co.*, 19—*Small v. Sanders*, 118 Ind. 160 U. S. 221-229. This reverses 105, 20 N. E. Rep. 296. It is well settled law that the jurisdiction of state and federal courts over suits for infringement of trademarks is concurrent. The act of March 3, 1881, conferring jurisdiction upon the courts of the United States, in no way impaired the jurisdiction of the state courts. *Re Keasbey & Mattison Co.*, 160 U. S. 221; *Reeder v. Brodt*, (C. P.) 4 Ohio N. P. 265; 6 Ohio Dec. 248.

17—*Einstein v. Sawhill*, 65 Off. Gaz. 1918.

18—*Illinois Watch Case Co. v.*

registration has been secured. Several of the states have by statute extended the definition of trademark to include tickets, labels, wrappers, and other wrappings or packages not properly trademark, and frequently it will be a benefit to a complainant to avail himself of such statutory provisions.²⁰ The courts of every state of the Union have, with the exception of California,²¹ always been open to the owners of trademarks seeking redress and protection against piracy, without requiring state registration as a prerequisite.

§ 141. The elements whereon jurisdiction must be predicated.—Lord Chancellor Brady, in the Irish high court of chancery, in 1893, speaking of trademark causes, said: “In such suits, in order to found the jurisdiction of this court, there must be established, first, the existence of the trademark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the court must regard them as merely colorable; and thirdly, the fact that the imitations were made without license, or anything that this court could regard as acquiescence in their use.”²² Mr. Sebastian refers to the remark of Vice Chancellor Bacon, in England, that “the law of Scotland does not in this respect differ from the law of England”²³ (referring to trademarks), as establishing, in conjunction with the above dicta of the

20—“The phrase trademark as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods of some particular class or description or the designation or

name for any mill, hotel, factory or other business.” Sec. 366, Penal Code of New York, 1893; Montana Code, 1895, vol. I, sec. 3160.

21—Whittier v. Dietz, 66 Cal. 78. This exception to the rule has since been removed by statutory enactment.

22—Kinahan v. Bolton, 15 Ir. Ch. 75-79. See also Thedford Medicine Co. v. Curry, 96 Ga. 89.

23—Singer Mfg. Co. v. Loog (3), L. R. 18 Ch. D. 395-404.

learned Irish chancellor, the fact that the jurisdictional principles in the three kingdoms are the same.²⁴ The supreme court of New York has held it error to dismiss a complaint upon the pleadings and the opening of counsel where the complaint showed the ownership of a tobacco sample ticket used in trade by the plaintiffs, and the wrongful use of an imitation thereof by the defendants.²⁵ For reasons discussed elsewhere, it is not necessary to confer jurisdiction that it be alleged that any one has in fact been misled or deceived by the use of the simulated mark. But the pleadings must be drawn to suit the exigencies of the case; and where the facts plainly showed that the simulated mark did not and could not deceive either the jobber or retailer, and the fraud, if any, was upon the ultimate purchaser, the consumer, it was proper to aver the fact that the infringement was calculated to deceive the consumer,²⁶ and it is probably always a better course to aver that the imitation is calculated to deceive the ultimate purchaser.

The real and simulated marks should be submitted with the bill of complaint or accurately described in appropriate terms, the main test of the alleged resemblance being inspection by the court;²⁷ with the qualification that the resemblance need not be such as to deceive persons seeing the two marks side by side.²⁸

24—Sebastian, *Trademarks* (4th ed.), 170.

25—*Linde v. Bense*, 22 Hun (29 N. Y. Sup. Ct.), 601.

26—*Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10, 25. The court adds: "The consumer of the particular article is to be considered almost exclusively in determining the question of infringement, because, in the case of an attempted deception, he is substantially the only party likely to

be deceived." Citing *Sykes v. Sykes*, 3 B. & Cr. 541; *Farina v. Silverlock*, 1 K. & J. 509; *Rose v. Loftus*, 47 L. J. Ch. 576; *Singer Mfg. Co. v. Loog* (3), 18 Ch. D. 395-412.

27—*Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10, 26.

28—*McCann v. Anthony*, 21 Mo. App. 83; *Drummond Tobacco Co. v. Tinsley Tobacco Co.*, 52 Mo. App. 10.

§ 142. **The parties plaintiff.**—The action to protect a trademark may be brought by its owner or a licensee.²⁹ Trusts, constructive, implied or expressed, may arise,³⁰ in which case the name of the trustee would be necessary in all suits at law affecting the legal title to the trademark, and it would be his duty at all times to protect and defend the title or allow his name to be used for that purpose, under the established principles of law affecting trusts.³¹

It is not necessary that all the parties having an interest in a trademark join as parties plaintiff. Thus, Vice Chancellor Shadwell held that surviving partners could maintain an action for an infringement of the firm's trademarks, notwithstanding the fact that the personal representatives of a deceased partner might have some interest in them.³²

Parties having distinct interests in the devices embodied in an infringing label may join as complainants in equity.³³

Individuals and corporations having a common interest may join as parties complainant in a bill in equity to restrain an unfair competition in trade. Thus in a recent case we find seven corporations located in the city of Minneapolis joined in a bill to restrain the fraudulent use of names peculiar to their business and locality, by

29—Kidd v. Johnson, 100 U. S. 617; Kidd v. Mills, 5 Off. Gaz. 337. Where there is an exclusive licensee he must be made a party, or no injunction can issue. Wallach v. Wigmore, 87 Fed. Rep. 469.

30—Re Mitchell, L. R. 28 Ch. D. 666. Thus where the use of a trademark is improperly obtained by one member of a partnership for his own use, he being bound to obtain it for the partnership, he is held to be the trustee of the mark for the benefit of the firm.

Webster v. Ketcham, 39 N. Y. Sup. Ct. 54. Compare *Ex parte* Lawrence Bros., 44 L. T. N. S. 98; 29 W. R. 392; Re Rust, 29 W. R. 393; Re Farina, 29 W. R. 391. The three cases last named are cases in which one partner registered a mark in his own name by mistake.

31—Perry, Trusts (4th ed.), sec. 520.

32—Hine v. Lart, 10 Jur. 106; Seb. 80.

33—Jewish Colonization Assn. v. Solomon, 125 Fed. Rep. 994, 995.

a dealer in Chicago,³⁴ and the owners of two separate "Blue Lick Water" springs in Kentucky joined in a bill to restrain the use of the words "Blue Lick Water" by a third party who had no right to their use.³⁵ During the period of administration the personal representative of the deceased owner of a trademark holds the mark, as we have seen, although it has been held in one case that it may pass without administration.³⁶ Where there is an administrator, it is his duty to defend the trademark from infringement, and he can recover all accrued profits and damages from the infringer, as actions to restrain infringement and recover profits and damages are held not to come within the rule *actio personalis moritur cum persona*.³⁷ The owner of real estate and improvements thereon may have such a right in a trademark used to identify the products of his tenants as to entitle him to prevent his tenants from using the mark after they have removed to other premises.³⁸

Upon the dissolution of a copartnership, "either member may use the devices or symbols, unless he has divested himself of the right."³⁹

Where copartners dissolve partnership, each retaining

34—Pillsbury - Washburn Flour Mills Co. v. Eagle, 30 C. C. A. 386, 86 Fed. Rep. 608. See also Gravel Roofers' Exchange v. Turnbull, 64 Off. Gaz. 441.

35—Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21. See also Society of Accountants v. Corporation of Accountants, 20 Scot. Sess. Cas. (4th ser.), 750, in which three chartered societies joined in an action to prevent the use of the letters "C. A." (Chartered Accountants) by the defendant, those letters having been used only to designate members of the three complaining societies. See also Pratt's Appeal, 117 Pa. St., 401.

36—Pratt's Appeal, 117 Pa. St. 401. See Stewart v. Einstein, 64 Off. Gaz. 1533.

37—Woerner, Administration, sec. 299; Oakey v. Dalton, L. R. 35 Ch. D. 700; 35 W. R. 709; Hatchard v. Mege, L. R. 18 Q. B. D. 771; Giblett v. Read, 9 Mod. 459; Croft v. Day, 7 Beav. 84.

38—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; Armstrong v. Kleinhaus, 82 Ky. 803; Harper v. Pearson, 3 L. T. N. S. 547; Carmichael v. Latimer, 11 R. I. 395; Motley v. Downman, 3 My. & Cr. 1; Dickson v. McMaster, 18 Ir. Jur. 202.

39—Patterson, J., in Baldwin v.

the right to use the trademarks of the firm, each can assert his right to the exclusive use of such trademarks as to all persons except his associates in ownership.⁴⁰ But in all cases where the right to a trademark is vested severally in two or more persons, either of them will be enjoined from advertising or claiming that he is the "sole proprietor,"⁴¹ or that his is the "only genuine" article.⁴² And where title is so held, either of the parties entitled to its use may alone maintain a suit in equity against an infringer.⁴³

§ 143. **The parties defendant.**—We have seen in a previous chapter that the liability for injunction against infringement extends to the manufacturer of dies from which counterfeits of the mark are to be made; and it may accurately be said that every one who deals with the simulated trademark or the means of producing it will be restrained in equity.

In a case where a temporary injunction had been granted against a person since deceased, without opposition, and the defendant in his life-time had never moved to vacate it, it was held in New York that the cause would not be continued as against the administratrix of the defendant, because it was not shown that the defendant had acquired any rights in the litigation or that any prejudice would result to the estate by not continuing the action.⁴⁴

The question who may be parties defendant involves necessarily a discussion of some of the principles applied by the courts in infringement proceedings.

Von Micheroux, 25 N. Y. Supp. 857. To the same effect see *Huwer v. Dannenhoffer*, 82 N. Y. 499.

Hazard v. Caswell, 93 N. Y. 259. Simeon L. & George H. Rogers Co., 110 Fed. Rep. 955.

40—*New York Cement Co. v. Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co.*, 87 Fed. Rep. 203.

41—*Coplay Cement Co.*, 45 Fed. Rep. 212. 43—*Dent v. Turpin*, 30 L. J. Ch. 495; *Seb.* 196.

44—*International Silver Co. v. Republic of Peru v. Reeves*, 40 N. Y. Sup. Ct. 316.

Where the plaintiff, the sole owner of a mineral spring, leased it to one who adopted a name to indicate its waters, the concessionaire was enjoined at the instance of the owner from applying the name so used to water from another spring;⁴⁵ and in a case where the owner of a spring granted concessions to another conveying the selling privileges in certain countries, the concessionaire was enjoined from interfering with the sale in those countries of water from the spring sold through parties other than the concessionaire.⁴⁶

A manufacturer may delegate the right to use his trademark to sales merchants, giving them that right only so long as they buy goods, of the class to which the trademark belongs, from him. Upon their ceasing to so purchase their goods they will be enjoined from the use of the mark.⁴⁷

A firm of shippers of merchandise who applied the name "The Keystone Line" to vessels they did not own, but of which they had the exclusive management in loading and unloading, were held to have acquired such an exclusive right in the name that the owners of the vessels so used were enjoined from using the name when the shippers transferred their business to other vessels, the property of other ship-owners.⁴⁸

One who is merely a forwarding agent may be enjoined. In an English case a firm of forwarding agents in London received from foreign correspondents several packages of cigars bearing forged brands. They were enjoined, but costs were not assessed against them because they had, prior to suit, given the makers of the brands so counterfeited full information as to the con-

45—Hill v. Lockwood, 32 Fed. Rep. 389.

46—Apollinaris Co. (Ltd.) v. Scherer, 23 Blatchf. 459, 27 Fed. Rep. 18.

47—Re Riviere, 53 L. T. N. S. 237. See also Lavergne v. Hooper, Ind. L. R. 8 Mad. 149.

48—Winsor v. Clyde, 9 Phila. 513.

signees and offered to return the cigars to the consignors or to erase the brands.⁴⁹

The managers of an infringing corporation, who are themselves substantially the corporation, are properly joined as co-defendants with the corporation in a bill to restrain the infringement.⁵⁰ The directors of an infringing corporation may be joined as co-defendants with it.⁵¹

Servants, agents, and employes generally, may be joined as defendants; they are personally liable to injunction.⁵² American agents of foreign houses will be enjoined from selling counterfeits or imitation goods received from their principals.⁵³ The same rule obtains in regard to English⁵⁴ or Australian⁵⁵ agents of foreign principals, and in regard to commission merchants.⁵⁶

The principal is, of course, liable for the acts of his servants or agents, whether or not he can be shown to have knowledge of those acts.⁵⁷

Difficulty arises in considering the rights and liabilities of innocent parties through whose hands counterfeit goods pass in transit, who hold them only as bailees and have no actual or imputed knowledge of their fraudulent nature. In the case of wharfingers so situated,

49—Upmann v. Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. Ap. 130.

50—California Fig Syrup Co. v. Improved Fig Syrup Co., 61 Off. Gaz. 155; 51 Fed. Rep. 296.

51—Armstrong & Co. v. Savannah Soap Works, 53 Fed. Rep. 124, 61 Off. Gaz. 1018.

52—Estes v. Worthington (2), 30 Fed. Rep. 465; Sawyer v. Kellogg (1), 7 Fed. Rep. 721; Sawyer v. Kellogg (2), 9 Fed. Rep. 601.

53—Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625; Roberts v. Sheldon, 8 Biss. 398, Fed. Case No. 11916.

54—Siegert v. Ehlers, Seb. 432; Siegert v. Findlater, L. R. 7 Ch. D. 801; Farina v. Cathery, L. J. N. C. 1867, p. 134.

55—Siegert v. Lawrence, 11 Vict. L. R. 47.

56—Coats v. Holbrook, 2 Sandf. 586; Cox, 20; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70.

57—Low v. Hart, 90 N. Y. 457; Atkinson v. Atkinson, 85 L. T. Jour. 229; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Tonge v. Ward, 21 L. T. N. S. 480.

who offered to act in regard to falsely marked wine in their possession as the court might direct, but asked to have their charges provided for, the court ruled that they were entitled to a lien upon the wine for their charges; that plaintiffs must pay defendant's costs; and if the plaintiffs had any lien for their own costs as against the wine, it must be subject to the lien of the wharfingers for their charges.⁵⁸

An innocent mortgagee of wines bearing a simulated mark was held to have a valid lien thereon, and it was directed that the spurious marks should be effaced and the wines delivered to him.⁵⁹

In no case, however, will relief in equity stop short of protecting the owner of a trademark of which imitations or counterfeits are found in the hands of a common carrier or warehouseman.⁶⁰ It is the duty of the bailee so situated to give the owner of the trademark full information in regard to the goods which are or have been in his hands by virtue of the bailment, and where he refuses so to do, even after the goods have gone beyond his control, it has been held that a bill will lie against him to compel discovery.⁶¹

If, on the other hand, the bailee gives the owner of the mark full information, he will be allowed costs if, notwithstanding his disclosures, proceedings are instituted against him.⁶² The wrongs of which this book treats being torts, and all participants in torts being principals,

58—*Moet v. Pickering*, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372. Upmann v. Elkan, L. R. 12 Eq. 140.

59—*Ponsardin v. Peto*, 33 Beav. 642. 61—*Orr v. Diaper*, L. R. 4 Ch. D. 92. See also *Carver v. Pinto Leite*, L. R. 7 Ch. D. 90; 41 L. J.

60—*Ponsardin v. Peto*, 33 Beav. 642; *Hunt v. Maniere*, 34 Beav. 157; *Del Valle v. Mayer, Seton* (4th ed.), 236; *Seb. 326; Rivero v. Norris. Seton* (4th ed.), 236; *Seb. 299; Moet v. Pickering*, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372; 25 L. T. N. S. 722; 20 W. R. 134.

62—*Upmann v. Currey*, 29 Sol. J. 735; *Upmann v. Forester*, L. R. 24 Ch. D. 231; *Moet v. Pickering*, L. R. 8 Ch. D. 372; *Upmann v. Elkan*, L. R. 12 Eq. 140.

a person who assists in conducting an unfair competition by furnishing fraudulent packages or labels is liable for the injury resulting to the plaintiff from the unfair competition.⁶³

§ 144. **Forms of action.**—The most usual form of civil action to secure redress for trademark piracy in this country is by bill in equity, praying for an injunction, discovery, account of profits, and damages. The remedy at law is by an action on the case, for deceit; that form of action being both the form known to the common law and that prescribed by the act of March 3, 1881.

An action of deceit may be brought by a purchaser who has been deceived by the vendor of the fraudulent article, but such actions are seldom, if ever, brought, and are practically unheard of.

One action in a federal court will lie for the infringement of a patent and the infringement of a trademark, where the trademark and the patent were both infringed together,⁶⁴ and the same rule applies where a publication infringes both a trademark and a copyright.⁶⁵

63—Hildreth v. Sparks Mfg. Co., Fleece Underwear Co., 60 Fed. Rep. 99 Fed. Rep. 484. 622.

64—Walker, Patents (3d ed.), 65—Harper v. Holman, 84 Fed. sec. 417; Jaros Underwear Co. v. Rep. 222.

CHAPTER XI.

THE CRIMINAL PROSECUTION—FEDERAL AND STATE.

§ 145. **The act of 1876.**—The prosecutions under which the decision styled the *Trademark Cases*¹ was rendered were instituted under the act of congress of 1876. This was a penal act applicable to infringers of trademarks registered under the registration act of 1870. Mr. Justice Miller says, in the conclusion of his opinion: “While we have, in our references in this opinion, had mainly in view the act of 1870, and the civil remedy which that act provides, it was because the criminal offenses described in the act of 1876 are, by their express terms, solely referable to frauds, counterfeits, and unlawful use of trademarks which were registered under the provisions of the former act. If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it.”²

After the enactment of the act of March 3, 1881, some able lawyers inclined to the belief that the act of 1876 was by the passage of a valid registration act given new life, or, as stated by one eminent jurist: “This is not an instance of revival; for the penal act was not dead, but simply dormant. Its sleep was ended by the birth of the act of 1881. No words were required in the latter to set the penal law in motion. That which is implied in a statute is just as much a part of it as is that which is expressed. Nor is it repealed by the civil act of 1881.”³

1—100 U. S. 82.

3—Browne, Trademarks (2d

2—Trademark Cases, 100 U. S. ed.), sec. 371.

82-99.

This reasoning, however, has not been followed by the courts. The proposition was first submitted to Judge Thayer, but in his opinion he expressly refrained from deciding it, sustaining demurrers to indictments based upon the act of 1876 upon other grounds.⁴ Subsequently the question was squarely presented to Mr. Justice Brewer, sitting as circuit judge, who said in substance: "While the act of 1870 was a nullity, it must be assumed as a matter of fact that in framing the act of 1876 the penalties imposed were with reference to the terms of the statute of 1870. * * * Again, when the act of 1881 was passed, if congress had intended that penalty should be imposed for a trespass upon the rights conferred by that statute, or if it had intended that the act of 1876 should be revived and operate upon the act of 1881, it was very easy to say so. Its silence in this respect is cogent evidence that it did not understand or intend that the penal statute should be considered a part of present and valid law. And that assumption is strengthened by the fact that it had before it for consideration this passage from the opinion of the supreme court (quoted above) in which it is broadly stated that the Act of 1876 had fallen with the Act of 1870. Whatever may be true as to the full meaning of that decision, or as to the general power of congress to impose penalties for trespasses upon rights having no existence, it had before it the general affirmance by the court that the law of 1876 had fallen, and it must be assumed that if it meant that it should stand and be revived, or that any penalties should be imposed for violations of the law of 1881, it would have so stated. These considerations convince me very strongly that the Act of 1876 has, as the supreme court said, fallen with the Act of 1870, and it is as much a dead letter as the Act of 1870, and was not revived or given operative force by the Act of 1881."⁵

4—United States v. Braun, 39
Fed. Rep. 775-777.

5—United States v. Koch, 40
Fed. Rep. 250-252.

The Act of 1876, then, is no longer of force, and there is no federal relief by criminal prosecution to be had; except that under certain conditions, which we will examine in the next section, the owners of trademarks applied to spirituous liquors and wines may be measurably protected by federal prosecution under the internal revenue laws.

§ 146. Section 3449, Revised Statutes.—In the last paragraph of section 29 of the act of congress approved July 13, 1866, and entitled “An act to reduce internal taxation and to amend an act entitled ‘An act to provide internal revenue to support the government, to pay interest on the public debt, and for other purposes,’ approved June 30, 1864” (now section 3449, Revised Statutes of the United States), it is provided as follows:

“Whenever any person ships, transports, or removes any spirituous or fermented liquors or wines, under any other than the proper name or brand known to the trade as designating the kind and quality of the contents of the casks or packages containing the same, or causes such act to be done, he shall forfeit said liquors or wines, and casks or packages, and be subject to pay a fine of five hundred dollars.”

This enactment is constitutional, being within the authority delegated to congress by the first clause of section 8 of article 1 of the constitution, being to “levy and collect taxes,” and to “make all laws which shall be necessary and proper for carrying into execution that power.” It is no objection to the validity of the act that its enforcement incidentally protects the owners of trademarks. As stated by Mr. Justice Nelson in another connection: “It will not do to say that the exercise of an admitted power of congress conferred by the constitution is to be withheld, if it appears, or can be shown, that the effect and operation of the law may incidentally extend beyond the limitation of the power. Upon any such in-

terpretation the principal object of the framers of the instrument in conferring the power would be sacrificed to the subordinate consequences resulting from its exercise."⁶ It has therefore been held constitutional by Judges Lacombe,⁷ Thayer, Sanborn, Caldwell⁸ and Hawley.⁹ Under this section the term "package" includes every box, barrel, or other receptacle into which distilled spirits have been placed for shipment or removal, either in quantity or in separate small packages, as bottles or jugs.¹⁰ The phrase "proper name or brand" does not refer to the trademark or make of a certain distiller, but to a removal under an improper or misleading title, as where the fraud on the government is attempted of removing brandy under the name of whiskey."¹¹

What will constitute transportation or removal under the terms of this act is not determined, and will probably depend upon the facts in each particular case. The act includes in its purview any person who ships, transports or removes liquors in violation of its provisions.¹²

This act is capable of protecting to a great extent the owners of trademarks used in the liquor trade.

§ 147. Criminal liability at common law.—The counterfeiter of a trademark is not guilty of forgery.¹³ His offense is comprehended under some division of the various fraud acts. Probably it will always be found to fall

6—State of Pennsylvania v. Wines, 76 Fed. Rep. 364-368, 22 C. Wheeling & Belmont Bridge Co., C. A. 228.

59 U. S. 421-433.

7—United States v. Loeb, 49 Fed. Rep. 636.

8—United States v. 132 Packages of Spirituous Liquors and Wines, 22 C. C. A. 228, 76 Fed. Rep. 364; reversing same case, 65 Fed. Rep. 980.

9—United States v. Campe, 89 Fed. Rep. 697.

10—United States v. 132 Packages of Spirituous Liquors and

11—United States v. 132 Packages of Spirituous Liquors and Wines, 76 Fed. Rep. 364-368, 22 C. C. A. 228.

12—United States v. Campe, 89 Fed. Rep. 697-699.

13—White v. Wagar, 185 Ill. 195-202. He may be, where the counterfeit mark contains a guaranty, expressed or implied. White v. Wagar, 83 Ill. App. 592-596.

within the limits of the acts defining the offense of obtaining money under false pretenses.¹⁴ But under the English decisions it is not a forgery, even where the trademark counterfeited consists of a signature.¹⁵ In the United States, however, prosecutions have been very seldom resorted to. The prosecutor in actions sounding in false pretenses should, of course, be the customer who has been defrauded, and as a rule he is little inclined to prosecute.

§ 148. **The penal statutes of the several states.**—The more important statutes relating to trademark protection are set out in the appendix. It will be noticed, upon examining them, that legislation has enlarged it for the protection of labor organizations and of particular industries; thus, states having no general registration act, have provisions for the registration and protection of timber marks, or of the packages, such as bottles, or syphons, used by the manufacturers of carbonated waters, or the milk cans of the dairy industry. In the statutes, which have been reproduced in the appendix, are to be found admirable examples of every form of trademark legislation which the necessities of commerce have thus far created. An adequate registration act in each of the states which now has no general statutory provision upon that subject, and greater uniformity of legislation between the states, are greatly to be desired. In the annotations of these cases, it will be noticed that there have been comparatively few reported cases of criminal prosecution under them. The heavy burden of proof imposed upon the state in these cases has served as a deterrent to such prosecution. Thus the Illinois court held that proof that two persons, strangers to the defendant, had told him that the mark on the goods

14—*Regina v. Smith*, D. & B. 8 Cox, 37; *Regina v. Dundas*, 6 566; 8 Cox, 32. Cox, 380; *Regina v. Gray*, Seb.

15—*Regina v. Closs*, D. & B. 183; *Regina v. Sutter*, 10 Cox, 460; 7 Cox, 494; *Regina v. Smith*, 577.

he was selling was counterfeit, was not necessarily sufficient to prove his guilty knowledge.¹⁶ This difficulty has been remedied in Massachusetts by the enactment of a provision requiring a defendant charged with the selling of goods bearing a spurious mark to show that he bought them innocently.

It is undoubtedly proper legislation to impose this requirement upon the defendant. In England, proof of fraudulent intent is not required in a prosecution under Merchandise Marks Act of 1887.¹⁷

16—Vogt v. People, 59 Ill. App. 684.

17—Wood v. Burgess, L. R. 24 Q. B. D. 162.

CHAPTER XII.

ACTIONS AT LAW.

§ 149. **The form of action.**—"The only redress for a trademark infringement was at first by an action in a common law court for damages for deceit.¹ An action at law for damages is prescribed by the act of 1905, as a proper legal remedy for infringements of trademarks.² It is against the policy of the law that the owner of a valid trademark should lose by reason of its infringement. To prevent such a result, the action at law is well adapted, because it measures the plaintiff's recovery by the plaintiff's loss. But it is also against the policy of the law that an infringer should gain by reason of his infringement.

By Sec. 7 of the Act of 1881 the action of trespass on the case was specified as the appropriate action at law for trademark infringement.

The history of this form of action has been succinctly described by English jurists. Lord Blackburn said: "The original foundation of the whole law is this: that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established (alike at law³ and in equity⁴) that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."⁵

1—Gaynor, J., in *Clinton Metallic Paint Co. v. New York Metallic Paint Co.*, 50 N. Y. Supp. 437.

4—*Edelsten v. Edelsten*, 1 DeG. J. & S. 185.

2—Act of February 20, 1905, § 16. R. 8 A. C. 15-29.

5—*Singer Mfg. Co. v. Loog*, L.

3—*Blofield v. Payne*, 4 B. & Ad.

The development of the action on the case, and the manner in which it became adapted to the exigencies of trademark issues, are thus admirably stated by Mellish, L. J.: "In my opinion all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in respect of the improper use of a trademark arose out of the common law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect: that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trademark, the common law courts noticed that the false representation which is made by putting another man's trademark, or the trade-name of another manufacturer, on the goods which the wrong-doer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trademark is imitated; and, therefore, the common law courts held that such a manufacturer had a right of action for the improper use of his trademark. Then the common law courts extended that doctrine one step further; first, if I recollect rightly, in the case of *Sykes v. Sykes*.⁶ There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods and therefore was not deceived into believing that he had bought goods manufactured by another person, yet if the trademark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manu-

6—3 B. & Cr. 541.

facturer to whom the trademark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trademark a right of action. That was the common law right.”⁷

§ 150. **The declaration.**—The proper parts of a declaration in an action at law are, in their order, as follows:

1. The title of the court.
2. The title of the term.
3. The name.
4. The commencement.
5. The statement of the right of action.
6. The conclusion.

The correct title of the United States Circuit Court established in the northern district of California is “The Circuit Court of the United States for the Northern District of California,” and the titles of the various other circuit courts are the same, except as to the name of the district,⁸ to which should be added the name of the division of the district, where the judicial districts are subdivided.

The term in which the declaration should be entitled is the term to which the defendant is summoned.⁹ It is unnecessary to entitle a declaration in the name of the case in which it is filed; the style of the case may be indorsed upon the back of the declaration as a matter of convenience.¹⁰

The venue should be laid in the district where the declaration is filed, regardless of the district or districts wherein the infringement was committed.¹¹

The commencement sets forth the names of the parties and the capacity in which they respectively sue or are sued, if it is other than a natural capacity.¹²

7—*Singer Mfg. Co. v. Wilson*, L. R. 2 Ch. D. 434-453.

10—*Walker*, Patents (3d ed.), sec. 422.

8—Revised Statutes, sec. 608.

11—Ibid.

9—*Chitty*, Pleading (15th Am.

12—Ibid.

ed.), p. 263.

A corporation cannot be or become a citizen of a state,¹³ and therefore an averment of its citizenship is improper. When a corporation is a party the corporate name should be set forth, followed by the averment that the said corporation "is a corporation created under the laws of the state of —, and having its principal place of business at —." ¹⁴

The courts of the United States having a limited jurisdiction, the jurisdictional facts must be expressly pleaded in the declaration. Diverse citizenship, if it exists, must be shown. If the trademark involved is registered under the act of Feb. 20, 1905, that fact must be pleaded, because, first, it establishes a *prima facie* right to the use of the mark, and second, confers jurisdiction upon the federal court regardless of the amount in controversy.¹⁵

If the action is between citizens of the same state, even though involving a registered trademark, the declaration must aver that the plaintiff uses the trademark and the defendant the infringing mark upon goods intended for commerce with foreign nations or with the Indian tribes or interstate commerce.¹⁶ If the action is based upon a common law trademark, the declaration must set forth the amount in controversy, which is not the amount sought to be recovered, but the value of the trademark, and that value must be not less than two thousand dollars.¹⁷

13—Paul v. Virginia, 8 Wall. 168; Ducat v. Chicago, 10 Wall. 410.

14—Shiras, Equity Practice (2d ed.), sec. 34. Citing Lafayette Ins. Co. v. French, 18 How. 404; Railroad Co. v. Harris, 12 Wall. 65; Ex parte Schollenberger, 96 U. S. 369; Pennsylvania Co. v. Railroad Co., 118 U. S. 290; Goodlet v. Railroad, 122 U. S. 391.

15—Act of March 3, 1881, sec. 7; Act of 1905, §§ 16, 17. Symonds v. Greene, 28 Fed. Rep. 834; Glotin v.

Oswald, 65 Fed. Rep. 151; Hennessey v. Herrmann, 89 Fed. Rep. 669; Re Keasbey & Mattison Co., 160 U. S. 221-227.

16—Luyties v. Hollender (1), 22 Blatchf. 413; Schumacher v. Schwenke (1), 26 Fed. Rep. 818; Ryder v. Holt, 128 U. S. 525; Gravely v. Gravely, 42 Fed. Rep. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed. Rep. 493.

17—Symonds v. Greene, 28 Fed. Rep. 834.

Fraud is essential to recovery at law. Lord Westbury said, "Proof of fraud on the part of the defendant is of the essence of the action."¹⁸ Furthermore, at law it is necessary to show, and plead, that an injury has actually been done by the defendant's act of infringement.¹⁹

The averment of infringement should set forth, then, in what the infringement consisted, and that it was done wilfully and with fraudulent intent on the part of the defendant. The statement of the right of action should describe the trademark in exact and appropriate terms, and where possible the real and simulated marks should be reproduced in fac-simile.

The conclusion of the declaration should pray for the actual damage sustained by the plaintiff and for punitive damages if the facts justify. Some adjudications in the past have held that there can be no recovery of punitive damages,²⁰ but such a conclusion is at variance with the fundamental principles of the law of torts. The more wholesome and better reasoned doctrine is to the contrary.²¹

In Sec. 16 the Act of 1905 provides in relation to actions at law for damages for the infringement of a registered mark, that "whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, not exceeding three times the amount of such verdict, together with the

18—*Edelsten v. Edelsten*, 1 DeG. J. & S. 185; *Hargraves v. Smith*, Seb. 338; *Lawson v. Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188; 2 Jur. N. S. 716; 27 L. T. 134; 4 W. R. 481; Seb. 140; *Rodgers v. Nowill*, 6 Hare, 325; 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; Seb. 82; *Crawshay v. Thompson*, 4 Man. & G. 357; 5

Scott, N. R. 562; 11 L. J. C. P. 301; Seb. 72.

19—*Singer Mfg. Co. v. Loog* (3), L. R. 8 App. Cas. 15-30.

20—*Taylor v. Carpenter* (2), 2 Wood. & M. 1; Cox, 32; 9 L. T. 514; Seb. 83.

21—*Warner v. Roehr*, Fed. Case No. 17189A; *Day v. Woodworth*, 13 How. 363; *Browne, Trademarks* (2d ed.), secs. 519, 520.

costs." In a declaration based upon the infringement of a mark registered under the act, the conclusion should pray for the actual damages stated to have been sustained by the plaintiff, together with such additional amount, not exceeding in all three times the amount of such actual damages, as the court may see fit to adjudge, together with the costs.

The conclusion ends with the formal allegation of bringing suit.

It is necessary at common law in drafting the declaration to directly allege that the injury has been committed by continuation from one given time to another or that it was committed on divers days and times. Thus, one pleader alleged in his declaration as follows: "Since the 1st day of November, 1888, knowingly, wilfully, and fraudulently offered for sale, and is now selling, glue in packages." Upon the trial, in the federal circuit court for the district of Massachusetts, the complainant was permitted to introduce proof of sales by the defendant of infringing goods between November 1, 1888, and November 30, 1889, amounting to \$56,318.24. The circuit court of appeals of the fourth circuit set aside a judgment of \$8,000, entered upon the verdict of a jury, saying, by Putnam, J., "There is no *continuando* with reference to the matter of selling; so that, according to the common law, the plaintiff could properly prove only one actual sale as an independent basis of damages. The defendant insisted at all necessary points on the enforcement of the rule, and exceptions were carefully taken and allowed; so that this court, however much it may regret it, is compelled to meet this issue. There is no doubt that at common law the position of the defendant would be correct on this point, and the Massachusetts statutes relating to pleading have not changed this rule."²²

22—Le Page Co. v. Russia Cement Co., 2 C. C. A. 555, 51 Fed. Rep. 941-949, 17 L. R. A. 354.

§ 151. **Defenses.**—The defenses to actions for trademark infringement may be divided into two classes. The first class embraces those defenses which attack the plaintiff's right to sue. It may be that the owner of a trademark who sues for infringement has conveyed the right to use the mark to an exclusive licensee for a term of years. In such a case no injunction can issue unless the licensee joins in the action.²³ It may be advisable to set up laches or acquiescence, or that there are facts to justify a plea that whatever rights the complainant once had he has lost by abandonment; which matters have been discussed in a preceding chapter. In an exceptional case the complainant's recovery may be precluded by an estoppel,²⁴ which should, of course, be pleaded. The complainant's mark may have become invalid because its assignment to him from its former owner has not been sufficiently advertised, and the mark as used tends to mislead the public into a belief that the former owner is still the producer of the goods.²⁵ The complainant's label may contain misrepresentations of fact,²⁶ or his alleged trademark may be a word that, once distinctive, has become *publici juris*.²⁷ It is a good defense to the action at law to show either of these matters. The fact that the complainant's trademark is registered does not deprive the public of the right to use a similar mark which was common to the trade before the registration. Thus, where "La Normandi" was registered as a mark for cigars, but "La Normanda" was already in common use for a like purpose, injunction to restrain the use of the latter was denied.²⁸ In fact the registration of a

23—Wallach v. Wigmore, 87 Fed. Rep. 469.

24—Lavergne v. Hooper, Ind. L. R. 8 Mad. 149.

25—Alaska Packers' Ass'n v. Alaska Imp. Co., 60 Fed. Rep. 103; Slegert v. Abbott (1), 61 Md. 286.

26—Piso Co. v. Voight, 4 Ohio

N. P. 347; Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585.

27—Siegert v. Abbott (4), 25 N. Y. Supp. 590; 72 Hun, 243.

28—Stachelberg v. Ponce, 23 Fed. Rep. 430; Price & Steuart, 967; 128 U. S. 686.

trademark does not prevent its being attacked as a word *publici juris*, or as being itself a colorable imitation of another trademark.²⁹ The English decisions upon this point are in harmony with those of the courts of the United States.³⁰

The defendant may plead a license from the owner of the mark. This, of course, presumes that the license was lawful, and that the licensee has not so used the mark as to perpetrate a fraud upon the public.³¹ Where two or more persons have an equal right in the use of the mark the defendant may plead a license from either of them.³²

The second class of defenses that may be interposed are those that deny the infringement—either denying that any infringement has been perpetrated by the defendant, or, if the infringing mark has been handled or dealt with by the defendant, denying that guilty knowledge which the complainant must prove to sustain his suit at law.

In the foregoing portion of this section we have noted the defenses which, if sustained by the proof, will relieve the defendant from liability at law. The action at law is much easier of defense than that in equity, and in another section, after we have considered the action in equity, will be found enumerated a number of defenses

29—*Moorman v. Hoge*, Fed. Case No. 9783, 2 Sawyer, 78; *Decker v. Decker*, 52 How. Pr. 218; *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 823; *Cox*, Manual, 695; 23 Blatchf. 46; *Schumacher v. Schwenke* (2), 36 Off. Gaz. 457.

30—*Re Palmer*, L. R. 21 Ch. D. 47; *Bodega Co. (Ltd.) v. Owens*, 23 L. R. Ir. 371; *Wolfe v. Lang*, 13 Vict. L. R. 752; *Wolfe v. Alsop* (2), 12 Vict. L. R. (E.), 421; *Lewis v. Klapproth*, 11 Vict. L. R. (E.), 214.

31—The goods to which a licensee applies the mark must be equal in quality to the goods to which the licensor applied them. *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 31 Fed. Rep. 776; 138 U. S. 537; *Oldham v. James*, 13 Ir. Ch. 393; 14 Ibid. 81; *Bloss v. Bloomer*, 23 Barb. 604; *Cox*, 200; *Samuel v. Berger*, 24 Barb. 163; *Cox*, 178; *Rodgers v. Philp*, 1 Off. Gaz. 29; *Re Tolle*, 2 Off. Gaz. 415.

32—*Marshall v. Pinkham*, 52 Wis. 572; *Price & Steuart*, 497.

which have proved ineffective in equity, many of which would doubtless be adequate at law.

§ 152. **Damages.**—The courts of the United States have signally failed to agree upon any fixed rule as to the measure of damages in actions at law for the infringement of trademarks. To the student of the decisions the only apparent cause for this fact lies in two practical reasons. The first, that the remedy offered by equity is more complete. The second is that much of the trademark piracy, of this country at least, is conducted by insolvents, who offer no inducement to the vigilant prosecution which should be visited upon them. In 1846, in the United States circuit court for the district of Massachusetts, Woodbury, J., said: "In a case like this (an action of trespass on the case for trademark infringement), if in any, no reason exists for giving greater damages than have actually been sustained, or what have been called compensatory. There is nothing peculiarly atrocious in the conduct of the defendant to be punished by damages, and in no other way, as a public example, considering the blamable usages which exist on this subject."³³ In a Missouri case, the St. Louis court of appeals, by Lewis, P. J., held that it was error in the trial court to instruct the jury that they might find exemplary damages if from the evidence they believed that the acts of the defendant were wilful or malicious. The reasoning of the court is that "If the plaintiffs had demanded an accounting of the profits made by the defendants, on the equitable ground that those profits were made by the use of the plaintiff's property, the instructions might have been substantially applicable."³⁴

33—Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; Fed. Case No. 13785. The passage quoted is a mere dictum, uttered in the course of an opinion upon a motion for a new trial where a jury

had been directed that they might find punitive damages. The verdict was not disturbed.

34—Addington v. Cullinane, 28 Mo. App. 238-241.

An eminent text-writer thus states the rule: "The jury are to give actual damages which the plaintiff has sustained—not vindictive or speculative damages, but such as his proof has shown to their satisfaction he has actually sustained by the infringement."³⁵

To the author's mind the better rule is announced in the case of *Warner v. Roehr*, in which the instructions of Judge Blodgett to a jury said in part: "In cases of this character, where you are satisfied from the proof and from the admissions in the case that the fraud—the intention to defraud—is at the bottom of the matter, . . . the jury are not confined to the exact monetary damages, but may give what are known as vindictive or exemplary damages, for the purpose of deterring others from embarking in the same scheme of fraud and deception."³⁶ It is not to be doubted that this doctrine is more reasonable and just, and better adapted to protect society from the ravages of trademark infringers, than the rule stated in *Taylor v. Carpenter*³⁷ and *Addington v. Cullinane*.³⁸ It is difficult to see how the result stated in those cases has been attained. They are wholly without precedent and opposed to the rule of damages which obtained at common law. What that rule was, and is, so far as our federal courts are concerned, is nowhere more clearly stated than by Mr. Justice Grier in an opinion in which he speaks for the federal supreme court. He says:

"It is a well-established principle of the common law that in actions of trespass and all actions on the case for torts a jury may inflict what are called exemplary, punitive or vindictive damages upon a defendant, having in view the enormity of his offense rather than the mea-

35—Sutherland, *Damages*, (2d ed.), vol. III, sec. 1202. Citing *Ransom v. Mayor*, 1 Fisher, 252; *Parker v. Hulme*, 1 Fisher, 44; *Addington v. Cullinane*, 28 Mo. App. 238.

36—*Warner v. Roehr*, Fed. Case No. 17189A.

37—*Supra*.

38—*Supra*.

sure of compensation to the plaintiff. We are aware that the propriety of this doctrine has been questioned by some writers; but if repeated judicial decisions for more than a century are to be received as the best exposition of what the law is, the question will not admit of argument. By the common as well as by statute law men are often punished for aggravated misconduct or lawless acts by means of a civil action, and the damages, inflicted by way of penalty or punishment, given to the party injured. In many civil actions, such as libel, slander, seduction, etc., the wrong done to the plaintiff is incapable of being measured by a money standard; and the damages assessed depend on the circumstances, showing the degree of moral turpitude or atrocity of the defendant's conduct, and may properly be termed exemplary or vindictive rather than compensatory.

“In actions of trespass where the injury has been wanton and malicious, or gross and outrageous, courts permit juries to add to the measured compensation of the plaintiff which he would have been entitled to recover, had the injury been inflicted without design or intention, something further by way of punishment or example, which has sometimes been called ‘smart money.’ This has always been left to the discretion of the jury, as the degree of punishment to be thus inflicted must depend on the peculiar circumstances of each case.”³⁹

Judge Thayer has said: “Punitive damages may be awarded when a wrongful act is done wilfully, in a wanton or oppressive manner, or even when it is done recklessly—that is to say, in open disregard of one's civil obligations and of the rights of others.”⁴⁰

We find the rule sanctioned and reaffirmed repeatedly by the supreme court of the United States.⁴¹ It has

39—Day v. Woodworth, 54 U. S. (13 Howard), 363, 371. See Press Pub. Co. v. Monroe, 73 Fed. Rep. 196, 201.

40—Fotheringham v. Express Co., 36 Fed. Rep. 252, 253.

41—Philadelphia R. R. Co. v. Quigley, 62 U. S. (21 Howard),

been the doctrine adhered to by that court ever since Mr. Justice Story in a case of marine tort spoke of exemplary damages as "the proper punishment which belongs to such lawless misconduct."⁴² It is manifest that in a case of deliberate counterfeiting of a trademark there should be a recovery of punitive damages, or at least an opportunity given the jury to assess punitive damages.

As to the award of actual damages at law, it has been held that nominal damages will be awarded where a fraudulent intent is shown, even though no specific injury is pleaded or proven.⁴³ The St. Louis court of appeals has said, by Bakewell, J., in an action of deceit based upon trademark infringement: "As to the damages, the facts present a case of fraud on plaintiff and violation of his rights for which the action lies without proof of specific damages. And the damage was not confined to the loss of such actual sales as could be specifically shown to be lost, but the jury might make such inferences as to the loss and injury sustained by plaintiff as they might think warranted by the whole evidence in the case."⁴⁴ Much to the same effect is the holding of the Massachusetts supreme court.⁴⁵

In California the rule of assessing damages would seem to give the plaintiff the profits made by the defend-

213; *Milwaukee R. R. Co. v. Arms*, 91 U. S. 487, 492; *Missouri Pacific Railway v. Humes*, 115 U. S. 512, 521; *Barry v. Edmunds*, 116 U. S. 550, 562; *Denver Railway v. Harris*, 122 U. S. 597, 609. Exemplary damages may be allowed even where no actual damage is proven. *Press Publishing Co. v. Monroe*, 73 Fed. Rep. 196, 201.

42—*The Amiable Nancy*, 16 U. S. (3 Wheat.) 546, 558.

43—*Le Page Co. v. Russia Cement Co.*, 2 C. C. A. 555, 51 Fed.

Rep. 941, 949; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. 603; *Coffeen v. Brunton*, 4 McLean, 516, 520; Fed Case No. 2946; *Blofield v. Payne*, 4 Barn. & Ad. 410, 411; *Marsh v. Billings*, 7 Cushing, 322, 331; *Conrad v. Brewing Co.*, 8 Mo. App. 277, 285; *El Modello Cigar Co. v. Gato*, 25 Fla. 886, 915; 9 So. Rep. 23.

44—*Conrad v. Brewing Co.*, 8 Mo. App. 277, 285.

45—*Marsh v. Billings*, 7 Cushing, 322, 332.

ant in his sales of goods bearing the infringing mark.⁴⁶

But it is very doubtful if that course is proper in an action at law. Damages were the appropriate, and indeed the only, remedy at law, while the account of profits was peculiar to courts of equity.⁴⁷

Under the English practice a custom has grown up by which a complainant in equity may pray for an account of profits and an inquiry as to damages (and it has been held in Wisconsin that this is the proper course in pleading),⁴⁸ but before any order for discovery can be made he must elect between the accounting of profits and the inquiry of damages. He cannot have both.⁴⁹ As said by Cotton, L. J., in the English court of appeal, in refusing discovery asked by a complainant before he had elected between profits and damages: "At the time when the order was made, the plaintiff had not elected to waive his account of profits. Would it then be right to allow the plaintiff to get a jury to determine what damages he was entitled to before he had made his election between damages and profits? Should the jury award him a large sum for damages, he would probably accept it; but if they gave him a small sum only, then he might say 'No, I would rather have an account of profits, as I see by the defendant's books that he has made a much larger sum.'"⁵⁰

It would seem that the damages at law must be based upon the injury sustained by the complainant by loss of sales and injury to the reputation of his trademark. Evidence of the extent of the defendant's sales may be proper,⁵¹ but only as proof of injury to the complainant,

46—*Graham v. Plate*, 40 Cal. 593, 598.

47—*Sebastian, Trademarks* (4th ed.), p. 232.

48—*Leidersdorf v. Flint* (2), 50 Wis. 401.

49—*Neilson v. Betts*, L. R. 5 H. L. R. 1.

50—*Fennessy v. Clark*, L. R. 37 Ch. D. 184, 187.

51—*Le Page Co. v. Russia Cement Co.*, 2 C. C. A. 555; 51 Fed. Rep. 941, 949; 17 L. R. A. 354.

and not with a view to measuring the plaintiff's damages by the defendant's profits.

Of course the fact that the defendant has discontinued his infringement is no defense to an action of damages,⁵² which would be barred only by the operation of the statute of limitations. It is competent to show that plaintiff's sales have fallen off because of the infringement.⁵³

A Canadian decision held that damages could not be recovered for the sale of a second-hand stove to which a second manufacturer's name-plate had been added, where the plate was put on by an employee without the employer's knowledge and the purchaser was informed of the real manufacture of the stove.⁵⁴

52—*Lemoine v. Gauton*, 2 E. D. defendant's infringement. Whether
Smith, 343; Cox, 142; Seb. 125. the latter is the cause of the former is a question for the jury.

53—*Shaw v. Pilling*, 175 Pa. St. 78, 84. It is competent to show
Ibid.

54—*Chapleau v. Laporte*, 16
sales occurred concurrently with Rap. Jud. Que. C. S. 189.

CHAPTER XIII.

THE ACTION IN EQUITY.

§ 153. **The basis of equitable jurisdiction.**—Lord Westbury said: “Imposition on the public occasioned by one man selling his goods as the goods of another cannot be the ground of private action or suit. In the language of Lord Thurlow in *Webster v. Webster*,¹ ‘The fraud upon the public is no ground for the plaintiff coming into court.’ It is, indeed, true, that, unless the mark used by the defendant be applied by him to the same kind of goods as the goods of the plaintiff, and be in itself such that it may be and is mistaken in the market for the trademark of the plaintiff, the court cannot interfere, because there is no invasion of the plaintiff’s right; and thus the mistake of the buyers in the market, under which they, in fact, take the defendant’s goods as the goods of the plaintiff, that is to say, imposition on the public, becomes the test of the property in the trademark having been invaded, and not the ground on which the court rests its jurisdiction.”²

In quoting the extract given above, Vice Chancellor Van Vleet has said: “The rule as thus stated I understand to be the established doctrine now in force on this subject both in this country and in England.”³

In the early English practice the chancellor had power to refuse or postpone the application of equitable reme-

1—3 Swanst. 490.

2—Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137, 141.

3—Schneider v. Williams, 44 N. J. Eq. 391, 393. To the same effect see Weener v. Brayton, 152 Mass. 101, 103; Avery v. Meikle, 81

Ky. 73, 91; Liggett & Myers Tobacco Co. v. Sam Reid Tobacco Co., 104 Mo. 53, 60; McLean v. Fleming, 96 U. S. 245, 251; Shaver v. Shaver, 54 Iowa, 208, 209; Barrows v. Knight, 6 R. I. 434, 438; Handy v. Commander, 49 La. Ann. 1119.

dies in trademark cases until the title to the trademark had been determined in a court of law. This practice continued until November 1, 1862, when the "Chancery Regulation Act, 1862,"⁴ went into effect. The first section of that act provides that "In all cases in which any relief or remedy within the jurisdiction of the said courts of chancery respectively is or shall be sought in any cause or matter instituted or pending in either of said courts, and whether the title to such relief or remedy be or be not incident to or dependent upon a legal right, every question of law or fact, cognizable in a court of common law, on the determination of which the title to such relief or remedy depends, shall be determined by or before the same court."

It is important to bear this enactment in mind in examining the earlier English trademark cases, as it explains the many failures of equity to act, or the deferring of relief by injunction until the determination of the right to the use of the trademark by trial at law.

Equity first extended its beneficent protection to the owners of trademarks because of the inadequacy of the remedy at law. This inadequacy arose from the absence of the power in courts of law to act *in personam*—the injunctive power. But there were other reasons why cognizance of trademark causes belonged peculiarly to equity. Prominent among these was the power of the chancellor in granting discovery—the right to discovery being, as Mr. Bispham says, one of the peculiar advantages of a complainant in equity, enjoyed by him in every case in which he was entitled to come into chancery, either for the purpose of asserting an equitable title, or setting up an equitable right or applying an equitable remedy;⁵ though the right was always conditioned by the necessary restriction that the person brought in

4—25 and 26 Victoria, c. 42, p. 154.

5—Bispham, Equity (4th ed.), p. 600, sec. 557.

on discovery need not disclose matters tending to incriminate him or expose him to penalty or forfeiture. And there was yet another reason why this litigation found its way to the chancellor. One of the most ancient forms of action at the common law was the action of account. "But," in the words of Mr. Justice Story, "the modes of proceeding in that action, although aided from time to time by statutable provisions, were found so very dilatory, inconvenient and unsatisfactory, that as soon as courts of equity began to assume jurisdiction in matters of account, as they did at a very early period, the remedy at law began to decline; and although some efforts have been made in modern times to resuscitate it, it has in England fallen into almost total disuse."⁶ So, when it became apparent that an account of profits must be sought as, at least, the basis of a proper money judgment against an infringer, the parties litigant were forced to enter the domain of equity. But, above all, there was that power in equity described by Blackstone as the power "to detect latent frauds and concealments, which the process of the courts of law is not adapted to reach."⁷ While not exclusive of the courts of law, the courts of equity had original, independent and inherent jurisdiction to relieve against every species of fraud.⁸

The remedy sought governs largely the question of jurisdiction in equity. If a mere accounting is sought for, it is insufficient to vest such jurisdiction, for the account must be incidental to some other equitable relief.⁹ Jurisdiction in equity will not attach for discovery simply, except in aid of a suit at law; the party ap-

6—Story, *Equity Jurisprudence* (13th ed.), sec. 442.

8—Kerr, *Fraud and Mistake* (Bump's ed.), p. 43.

7—1 Blackstone, *Commentaries*, 92.

9—Root v. *Railway Co.* 105 U. S. 189.

plying must invoke some other distinct equitable ground.¹⁰

§ 154. **The bill in equity.**—The bill for an infringement of a trademark or unfair competition properly consists of six parts:

1. The title of the court.
2. The introduction.
3. The statement.
4. The prayer for relief.
5. The interrogating part.
6. The prayer for process.

By the twenty-first federal equity rule, the plaintiff is given liberty to omit, at his option, the jurisdiction clause (*i. e.*, that the acts complained of are contrary to equity, and that the complainant is without any remedy at law), the charging part of the bill, setting forth the matters or excuses which the defendant is supposed to intend to set up by way of defense to the bill, and the common confederacy clause. The title of the court is given substantially as indicated in the preceding section on declarations at law, and rule 20 of the federal equity rules prescribes the form of the introductory part, which is a formal address to the judges of the court in which the bill is filed, together with the names and averments of the citizenship of the parties.

The stating part of the bill should show: (1) The ownership of the trademark, describing it and the mode of its application to merchandise. (2) The registration of that trademark under the act (if registered), and the value of the trademark. (3) The facts in relation to the infringement of the trademark by the respondent. This part of the bill differs from the corresponding part of the declaration at law in this, that it need not be averred that the defendant had guilty knowledge,¹¹ although that

10—Lord v. Whitehead & Atherton Machine Co., 24 Fed. Rep. 801.

11—McLean v. Fleming, 96 U. S.

fact should be averred where it is true. Where profits are sought to be recovered there should be a direct averment that such profits have been realized by the defendant on account of the infringement.

In every case where the value of the complainant's trademark is over two thousand dollars, that fact should be pleaded,¹² as a jurisdictional safeguard, independent of the fact of registration under the act of congress. A matter of paramount importance where the parties are citizens of the same state is an averment that the complainant uses his trademark in interstate commerce or commerce with foreign nations or with the Indian tribes,¹³ and under the act of 1881 it had to be averred and proven in such a case that the defendant had used the infringement in commerce with foreign nations or with the Indian tribes.¹⁴ Where the parties are of diverse citizenship no such averment is necessary.¹⁵ Whatever allegations are essential must be made positively and not on information and belief.¹⁶

The prayer for relief should be both special and general, under the directions given in the twenty-first federal equity rule. The special portion of the prayer should ask for a preliminary injunction (if it is desired), a perpetual injunction, for an account of the defendant's profits, and for an assessment of the damages sustained by the complainant by reason of the injuries he has sustained through the loss of reputation of his

12—Glen Cove Mfg. Co. v. Lude-
ling, 22 Fed. Rep. 823. A bill is
sufficient in this regard which re-
cites that "the amount in contro-
versy exceeds the sum of \$2000."
Griggs, Cooper & Co. v. Erie Pre-
serving Co., 131 Fed. Rep. 359, 360.

13—Ryder v. Holt, 128 U. S. 525;
Luyties v. Hollender (1), 21 Fed.
Rep. 281, 22 Blatchf. 413; Schu-
macher v. Schwenke (1), 26 Fed.

Rep. 818; Schumacher v. Schwenke
(2), 36 Off. Gaz. 457; Gravely v.
Gravely, 42 Fed. Rep. 265.

14—Gravely v. Gravely, 42 Fed.
Rep. 265; 52 Off. Gaz. 1538; War-
ner v. Searle & Hereth Co., 191 U.
S. 195.

15—Hennessy v. Braunschweiger
& Co., 89 Fed. Rep. 669.

16—Gaines & Co. v. Sroufe, 117
Fed. Rep. 965.

trademark or otherwise. A bill is not demurrable on the ground that it prays for damages in addition to profits, because both can be recovered where fraudulent intent is established.¹⁷ But punitive or exemplary damages should not be prayed for, as they cannot be assessed in equity.¹⁸ Where the bill charges the infringement of a registered mark the prayer should ask for an increase of the actual damages found, as provided in § 19 of the act of 1905.

The prayer for general relief should be in the form usual in equity pleading.¹⁹

17—*El Modelo Cigar Co. v. Gato*, 25 Fla. 886, 915; 7 So. Rep. 23; *Benkert v. Feder*, 34 Fed. Rep. 534.

18—*Hennessy v. Wilmerding-Loewe Co.*, 103 Fed. Rep. 90.

19—A bill to enjoin unfair competition must expressly charge that the defendant has attempted or intended to practice fraud upon the public. *Lamont v. Leedy*, 88 Fed. Rep. 72, 74. But this rule is hardly broad enough. The better doctrine would seem to be that the bill need only charge that the defendant's merchandise is calculated to deceive the public. Judge Lacombe, referring to the practice of the federal courts in cases of unfair trade, has said: "Nor do these courts require specific proof of purchases by individuals actually deceived, when the labels themselves show an attempt at deception which appears to be well calculated to deceive." *Collinsplatt v. Finlayson*, 88 Fed. Rep. 693. And the same learned court indicates the same rule in *Burnett v. Hahn*, 88 Fed. Rep. 694.

A bill to enjoin the manufacturer or vendor of spurious labels must contain an express charge

that the defendant is actually engaged in assisting third persons to palm off their goods upon the public as the goods of the complainant, or a substantially equivalent averment. *De Kuyper v. Witteman*, 23 Fed. Rep. 871; *Hennessy v. Herrmann*, 89 Fed. Rep. 669.

A bill to enjoin the infringement of a technical trademark must set up facts showing an exclusive right to the use of the mark in the plaintiff. He "must recover upon the strength of his own title, and not upon the weakness of the defendant's." *Brown, J.*, in *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576-579.

Improper joinder of causes of action.—A bill is multifarious that joins with a charge of unfair competition by the use of a trade-name a claim for damages under the Sherman anti-trust act of July 2, 1890. *Block v. Standard Distilling & Distributing Co.*, 95 Fed. Rep. 978.

A bill is multifarious that joins with a charge of unfair competition (by passing off the defendant's goods in unmarked packages

The form to be used in the interrogating part of the bill is prescribed by the forty-third federal equity rule. Rule 41 provides that the interrogatories be separated and numbered consecutively, and the interrogatories which each defendant is required to answer must be specified in a note at the foot of the bill. And that rule further provides that where the complainant in his bill waives an answer under oath, or only requires an answer under oath with regard to certain specified interrogatories, the answer of the defendant, though under oath, except such part thereof as shall be directly responsive to such interrogatories, shall not be evidence in his favor unless the cause be set down for hearing on bill and answer only.

The twenty-third federal equity rule provides that the prayer for process of subpoena shall contain the names of the defendants named in the introductory part of the bill, and if any of them are known to be infants under age, or otherwise under guardianship, shall state the fact so that the court may take order thereon, as justice may require, upon the return of the process.

The bill must contain the signature of counsel, as provided in the twenty-fourth federal equity rule.

Unless a preliminary injunction is prayed for the bill need not be verified.²⁰

These suggestions for the most part relate to bills in the federal circuit courts. The decisions of those courts are so harmonious that the great bulk of the trademark litigation is before them. As to the state courts, reference must necessarily be had to the local forms of action (or absence of such forms) created by legislative enactment.

as and for plaintiff's goods) a charge of patent infringement. *Ball & Socket Fastener Co. v. Cohn*, 90 Fed. Rep. 664.

20—*Hughes v. Northern Pacific Ry. Co.*, 18 Fed. Rep. 106, 110; *Black v. Allen*, 42 Fed. Rep. 618, 623.

Where affirmative relief is sought by a defendant, it should be prayed for in a cross-bill.²¹

§ 155. **The defenses in equity.**—All defenses good in the action at law are good in the action in equity except that of the innocence of the defendant of wrongful intent. In a case where both parties have the right to use the trademark, the defendant will be enjoined from using the words “the only genuine” in connection with the trademark.²² The plaintiff must, of course, be actually entitled to use the trademark having applied it commercially. Thus Sir James Clark’s application to restrain one Freeman from advertising or selling pills under the name of “Sir J. Clark’s Consumption Pills” was denied because the plaintiff was not engaged in the sale of pills.²³ The plaintiff may not be entitled to recover because of his not having an exclusive right to the mark; or because he has, without authority, used the words “patent” or “patented” in connection with or as a part of what he claims as his trademark. Or he may have made fraudulent representations in connection with his trademark which will prevent his recovering the relief sought for. A single act done at the sugges-

21—Corbin v. E. Taussig & Co., 132 Fed. Rep. 662; Hygienic Fleeced Underwear Co. v. Way, 133 Fed. Rep. 245.

22—James v. James, L. R. 13 Eq. Cas. 421; Cocks v. Chandler, L. R. 11 Eq. Cas. 446.

23—Clark v. Freeman, 11 Beav. 112. This decision is criticised in Maxwell v. Hogg, L. R. 2 Ch. App. 307; but it is manifestly correct in principle, considered as a trade-name case. Lord Justice Cairns says (L. R. 2 Ch. App. 310): “It has always appeared to me that Clark v. Freeman might have been

decided in favor of the plaintiff on the ground that he had a property in his own name,” *i. e.*, a right of privacy, which involves a discussion which it would be aside from our purpose to enter upon here. Lord Chancellor Selborne has criticised Clark v. Freeman from another standpoint, saying: “That case has been seldom cited but to be disapproved. Could not a professional man be injured in his profession by having his name associated with a quack medicine?” *Re Riviere’s Trademark*, L. R. 26 Ch. D. 53.

tion of the plaintiff's agent will not be treated as an infringement.²⁴

It often happens that the defendant may plead by way of mitigation of damages or so as to avoid his liability for an accounting or for costs.²⁵ Thus, in an English case, the defendants purchased five hundred cigarettes, worth only 17s. 6d., and which bore a mark which was an infringement of the plaintiff's. The court granted the application for injunction, but refused to order the defendants to pay costs, saying by Sterling, J.: "I confess I think this is not a sort of action that ought to be encouraged. If persons find a trademark is being pirated, surely it is not the small retailers who ought to be punished. . . . I cannot think that it is the duty of the court in every case in which a small dealer who has innocently happened to purchase a small quantity of the spurious goods, to fix him with the costs of an action."²⁶ A defendant who was printing labels for a third party did not know that the labels bore counterfeits of plaintiff's trademarks. On being notified of the fact of infringement, defendant offered to surrender the lithograph stone and promised to desist from further printing the counterfeit labels. The court adopted the same course as that taken by the English court in the last named case—granted an injunction but at complainant's costs.²⁷ This case shows that it is not wise to notify a defendant before suing. It has been expressly and repeatedly held that the defendant is not entitled to notice,²⁸ and it is related by Chitty, J., that

24—*Hennessy v. Kennett*, Seb. Guest, 9 R. P. C. 218; L. R. (1892) 556; *Gorham Mfg. Co. v. Emery-Bird-Thayer Co.*, 92 Fed. Rep. 774; L. T. 257; 40 W. R. 364; *Cartmell, Hostetter Co. v. Brunn*, 107 Fed. 45.

Rep. 707.

27—*Bass v. Guggenheimer*, 69

25—*Guilhon v. Lindo*, 9 Bos. 605; Fed. Rep. 271.

Cox' American Trademark Cases, 295.

28—*Upmann v. Forester*, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946;

26—*American Tobacco Co. v.* 49 L. T. 122; 32 W. R. 28.

when that very learned jurist, the late Sir G. Jessel, master of the rolls, was at the bar, it was his custom to advise his clients in trademark actions not to give any notice but to move at once.²⁹

These suggestions are given here to call the attention of the practitioner whose duty is to defend the alleged infringer to the very serious question of avoiding costs.

It may be possible to defend successfully on the ground that, although the plaintiff has applied his trademark in commerce, he has not applied it to the same character or class of merchandise as that to which the defendant is applying it. We have touched upon this question before, but a more extended consideration of it may be advisable. To answer the question of whether the defendant's use of the complainant's trademark is such an unlawful use that it should be restrained, "the extent of the owner's property in a trademark, and the character of the act which is held to injuriously affect his property rights, and to call for the interposition of a court of equity, must be ascertained. . . . The deceit of the public and the subsequent injury to it are as much to be regarded by a court of equity as an injury to a plaintiff's business. It therefore follows that the right of an owner of a trademark is not a right to its exclusive use everywhere and under all circumstances."³⁰ Thus, an iron manufacturer using a lion's head as his trademark cannot enjoin a linen manufacturer from using a lion's head as his mark.³¹ It was held that "Fruit Salt" as a trademark for an effervescing drink, a registered mark, might be interfered with by the words "Fruit Salt" designating a baking powder. In this case it was shown that the "Fruit Salt" used in producing the effervescing drink had been used as a

29—Upmann v. Forester, L. R. Mfg. Co. v. Read, 47 Fed. Rep. 712-714.
24 Ch. D. 231-235.

30—Shipman, J., in Celluloid 31—Ainsworth v. Walmsley, 35 L. J. Ch. 352.

baking powder, in exceptional cases; but the court remarked that if it were proposed to so employ the words "Fruit Salt" that "no reasonable person could suppose that they had reference to the appellant's preparation, such a use would be perfectly unobjectionable. For example, I cannot conceive any one imagining that a "Fruit Salt Umbrella" was in any way connected with the article manufactured by Mr. Eno (the effervescing drink)."³² So it has been held in this country that the word "Celluloid" is a valid trademark as applied to articles actually composed of celluloid,³³ but that the use of the word "Celluloid" to designate a starch is not an infringement, because celluloid had never been used in making starch and there was no testimony to show that the plaintiff had intended ever to use it in making starch. There was expert testimony to the effect that it was highly probable that a method might be devised by which celluloid could be converted into a starch-like body fit for use as a substitute for starch, but the court held this statement of probabilities "too indefinite to be the foundation of an injunction."³⁴ The whole question depends upon how closely related are the classes of goods to which the complainant and respondent apply the mark.³⁵

The other defenses, beside those thus far indicated, such as license from the owner or his co-proprietor in the mark, delay, acquiescence or abandonment, have been treated in connection with the defenses at law. But it is proper to note here that where the complainant has

32—Lord Herschell in *Eno v. How*, Pr. 297; *Carroll v. Ertheiler*, Dunn, L. R. 15 App. Cas. 252, 260. 1 Fed. Rep. 688; *Hecht v. Porter*,

33—*Celluloid Mfg. Co. v. Cel-* 9 Pac. C. L. J. 569; *Osgood v.*
lonite Mfg. Co., 32 Fed. Rep. 94. *Rockwood*, Fed. Case No. 10605, 11

34—*Celluloid Mfg. Co. v. Read*, Blatch. 310; *Smith v. Reynolds*,
47 Fed. Rep. 712, 716. Fed. Case No. 13098, 10 Blatchf.

35—*Collins Co. v. Ames*, 20 100; 13 Blatchf. 458; *Swift & Co.*
Blatchf. 542; 18 Fed. Rep. 561; *v. Groff*, 114 Fed. Rep. 605.

Amoskeag Mfg. Co. v. Garner, 54

been guilty of serious laches his relief will be limited to the injunction, and an accounting will be refused.³⁶

Where the bill of complaint makes profert of the plaintiff's trademark and exhibits the alleged infringement, a demurrer will be sustained if an inspection of the exhibits satisfies the court that there is no infringement.³⁷

Where the defendant undertakes to defend by attacking the complainant's title to the mark and fails, the Supreme Court of Louisiana has held that he should be treated as a wanton trespasser.³⁸

But the courts are not inclined to sustain demurrers upon the ground that the plaintiff's mark is not a valid technical trademark, where the bill contains the specific charge that the defendant has, by its conduct in the premises, deceived and misled the public into buying its goods as and for the plaintiff's goods.³⁹ A defect upon the face of the bill, such as a failure to show title to the mark in a complainant, must be met by demurrer and cannot be raised by a plea.⁴⁰

There are a number of lines of defense which have been ineffective. Among them are to be particularly noted the following:

1. Infancy.⁴¹
2. The registration of defendant's mark, because registration is only *prima facie* evidence of ownership.⁴²
3. Laches or delay, except in unusual cases.⁴³

36—Holt v. Menendez, 23 Fed. Rep. 869, 871; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 106 Fed. Rep. 498.

37—Handy v. Commander, 49 La. Ann. 1119, 22 So. Rep. 230.

38—Collins Chemical Co. v. Capital City Mfg. Co., 42 Fed. Rep. 64.

39—Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800.

40—Hostetter Co. v. E. G. Lyons Co., 99 Fed. Rep. 734.

41—Chubb v. Griffiths, 35 Beav. 127.

42—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; 23 Blatchf. 46; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206, 209, 212.

43—McLean v. Fleming, 96 U. S.

4. Showing that defendant always placed his own address upon his goods, in conjunction with the infringing mark.⁴⁴
5. Showing that defendant has always used his own name or initials in conjunction with the infringing mark. This is not, of itself, a good defense.⁴⁵
6. Showing that defendant has always used the word "Improved" in addition to the alleged infringing words.⁴⁶
7. Showing that the defendant's goods are not inferior in quality to the complainant's.⁴⁷
8. Showing that the goods sold are goods made by the complainant, if they are goods to which the complainant did not intend the mark to be applied.⁴⁸

245; *Lee v. Haley*, L. R. 5 Ch. App. 155. See *ante*, § 75.

44—*Gray v. Taper-Sleeve Pulley Works*, 16 Fed. Rep. 436-442.

45—*Menendez v. Holt*, 128 U. S. 521; *Battle v. Finlay*, 50 Fed. Rep. 106; *N. K. Fairbank Co. v. Central Lard Co.* 70 Off. Gaz. 635; 64 Fed. Rep. 133; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Hier v. Abrahams*, 82 N. Y. 519; *Fleischmann v. Schuckmann*, 62 How. Pr. 92; *Lea v. Wolff*, 15 Abb. Pr. N. S. 1; *Carroll v. Ertheiler*, 1 Fed. Rep. 388; *Hegeman v. O'Byrne*, 9 Daly, 264; *Pratt's Appeal*, 117 Pa. St. 401; *Walter Baker & Co. v. Baker*, 87 Fed. Rep. 209; *Bass, Ratcliff & Gretton (Ltd.) v. Feigen-span*, 96 Fed. Rep. 206-210; *Leonard v. White's Golden Lubricator Co.*, 38 Fed. Rep. 922; *Gillott v. Esterbrook*, 47 Barb. 455; *Dunlap & Co. v. Young*, 74 N. Y. Supp. 184.

46—*Russia Cement Co. v. LePage*, 147 Mass. 206; 17 N. E. Rep.

304; *Gage v. Canada Pub. Co.*, 11 Can. S. C. R. 306; *Improved Fig Syrup Co. v. California Fig Syrup Co.*, 54 Fed. Rep. 175; 4 C. C. A. 264.

47—*Cleveland Stone Co. v. Wallace*, 52 Fed. Rep. 431-436; *Taylor v. Carpenter* (3), 11 Paige, 292; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Partridge v. Menck*, 2 Sandf. Ch. 622; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Shaver v. Shaver*, 54 Iowa, 208; *Coffeen v. Brunton*, 5 McLean, 256; *Gillott v. Esterbrook*, 47 Barb. 455; 48 N. Y. 374; *Singer Mfg. Co. v. Loog* (3), L. R. 8 App. Cas. 15; *Edelsten v. Edelsten*, 1 DeG. J & S. 185; *Blofield v. Payne*, 4 B. & Ad. 410.

48—*Krauss v. Jos. R. Peebles' Sons Co.*, 58 Fed. Rep. 585; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225; *Gillott v. Kettle*, 3 Duer, 624; *Hennessy v. Kennett*, Seb. 556.

9. Showing that the defendant did not intend to sell the goods bearing the infringing mark.⁴⁹
10. Showing that the complainant's mark has been used by others without his knowledge, consent or acquiescence,⁵⁰ for "a trespasser cannot justify upon the ground that others have committed like trespasses."⁵¹
11. Showing that the same mark has been used by others on goods of another class.⁵²
12. Showing that a third person used the trademark prior to its appropriation by the complainant, when that third person has been refused relief in equity against infringers, because of fraudulent representations made by him in using the mark.⁵³
13. Showing that the infringing act was done by the defendant's servants, agents or employees without his knowledge.⁵⁴
14. Showing that defendant partners have incorporated after the institution of the suit.⁵⁵

49—Upmann v. Forester, L. R. 24 Ch. D. 231; Upmann v. Curry, 29 Sol. J. 735.

50—Cuervo v. Jacob Henkell Co., 50 Fed. Rep. 471; Filley v. Fassett, 44 Mo. 173; Cox, 530; Taylor v. Carpenter (1), 3 Story, 458; Cox, 14; Seb. 78; Ford v. Foster, L. R. 7 Ch. App. 611.

51—Actiengesellschaft Vereinigte Ultramarin-Fabriken v. Amberg, 48 C. C. A. 264, 109 Fed. Rep. 151. Reversing same v. same, 102 Fed. Rep. 551.

52—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Colman v. Crump, 70 N. Y. 573; Hegeman v. O'Byrne, 9 Daly, 264; Somerville v. Schembri, L. R. 12 App. Cas. 453-457; Ainsworth v.

Walmsley, L. R. 1 Eq. 518; Hall v. Barrows, 4 DeG. J. & S. 150; George v. Smith, 52 Fed. Rep. 830.

53—Parlett v. Guggenheimer, 67 Md. 542-544. The rights of the third party had been so adjudicated in Palmer v. Harris, 60 Pa. St. 156.

54—Low v. Hart, 90 N. Y. 457; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Tonge v. Ward, 21 L. T. N. S. 480; Atkinson v. Atkinson, 85 L. T. Jour. 229. But see Leahy v. Glover, 10 R. P. C. 141, where a single sale by defendant's clerk was held insufficient to warrant injunction.

55—American Fibre Chamois Co. v. De Lee, 67 Fed. Rep. 329.

15. Showing that the complainant gave the defendant no notice of his intention to bring suit.⁵⁶
16. Showing that a proper name alleged to be an infringement is the name of a person connected with defendant's business, when in fact such person has only given defendant permission to use his name as a means of attracting trade from the complainant, in pursuance of defendant's scheme to fraudulently take away complainant's business.⁵⁷
17. Showing that plaintiff has added words, figures or designs, such as a coat-of-arms, to the trademark as registered.⁵⁸
18. Showing that the complainant's trademark or package is only partially copied or imitated in defendant's mark or package.⁵⁹

56—*Coats v. Holbrook*, 2 Sandf. Ch. 586; *Cox*, 20; *Sawyer v. Kellogg*, 9 Fed. Rep. 601-602; *Upmann v. Forester*, L. R. 24 Ch. D. 231-235; *Cartmell*, 331; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130; *Burgess v. Hately*, 26 Beav. 249; *Seb*, 169; *Field v. Lewis*, *Seton* (4th ed.), 237; *Seb*, 280; *Re Kuhn*, 53 L. J. Ch. 238; *Barrett v. Goom*, 74 L. T. Jour. 388; *Fennessy v. Day*, 55 L. T. N. S. 161; *Siegert v. Lawrence*, 11 Vic. L. R. 47. See, *contra*, *Wallis v. Wallis*, 4 Dr. 458; *Twentsche Stoom Bleekery Goor v. Ellinger*, 26 W. R. 70; *Chappell v. Davidson*, 2 K. & J. 123; *Williams v. Osborne*, 13 L. T. N. S. 498; *Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co.*, 92 Fed. Rep. 774-778.

57—*Sawyer v. Kellogg*, 7 Fed. Rep. 720; *Price & Steuart*, 493; 9 Fed. Rep. 601; *Rogers Mfg. Co. v. Rogers Mfg. Co.*, 11 Fed. Rep. 495; *Williams v. Brooks*, 50 Conn. 278;

Meriden Britannia Co. v. Parker, 39 Conn. 450; 12 Am. Rep. 401; *Garrett v. T. H. Garrett & Co.*, 24 C. C. A. 173, 78 Fed. Rep. 472; *Phalon v. Wright*, 5 Phila. 464; *Cox*, 307; *Wolfe v. Barnett*, 24 La. Ann. 97; 13 Am. Rep. 111; *Melachrino v. Melachrino Cigarette Co.*, 4 R. P. C. 215; *Cartmell*, 223; *Perks v. Hall*, W. N. 1881, p. 111; *Williams v. Johnson*, 2 Bos. 1.

58—*Melachrino v. Melachrino Cigarette Co.*, 4 R. P. C. 215; *Cartmell*, 223; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. N. S. 31; *Cartmell*, 242; *Carroll v. Ertheiler*, 1 Fed. Rep. 688-691.

59—*McCann v. Anthony*, 21 Mo. App. 83; *Enoch Morgan's Sons Co. v. Edler*, *Cox*, Manual, 714; *Taendsticksfabriks Aktiebolaget Vulcan v. Myers*, 139 N. Y. 364; *Pillsbury v. Pillsbury-Washburn Mills Co.*, 12 C. C. A. 432, 64 Fed. Rep. 841; *Centaur Co. v. Killenberger*, 87 Fed. Rep. 725.

'As by the use of but one of several words composing the plaintiff's mark.'⁶⁰

"The reports are full of cases where bills have been sustained for the infringement of one of several words of a trademark."⁶¹

19. Showing that complainant has been guilty of misrepresentation in connection with his use of the trademark, where that misrepresentation consists only in harmless exaggeration of the merits of his product (puffing);⁶² or in purely collateral representation, as by newspaper advertising;⁶³ or in regard to the size of packages used by him, where the sizes of those packages are the ordinary sizes known to the trade, the capacity of which is generally understood.⁶⁴

Generally, as to the defense that the complainant has been guilty of misrepresentation, Judge Sanborn has said "the principle 'that he who comes into equity must do so with clean hands' is familiar and indisputable. But it does not repel all sinners from courts of equity, nor does it disqualify any complainant from obtaining relief there who has not dealt unjustly in the very transaction concerning which he complains. The iniquity which will repel him must have an immediate and necessary relation to the equity for which he sues."⁶⁵ Thus,

60—*Saxlehner v. Eisner & Mendelson Co.* (3), 179 U. S. 19-33.

61—*Mr. Justice Brown in Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 33; citing *Shrimpton v. Laight*, 18 Beav. 164; *Clement v. Maddick*, 1 Giff. 98; *Hostetter v. Vowinkle*, 1 Dill. 329, Fed. Cas. No. 6,714; *Morse v. Worrell*, 10 Phila. 168, 9 Am. L. Rev. 368; *Grillon v. Guenin*, Weekly Notes (1877), 14; *American Grocer Pub. Asso. v. Grocer Pub. Co.* 25 Hun, 398.

62—*Comstock v. White*, 18 How.

Pr. 421; *Cox*, 232; *Metzler v. Wood*, L. R. 8 Ch. D. 606; *Seb.* 587; *Holloway v. Holloway*, 13 Beav. 209; *Seb.* 106; *Ellis v. Zeilen*, 42 Ga. 91.

63—*Curtis v. Bryan*, 36 How. Pr. 33; 2 *Daly*, 212; *Cox*, 434; *Seb.* 291.

64—*Hennessy v. Wheeler*, 51 How. Pr. 457; 69 N. Y. 271; 15 Alb. L. J. 454; *Seb.* 483.

65—*Shaver v. Heller & Merz Co.*, 48 C. C. A. 48, 108 Fed. Rep. 821, 834. Citing *Dering v. Earl of Winchelsea*, 1 Cox, Ch. 318, 319; *Lewis & Nelson's Appeal*, 67 Pa. 153, 166; *Bateman v. Fargason*,

the use of the word "copyright" in connection with a tradename when no copyright actually exists, has been held not to disentitle the owner from relief in equity,⁶⁶ and so of statements of opinion concerning the curative properties of a medical compound to which the trademark is applied.⁶⁷ But the statement on the label of a small-pox remedy, "cures the worst cases without marking," is sufficient to disentitle the complainant from relief.⁶⁸

20. Showing that the infringement has ceased.⁶⁹

21. Showing that the complainant has made a third party his licensee for the territory in which the infringement was committed.⁷⁰

22. Showing that the defendant has made no sales of goods bearing the infringing mark, where it appears that he would have done so had the suit not been instituted.⁷¹

"Proof of injury is unnecessary if the evidence establish the fact that injury will result unless such use (of the infringing mark) will be restrained."⁷² "The infringement of a trademark implies injury."⁷³

23. Showing that the defendant is merely a dealer who has purchased from the originator of the infringement,⁷⁴ or merely the agent of another in the sale of the infringing goods.⁷⁵

4 Fed. Rep. 32, 33. To the same effect see *Frazier v. Dowling*, 18 Ky. L. Rep. 1109, 39 S. W. Rep. 45.

66—*Wormser v. Shayne*, 11 Ill. App. 556.

67—*Newbro v. Undeland*, Neb. —, 96 N. W. Rep. 635.

68—*Houchens v. Houchens*, 95 Md. 37, 51 Atl. Rep. 822.

69—*Frese v. Bachof*, Fed. Case No. 5110, 13 Blatchf. 234; *Burnett v. Hahn*, 88 Fed. Rep. 694; *Hutchinson v. Blumberg*, 51 Fed. Rep. 829-831; *Clark Thread Co. v. Wm. Clark Co.* (1), 55 N. J. Eq. 658, 37 Atl. Rep. 599.

70—*Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205.

71—*Cuervo v. Landauer*, 63 Fed. Rep. 1003; *McLean v. Fleming*, 96 U. S. 252.

72—*Maddox, J.*, in *Brown v. Braunstein*, 83 N. Y. Supp. 1096.

73—*Thomas, J.*, in *Lanahan v. John Kissel & Son*, 135 Fed. Rep. 899.

74—*Burnett v. Hahn*, 88 Fed. Rep. 694.

75—*Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889, 26 C. C. A. 220.

24. Showing that the defendant once held a license from the plaintiff, permitting the use of the mark, when that license has been revoked for failure to pay royalties and other breaches of the licensing contract.⁷⁶
25. Showing that there has been an adjudication against the plaintiff in a court of a foreign country. The subject-matter, in cases of the classes treated in this work, is a tort. Such subjects are not concluded by foreign adjudications, even when the acts referred to are the same identical acts.⁷⁷
26. Showing that the defendant was insane at the time of the commission of the infringing acts.⁷⁸
27. Showing the defendant's innocence of guilty knowledge or fraudulent intent.⁷⁹
28. Showing that defendant has used plaintiff's mark only in connection with matter explanatory of its use (as where the plaintiff marked his goods "Akron Dental Rubber" and defendant marked his as "Non-Secret Dental Vulcanite, made according to our analysis of the Akron Dental Rubber," the words "Akron Dental Rubber" being printed in red, from large type), where the added matter is a mere evasive attempt to hide the similarity.⁸⁰
29. Showing that the plaintiff is a party to a combination in restraint of trade.⁸¹ "It does not tend to foster monopoly to sustain the right, if one has acquired it, to the exclusive use of a trademark."⁸²

76—Martha Washington Creamery Buttered Flour Co. v. Martien, 44 Fed. Rep. 473.

77—Hohner v. Gratz, 50 Fed. Rep. 369; City of Carlsbad v. Kutnow, 68 Fed. Rep. 794.

78—Avery v. Wilson, 20 Fed. Rep. 856.

79—Saxlehner v. Siegel-Cooper Co., 179 U. S. 42; Colman v. Crump, 70 N. Y. 573; Taendsticks-

fabriks Aktiebolaget Vulcan v. Myers, 139 N. Y. 364, 34 N. E. Rep. 904.

80—Keller v. B. F. Goodrich Co., 117 Ind. 556; 19 N. E. Rep. 196.

81—General Electric Co. v. Re-
new Lamp Co., 128 Fed. Rep. 154,
156.

82—Gray, J., in Independent Baking Powder Co. v. Boorman, 130 Fed. Rep. 726.

§ 156. **The relief in equity.**—In regard to making an application for a preliminary injunction in cases of unfair trade or trademark infringement, it should be remembered that wherever there is any doubt as to the plaintiff's right or the defendant's infringement, the application *pendente lite* will be denied.⁸³ Accordingly the courts have refused to grant the preliminary injunction where it appeared probable that the plaintiff had never acquired the exclusive right to use the mark,⁸⁴ but held it as a tenant in common with another;⁸⁵ where there existed a doubt whether the words claimed as trademarks by the plaintiff ("Pile Leclancha" and "Disque," applied to electric batteries) were or were not merely descriptive words;⁸⁶ where the facts indicated that the complainant was possibly guilty of laches;⁸⁷

83—"An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question it is at times an appropriate remedy in the prevention of great wrong, but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and generally, where the injury may be measured in money, the alleged wrong-doer should be shown to be unable pecuniarily to respond." Jenkins, J., in *American Cereal Co. v. Eli Pettijohn Cereal Co.*, (2), 22 C. C. A. 236, 76 Fed. Rep. 372-374. To the same effect, see *Smith-Dixon Co. v. Stevens*, Md., 59 Atl. Rep. 401.

In refusing to grant a preliminary injunction Mr. Justice Bradley, on circuit, said: "My great reluctance to grant a preliminary injunction for suppressing the use of a business name or trademark, in any case in which the matter

in issue is a subject for fair discussion, induces me to withhold the order." *Celluloid Mfg. Co. v. Cellonite Mfg. Co.*, 32 Fed. Rep. 94-102. And to the same effect see *Van Camp Packing Co. v. Cruikshanks Bros. Co.*, 90 Fed. Rep. 814; 33 C. C. A. 280; *Charles E. Hires Co. v. Consumers' Co.*, 41 C. C. A. 71, 100 Fed. Rep. 809, 813; *Goldstein v. Whelan*, 62 Fed. Rep. 124.

84—*Societe des Huiles D'Olive de Nice v. Rorke*, 31 N. Y. Supp. 51.

85—*American Cereal Co. v. Eli Pettijohn Cereal Co.*, 76 Fed. Rep. 372, 22 C. C. A. 236.

86—*Laclancha Battery Co. v. Western Electric Co.*, 21 Fed. Rep. 538. Same of "air-cell" and "fire-board" applied to fire-proofing material. *New York Asbestos Mfg. Co. v. Amber Asbestos Air-cell Covering Co.*, 99 Fed. Rep. 85, affirmed, 43 C. C. A. 46, 102 Fed. Rep. 890.

87—*Estes v. Worthington*, 22 Fed. Rep. 822.

and where the defendant's affidavits created a doubt in the mind of the court as to whether the plaintiff had been the exclusive user of the symbols claimed by him as his trademark.⁸⁸ A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case,⁸⁹ particularly where the defendant is financially able to respond for damages.⁹⁰ A mandatory injunction pending the suit is not granted except in extreme cases where the right thereto is clearly established and it appears that irreparable injury will follow from its refusal.⁹¹

So when the court has reason to doubt that the defendant has been guilty of acts amounting to an invasion of the plaintiff's trade rights, a preliminary injunction will not be issued.⁹² But while refusing the interlocutory injunction, the court may, in its discretion, require the defendant to keep an account, pending the suit, of all his dealings in goods bearing the alleged infringing mark; as Judge Treat said in making such an order: "It will not hurt him to keep an account."⁹³

It is sufficient to sustain the application for the preliminary injunction (so far as the plaintiff's title to the mark is concerned) if he has established his right to the trademark in a former proceeding.⁹⁴ While the decision in such former proceeding is not conclusive and binding upon the court in the later case, it is persuasive and of

88—French v. Alter & Julian Co., 74 Fed. Rep. 788; Leclancha Battery Co. v. Western Electric Co., 21 Fed. Rep. 538; Portuondo v. Monne, 28 Fed. Rep. 16; Davis v. Davis, 27 Fed. Rep. 490.

89—New York Asbestos Mfg. Co. v. Amber Asbestos Air-cell Covering Co., 99 Fed. Rep. 85; Lare v. Harper & Bros., 86 Fed. Rep. 481; 30 C. C. A. 373.

90—H. Mueller Mfg. Co. v. A. Y. McDonaly & Morrison Mfg. Co., 132 Fed. Rep. 585, 588.

91—Hagen v. Beth, 118 Cal. 330.

92—Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44; Whiting Mfg. Co. v. Jos. H. Bauland Co., 56 N. Y. Supp. 114.

93—Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44. For a similar order, see Cantrell & Cochrane, Ltd., v. Wittemann, 109 Fed. Rep. 82.

94—Symonds v. Greene, 28 Fed. Rep. 834, 835; Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248.

great weight, and on the motion for a preliminary injunction, especially where it sustains the impression of the court upon the hearing, is decisive.⁹⁵ Where a demurrer is interposed to the bill, upon the application for preliminary injunction, the allegations of fraud in the bill are confessed thereby; and if the demurrer is overruled the complainant is entitled to the preliminary injunction.⁹⁶

Upon granting a preliminary injunction bond may be required of the complainant.

Where such a bond was given, conditioned for "the payment of all damages and costs to be awarded against the complainant and in favor of the defendant upon the trial or final hearing," a demurrer was sustained to a declaration setting forth the obligee's claim to damage, because no damages were awarded on the final hearing.⁹⁷ The Supreme Court has commended, as a proper condition of such bonds, one which ran "to answer all damages which the defendant in that suit might sustain in consequence of said injunction being granted, should the same be thereafter dissolved."⁹⁸

It is a general rule in the law of unfair trade, as well as in patent law, that where the infringement is admitted or proven the plaintiff is entitled to a reference for an accounting as a matter of right.¹ But "cases frequently arise where a court of equity will refuse the prayer of the complainant for an account of gains and profits, on the ground of delay in asserting his rights,

95—Price Baking Powder Co. v. Bein v. Heath, 12 How. 168, as controlling his decision.
Fyfe, 45 Fed. Rep. 799.

96—Enoch Morgan's Sons Co. v. Hunkele, 16 Off. Gaz. 1092, 1093. 98—Bein v. Heath, 12 Howard, 168-177.

97—Beakin v. Stanton, 3 Fed. Rep. 435. In his opinion Judge Blodgett calls attention to the wide conflict of authority in the decisions of the courts of the several states upon this subject, and cites 1—Oakes v. Tonsmierre, 49 Fed. Rep. 447-453; Campbell Printing Press Co. v. Manhattan R. Co., 49 Fed. Rep. 930-932; Fisk v. Mahler, 54 Fed. Rep. 528.

even when the facts proved render it proper to grant an injunction to prevent future infringement.”²

In case of unfair competition, though the facts justify injunction, there can be no money judgment for damages unless the defendant has been found guilty of fraudulent intent.³

“In England the rule is stringent in trademark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trademark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrong-doer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge is brought home to the complainant.”⁴

It is now the rule in England, as we have seen in our discussion of the question of damages at law, that upon the injunction being entered in the action in equity the complainant is compelled to elect between profits and damages; he cannot have both. If he elects to take his damages, the issue is sent to the Queen’s Bench division to be tried by a jury.⁵ In our federal courts, however, there is no provision for transferring the case from the equity side to the law side after the entry of the interlocutory decree, nor any other provision for submitting the issue of damages, in an equity case, to a jury. The plaintiff is not compelled to elect between profits and damages, but the reference is made to the master in chancery to take an account of the defendant’s profits and to make an assessment of the damages sus-

2—Mr. Justice Clifford in *McLean v. Fleming*, 96 U. S. 245-257. 200, 202.

To the same effect see *Low v. Fels*, 35 Fed. Rep. 361-363.

3—*N. K. Fairbank Co. v. Wind-*

sor, 61 C. C. A. 233, 124 Fed. Rep.

4—*Nixon, J., in Sawyer v. Kellogg*, 9 Fed. Rep. 601.

5—*Fennessy v. Rabbits*, 56 L. T. 138; *Cartmell*, 125.

tained by the plaintiff.⁶ In assessing damages the master will consider the extent to which plaintiff's sales have fallen off, if the defendant's acts are the cause of such falling off.⁷

It was held in one case that the profits due to the use of the trademark only were the subject of inquiry.⁸ But this was clear error, and the court laying down this rule cited in support of it only one precedent and that a patent case.⁹ This question was considered very carefully by the supreme court of California, and its conclusion is as follows: "Every consideration of reason, justice and sound policy demands that one who fraudulently uses the trademark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trademark, on the plea that it is impossible to determine how much of the profit is due to the trademark, and how much to the intrinsic value of the commodity." The supreme court held, therefore, that the trial court had not erred in awarding the plaintiff the whole profit made by the defendant.¹⁰ In treating the same subject, Judge Sawyer said: "To adopt as the measure of compensation for such injuries the difference between the price for which the spurious goods would sell without the trademark and for which they would sell with it imprinted thereon, would be a mockery of justice. In my judgment the infringer should at least account for the entire profits made upon the goods wrongfully sold with the trademark impressed upon them."¹¹ This now appears to be the accepted rule.¹²

6—The Collins Co. v. Oliver Case No. 6714; 1 Dill. 329; Cox, Ames & Sons Corporation, 18 Fed. Manual, No. 207.

Rep. 561-571; Benkert v. Feder, 34 8—Atlantic Milling Co. v. Rowland, 27 Fed. Rep. 24.

Fed. Rep. 534, 535; Sawyer v. Kellogg, 9 Fed. Rep. 601, 602; Sawyer v. Horn, 1 Fed. Rep. 24-39. To 9—Garretson v. Clark, 111 U. S. 120.

the same effect see Clark Thread Co. v. William Clark Co., (2) 56 10—Graham v. Plate, 40 Cal. 593-599.

N. J. Eq. 739, 40 Atl. Rep. 686. 11—Benkert v. Feder, 34 Fed.

7—Hostetter v. Vowinkle, Fed. Rep. 534.

Counsel fees expended by plaintiff in the cause are not an element of damage, and cannot be considered in assessing damages in equity.¹³

The court will refuse to decree an accounting where it is manifestly impossible to segregate the profits arising from the infringement.¹⁴

In jurisdictions where the master is permitted to assess damages, he may do so even in the absence of any direct proof of loss of profit.¹⁵ As all participants in torts are principals, one who participates in unfair trade by furnishing fraudulent labels is liable in equity to the party injured for the whole damage resulting from the unfair competition.¹⁶

§ 157. **Punitive damages in equity.**—"The question of the true measure of damages in cases of this sort is an interesting one. The injured party is entitled to full compensation for the injury, but how shall that be measured? Manifestly, the profits which the infringer has made would not in all cases be compensation to the injured. The latter's loss in part inheres in the failure to acquire a just and deserved gain; also in the injury to the reputation of his product by reason of the substitu-

12—Saxlehner v. Eisner & Mendelson Co., 138 Fed. Rep. 22.

13—Burnett v. Phalon (1), 21 How. Pr. 100; Cox' American Trademark Cases 292.

14—Ludington Novelty Co. v. Leonard, 62 C. C. A. 269, 127 Fed. Rep. 155.

15—Thus in a chancery case in New Zealand the court said: "First as to damages, I am of opinion that there has been no direct proof of loss of profit by Messrs. Littlejohn & Son, consequent upon the sale of the watches which improperly have their name inscribed upon them, but, as I have intimated during the course of the ar-

gument, it appears to me that, apart from any direct proof of loss of profit, there arises in cases of this class an inference of possible damage to the manufacturer whose name is improperly used—damage to his well established reputation. It is impossible that the quantum of damage in cases of this class can be mathematically ascertained; no account can possibly reach such a matter. It must always be a matter of discretion for the court and jury." Littlejohn v. Mulligan, 3 New Zealand Rep. 446.

16—Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

tion of the spurious article. The latter element is difficult, if not impossible of accurate admeasurement. It can only be approximately compensated by an allowance in the nature of punitive damages, resting largely in discretion."¹⁷ This happens to be merely a *dictum*, as the issue was not before the court. But it is the statement of a sound principle, though one difficult of practical application, and is flatly opposed to *Hennesy v. Wilmerding-Loewe Co.*,¹⁸ which denies the right to recover punitive damages in equity in this class of cases.

§ 158. Increase of damages in equity.—Section 19 of the Act of 1905 provides that: "Upon a decree being rendered in any such case for wrongful use of a trademark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby. . . . The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law."

This provision was doubtless intended to enable the trial court, having regard to the questions of fraudulent intent and guilty knowledge of the defendant, to assess damages by way of punishment, in addition to those damages found by the Master to have been actually sustained by the complainant.

§ 159. The defendant's credits upon accounting.—Section 19 of the Act of 1905 provides that "In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed."

These provisions are evidentiary, shifting the burden of proof upon the defendant, after the complainant has

¹⁷—Jenkins, J., in *Walter Baker & Co. v. Slack*, 130 Fed. Rep. 514, 519, 65 C. C. A. 138.

¹⁸—103 Fed. Rep. 90.

proven the extent of sales, to establish such credits or off-sets as he may be entitled to.

Where the defendant carried on the infringing traffic in connection with his regular business, it has been held, the master in chancery will not make any deduction for expenses in taking the account of profits;¹⁹ but two later cases hold directly to the contrary.²⁰

§ 160. **Label designing as a judicial function.**—The willingness of courts of equity to aid in maintaining fairness in competition has been evidenced by a label designed by Judge Coxe and exhibited with his opinion in a case involving the word “Carlsbad” as applied to mineral water, with the statement that “in order that there may be no misunderstanding upon the settlement of the decree, the court has applied a copy of a label which, it is thought, the defendant may use with impunity as truthfully representing the water sold by him.”²¹

In another case, Judge Lacombe, in offering alternative forms of decree for the choice of a defendant, said “the mandate will, if defendant prefers, direct a modification of the interlocutory decree solely by requiring the affixing upon every package sold, in type as prominent as the title, of the statement that “W. H. Baker is distinct from and has no connection with the old chocolate manufactory of Walter Baker & Co.’ ”²² The Court of Appeals of the Seventh Circuit has criticised this practise, Judge Jenkins observing that “The court below, upon holding that the changed label of the defendant infringed the complainant’s right, caused to be submitted for its approval another form of label, which it approved,

19—*Societe Anonyme v. Western Distilling Co.* 46 Fed. Rep. 921.

20—*Walter Baker & Co. v. Slack*, 65 C. C. A., 138, 130 Fed. Rep. 514, 520; *Saxlehner v. Eisner & Mendelson Co.*, 138 Fed. Rep. 22.

21—*City of Carlsbad v. Schultz*, 78 Fed. Rep. 469, 472.

22—*Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889, 895, 26 C. C. A. 220.

and authorized the defendant to use upon bottles of the same form as those used by the complainant. We greatly doubt the propriety of such action. When an infringement has been found, it should be restrained. A court of equity does not sit as an arbiter to determine in advance upon other and changed labels which the infringer may adopt to avoid the condemnation of the court. Whether such changed forms do in fact infringe is matter of fact to be determined by the court in its usual course of procedure upon complaint lodged by the party damnified. The duty of the court below was to determine whether the labels complained of in the bill infringed the complainant's right. That duty was fully performed when the court had so determined. It is not called upon to decide whether a new label proposed for adoption would infringe. This is especially so here, where the infringement was deliberate and designed. In such case the court ought not to say how near the infringer may lawfully approximate the label of the complainant, but should cast the burden upon the guilty party of deciding for himself how near he may with safety drive to the edge of the precipice, and whether it be not better for him to keep as far from it as possible";²³ and in a later case, quoting from the foregoing opinion, the same court, per curiam remarks "it will be time enough for the court to determine the question upon issues properly framed and the evidence taken thereunder."²⁴

Where the complainant's counsel has stated that he saw no objection to a proposed new label submitted to him by defendant, the fact was held conclusive against

23—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep., 809, 813, 41 C. C. A. 71. to the same effect see Sterling Remedy Co. v. Spermine Medical Co., 50 C. C. A. 657, 112 Fed. Rep.

24—Williams v. Mitchell, 45 C. C. A., 265, 106 Fed. Rep. 168, 172; 1000.

an application for a preliminary injunction to restrain its use.²⁵

§ 161. **Appeals.**—Section 17 of the Act of 1905 provides that “The circuit courts of Appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.”

Section 7 of the act of March 3, 1891 (26 Stat. 826, c. 517) establishing the Circuit Court of Appeals as amended by the act of February 18, 1895 (28 Stat. 666, c. 96), provides:

“That where upon a hearing in equity in a district court or a circuit court an injunction shall be granted, continued, refused or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused in a cause in which an appeal from a final decree may be taken under the provisions of this act to the circuit court of appeals, an appeal may be taken from such interlocutory order or decree granting, continuing, refusing, dissolving, or refusing to dissolve an injunction to the circuit court of appeals, provided that the appeal must be taken within thirty days from the date of entry of such order or decree and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, during the pendency of such appeal: and provided further that the court below may, in its discretion, require as a condition of the appeal, an additional injunction bond.” Under this section, an appeal from a decree made after final hearing on the merits, declaring infringement of a trademark, awarding a perpetual injunction and refer-

ring the cause to a master for an accounting, is not an appealable final decree but is interlocutory, and such an appeal, to be effectual must be taken within 30 days from entry of the interlocutory decree.²⁶

The United States circuit courts of appeals will review the action of the circuit courts in granting or refusing preliminary injunctions, for the purpose of reviewing the discretion of the court below and correcting error in its exercise. In a proper case it will enlarge the scope of a preliminary injunction which falls short of protecting the complainant's rights.²⁷

Where such a preliminary injunctive order is appealed from, however, "the question for consideration is whether the court below improperly exercised its discretionary power in respect of issuing an injunction *pendente lite*. Unless it clearly appears that it has so done, the order should be affirmed."²⁸

§ 162. **Certiorari.**—Section 18 of the Act of 1905 provides as follows:

"That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the circuit court of appeals."

The Act referred to is known as the Judiciary Act of 1891, Section 6 of which Act provides "That in any such case as is hereinbefore made final in the Circuit Court of Appeals, it shall be competent for the Supreme Court to require by certiorari or otherwise, any such case to be certified to the Supreme Court for its review and determination with the same power and authority in

26—Raymond v. Royal Baking Powder Co., 76 Fed. Rep. 465, 22 C. C. A. 278.

27—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-813, 41 C. C. A. 71.

28—Chickering v. Chickering & Sons, 120 Fed. Rep. 69, 73, 56 C. C. A. 475; Pfeiffer v. Wilde, 46 C. C. A. 415, 107 Fed. Rep. 456.

the case as if it had been carried by appeal or writ of error to the Supreme Court.” Section 716 of the United States Revised Statutes has been held to authorize the use of writs of certiorari by the Supreme Court in all proper cases.²⁹

The general rule concerning the issuance of a writ of certiorari by the Supreme Court is that it rests within the discretion of the court. Mr. Chief Justice Fuller has said that “When sought as between private persons, the general rule is that the writ of certiorari will be granted or denied, in the sound discretion of the court, on special cause or ground shown; and will be refused where there is a plain and equally adequate remedy by appeal or otherwise.”³⁰

29—*Re Tampa Suburban R. Co.*,
168 U. S. 583, 42 L. Ed. 589.

30—*Re Tampa Suburban R. Co.*,
168 U. S. 583, 42 L. Ed. 589.

CHAPTER XIV.

MATTERS OF PRACTICE AND EVIDENCE.

§ 163. **Matters of which courts will take judicial notice.**—This subject is of practical importance in the trial of trademark causes. The courts of the United States will take judicial notice of the statutes of the several states,¹ and of the decisions of the state courts upon the constitutionality of such statutes.² All courts will take judicial notice of the treaties or conventions with a foreign government or power.³ It has been expressly held that judicial notice will be taken of the convention concerning trademarks, of April 16, 1869, between the United States and France.⁴ As in other classes of cases, the courts take judicial notice of political facts, legal facts, official facts, public history, natural history and the vernacular language, and all matters of common and ordinary knowledge, including matters of science.

§ 164. **Expert and other evidence on the question of infringement.**—Inspection by the court is the main, and indeed the final test of the alleged resemblance in trademark cases.⁵ The courts, as a rule, give little weight to expert testimony on questions of similitude.⁶

1—*Re Jordan*, 49 Fed. Rep. 238; *dison-Tinsley Tob. Co.*, 52 Mo. App. 10; *Collins Chemical Co. v. Bunyan*, 138 U. S. 623.

2—*Knox v. Columbia Liberty Capitol City Mfg. Co.*, 42 Fed. Rep. 378.

3—*Ex parte McCabe*, 46 Fed. Rep. 363.

4—*La Croix v. Sarrazzin*, 15 Fed. Rep. 489.

5—*Von Mumm v. Frash*, 56 Fed. Rep. 830-838; *Filley v. Fassett*, 44 Mo. 173; *Gail v. Wackerbarth*, 28 Fed. Rep. 286; *Drummond v. Ad-*

6—*Cook v. Starkweather*, 13 Abb.

Pr. N. S. 392; *Popham v. Wilcox*, 66 N. Y. 69; *Re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Radam v. Destroyer Co.*, 81 Texas, 122; 16 S.

Testimony of skilled witnesses to the effect that in their opinion the public is likely to be deceived by the similarity of two trademarks, although valuable in a doubtful case,⁷ is not of itself sufficient evidence of infringement.⁸ When technical trade or scientific questions are involved, however, expert evidence is highly desirable,⁹ and especially when the probability of the ultimate consumer being deceived by the defendant's goods rests on the character and habits of the people who use the product,¹⁰ or the manner in which the goods are usually sold or exhibited by the retailer.¹¹

Where the defendant was charged with re-filling "A. V. H." gin bottles, evidence of an expert gauger showing a variance in alcoholic proof between the genuine gin and that sold by defendant in the trademarked packages, was admitted.¹²

Where the complainant's case rested on the testimony of hired witnesses that they had drunk bitters sold them by the defendant in his saloon as being complainant's

W. Rep. 990; *P. Lorillard Co. v. Peper*, 86 Fed. Rep. 956; *Monopol Tobacco Works v. Gensior*, 66 N. Y. Supp. 155. Lord Esher, Master of the Rolls, has terseley said: "If a man was to come and tell me that a horse was like a cat, he might swear it, and you might get fifty persons to swear it, but I should not act on such evidence, because it is pure nonsense." *Re Christiansen*, 3 R. P. C. 54-61.

7—*Celluloid Mfg. Co. v. Read*, 47 Fed. Rep. 712-716.

8—*Columbia Mill Co. v. Alcorn*, 40 Fed. Rep. 676; *Cope v. Evans*, L. R. 18 Eq. 138. But in one case such evidence was admitted and approved (*Williams v. Brooks*, 50 Conn. 278; 47 Am. Rep. 642), while in another its propriety was

questioned (*Radam v. Capital Microbe Destroyer Co.*, 81 Texas, 122; 26 Am. St. Rep. 783).

9—*Mitchell v. Henry*, L. R. 15 Ch. D. 181; 43 L. T. 186; *Cartmell*, 227; *Re Worthington*, 14 Ch. D. 8; 49 L. J. Ch. 646; *Cartmell*, 351; *Re Christiansen*, 3 R. P. C. 54; *Cartmell*, 95; *Gorham Co. v. White*, 14 Wall. 511; *Williams v. Brooks*, 50 Conn. 278; *Price & Steuart*, 654; *Celluloid Mfg. Co. v. Read*, 47 Fed. Rep. 712-716.

10—*Drummond v. Addison-Tinsley Tob. Co.*, 52 Mo. App. 10; *Sperry v. Percival Milling Co.*, 81 Cal. 252-260.

11—*Re Worthington*, L. R. 14 Ch. D. 8.

12—*Van Hoboken v. Mohns & Kaltenbach*, 112 Fed. Rep. 528.

bitters and that said bitters were imitation, the bill was dismissed on the conflicting testimony offered in defense, the court remarking that hired witnesses are not disinterested and their testimony for that reason should be scrutinized with unusual caution.¹³ In dismissing a bill in which a defendant was charged with refilling genuine packages, where the evidence was conflicting, Judge Coxe remarked that "the burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."¹⁴

Where proof is offered to show that the complainant's business has increased steadily during the period of the alleged unfair competition, and there is no evidence of injury, such facts will be considered in determining the complainant's right to relief.¹⁵ Where the only evidence of deception came from purchasers who were not misled, it was held that the facts constituted a case of substitution on the part of the retailer, and not unfair competition.¹⁶

Expert testimony on other issues.—A witness familiar with the trade may testify to the catch-word or other peculiar designation by which an article is known to the

13—Hostetter Co. v. Bower, 74 Fed. Rep. 235. The quantity of proof adduced, and its weight, necessarily must be fixed by the attendant circumstances of each case. Thus, in one case it was held that a single sale of the infringing article by the defendant's clerk was insufficient to warrant injunction. Leahy v. Glover, 10 R. P. C. 141. And in a patent case it was held that a single sale was not *per se* an infringement. Byam v. Bullard, 1 Curt. 100; Fed. Case No. 2262. But evidence of a single sale "may, in connection with other

proof, be persuasive evidence of other sales, and convincing proof of an intention to sell whenever the opportunity of doing so without detection is presented." Lacombe, J., in Lever Bros. (Ltd.) v. Pasfield, 88 Fed. Rep. 484. Citing De Florez v. Reynolds, 14 Blatchf. 505.

14—Hostetter Co. v. Comerford, 97 Fed. Rep. 585.

15—Stevens Linen Works v. William & John Don & Co., 121 Fed. Rep. 171.

16—Bickmore Gall Cure Co. v. Karns Mfg. Co., 126 Fed. Rep. 573.

trade,¹⁷ or to consumers;¹⁸ and of course other witnesses similarly qualified may testify to the contrary.¹⁹

Testimony of witnesses properly qualified is admissible to show that owing to the defendant's infringement, plaintiff's sales have fallen off; this is true both at law²⁰ and in equity.²¹ In the action at law it is competent for the plaintiff's proof to show that his sales fell off concurrently with the defendant's infringement, from which the jury may infer that the falling off was the result of the defendant's acts.²²

Evidence of Defendant's Good Faith.—The relief resting upon the charge of fraud, the fact that a defendant has transacted his alleged infringement openly, by extensive advertising of his package will be considered as bearing on the question of intent, where a technical trademark is not involved.²³

§ 165. **Exhibits.**—It is particularly desirable that the conflicting marks be at all times easily accessible to the court, and that they be filed as exhibits whenever possible. The practice of the courts of several states does not permit exhibits, other than documentary, to be filed, as no provision has been made for their accommodation and safe-keeping. In Missouri, where this condition prevails, the St. Louis court of appeals has recommended the preservation of the brands or labels as a part of the record on appeal.²⁴

The federal courts, however, afford every facility required for the care of exhibits and the following rule is in effect in all the federal circuit courts of appeals:

“1. Models, diagrams and exhibits of material form-

17—Pollen v. LeRoy, 30 N. Y. 78-84; 34 Atl. Rep. 446.
549-561.

18—Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374, 82 Fed. Rep. 662; Read v. Richardson, 45 L.T.N.S. 54; Cox, Manual, No. 698.

19—Wilkinson v. Greely, Fed. Case No. 17671; 1 Curt. 63.

20—Shaw v. Pilling, 175 Pa. St. 123.

21—Hostetter v. Vowinkle, Fed. Case No. 6714; 1 Dill. 329; Cox, Manual, No. 207.

22—Shaw v. Pilling, *supra*.

23—T. B. Dunn Co. v. Trix Mfg. Co., 63 N. Y. Supp. 323.

24—Alden v. Gross, 25 Mo. App.

ing part of the evidence taken in the court below, in any case pending in this court on writ of error or appeal, shall be placed in the custody of the marshal of this court at least ten days before the case is heard or submitted.

"2. All models, diagrams and exhibits of material placed in the custody of the marshal for the inspection of the court on the hearing of a case must be taken away by the parties within one month after the case is decided. When this is not done, it shall be the duty of the marshal to notify the counsel in the case, by mail or otherwise, of the requirements of this rule, and, if the articles are not removed within a reasonable time after notice is given, he shall destroy them or make such other disposition of them as to him may seem best."²⁵

It is frequently expedient to annex to the order of injunction specimens of the marks used by the defendant.²⁶

§ 166. **Discovery.**—The resistance of discovery is usually met with by complainants in trademark causes.

Lord Romilly compelled a defendant to make a full discovery of all his sales, the prices, profits realized and the names of the purchasers, notwithstanding the objection of the defendant that he would thereby disclose his business secrets;²⁷ and full discovery has been compelled in other cases.²⁸ The power to compel discovery is inherent in equity, but is not vested in courts of law in the absence of statutory enactment.²⁹

"Equitable jurisdiction will not attach for discovery simply, except in aid of a suit at law."³⁰

25—The above rule is numbered rule 34 in each court of appeals but that of the seventh circuit, where it is numbered rule 32.

26—Hansen v. Siegel-Cooper Co. (1), 106 Fed. Rep. 690, 691.

27—Howe v. McKernan, 30 Beav. 547.

28—Leather Cloth Co. v. Hirsch-

feld (2), 1 H. & M. 295; Seb. 224; Orr v. Diaper, L. R. 4 Ch. D. 92; 46 L. J. Ch. 41; Seb. 519.

29—Colgate v. Compagnie Française, 23 Fed. Rep. 82-85.

30—Colt, J., in Lord v. Whitehead & Atherton Machine Co., 24 Fed. Rep. 801.

In actions at law production of books and papers is fully provided for, in federal practice, by section 724 of the Revised Statutes. It has been held that inspection of books or writings may be ordered to be made before the trial.³¹ Its provisions, when affording an adequate remedy, preclude resorting to equity to compel discovery,³² and render the issuance of *subpoena duces tecum* unnecessary.³³

In equitable proceedings discovery will not be enforced when it may tend to incriminate the person against whom discovery is sought,³⁴ or to disclose trade secrets,³⁵ and the same rule applies to the enforced production of books and papers by such persons.³⁶

Subject to these restrictions, discovery of material facts will be compelled.³⁷

When a defendant professes to answer, he must answer fully. If he desires protection against discovery, he must seek such protection by plea.³⁸

§ 167. Evidence of recognition by others of plaintiff's right to the mark.—The rule is well settled that a former adjudication establishing a trademark, where there has been an adjudication after a *bona fide* contest on the merits, and the same issues were presented as in the later suit, is of persuasive if not binding force in a later case.³⁹ But a mere showing that the claimant of the

31—Lucker v. Phoenix Assurance Co., 67 Fed. Rep. 18; Exchange Bank v. Wichita Cattle Co., 61 Fed. Rep. 190; United States v. National Lead Co., 75 Fed. Rep. 94.

32—Washburn & Moen Mfg. Co. v. Freeman Wire Co., 41 Fed. Rep. 410; Paton v. Majors, 46 Fed. Rep. 210. But see Colgate v. Compagnie Francaise, 23 Fed. Rep. 82.

33—Kirkpatrick v. Pope Mfg. Co., 61 Fed. Rep. 46.

34—Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

35—See *ante*, Chapter VII. and Dobson v. Graham, 49 Fed. Rep. 17.

36—Ibid. See also Union Paper Collar Co. v. Metropolitan Collar Co. (Ltd.), 3 Daly, 171.

37—Benbow v. Low, L. R. 16 Ch. D. 93; Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

38—Howe v. McKernan, 30 Beav. 547; Slater v. Banwell, 50 Fed. Rep. 150.

39—Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; Symonds v. Greene, 28 Fed. Rep. 834; La Republique Francaise v. Saratoga

trademark has by threats of legal prosecution compelled or induced others to enter into undertakings to desist from the use of the name, or that others have submitted to injunctions without a contest, is very slight, if any, evidence of the plaintiff's right to use the mark. In a recent case before the House of Lords, Lord Davey said in regard to evidence of cases in which other persons had submitted to injunctions and had paid the costs: "That does not appear to me to be very strong evidence in favor of the pursuers. Of course, a shop-keeper or a person in that position would hesitate a long time before he incurred the expense, which in the case of a trademark or in a patent case is not slight, of defending an action of this character; probably the value to him of the trade he would lose would not in any way compensate for the risk he would incur. Therefore, as evidence of the fact, I do not attach much importance to those cases."⁴⁰ An interlocutory decree of one court appears to be entitled to but little weight in a proceeding before another.⁴¹

§ 168. Contempts.—It is provided by section 725 of the United States Revised Statutes that the Courts of the United States shall have the power to punish, "by fine or imprisonment, at the discretion of the court, contempt of their authority; provided, that such power to punish contempts shall not be construed to extend to any cases except the misbehavior of any person in their presence, or so near thereto as to obstruct the administration of justice, the misbehavior of any of the officers of said courts in their official transactions, and the disobedience or resistance by any such officer, or by any party, juror,

Vichy Springs Co., 99 Fed. Rep. 733. But a decision of the English high court of chancery adverse to the claimant of a mark is not a bar to a suit for infringement of the mark brought in the United States. *City of Carlsbad v. Kut-*

now, 68 Fed. Rep. 794. And to the same effect see *Hohner v. Gratz*, 50 Fed. Rep. 369.

40—*Cellular Clothing Co. v. Maxton*, L. R. (1899) A. C. 326-346.

41—*Walter Baker & Co. v. Sanders*, 80 Fed. Rep. 889, 26 C.C.A. 220.

witness, or other person, to any lawful writ, process, order, rule, decree, or command of said courts.”

Contempt of court is a specific criminal offense.⁴² Imposition of a fine for contempt is a judgment in a criminal case.⁴³ It has been held that a plaintiff who circulates matter prejudicial to the defense of a pending action for trademark infringement is guilty of a contempt,⁴⁴ as has also been held of a plaintiff who published a false and perverted construction of the purpose and effect of an injunction.⁴⁵

By far the greater number of applications to commit for contempt in the class of cases under consideration are based upon the failure of the party enjoined to comply with the injunctive decree. Where no attempt has been made toward compliance with the decretal order, the respondent is, of course, in contempt and liable to commitment, like any other contemnor.⁴⁶ But where some effort has been made to comply with the order, but to an extent not satisfactory to the complainant, an issue of fact is raised for the determination of the trial court, and as a rule its findings and judgment will not be reviewed on appeal;⁴⁷ and where the contempt proceedings are referred, the court is reluctant to disturb the findings of fact made by the referee.⁴⁸

It is a contempt, after decree, to offer the infringing goods for sale, even though no sale is actually effected;⁴⁹ nor does it exempt the defendant from commitment to show that he intended to comply with the decree, if in

42—Fischer v. Hayes, 6 Fed. Rep. 63-68.

43—New Orleans v. Steamship Co., 20 Wall. 387-392; Butler v. Fayerweather, 91 Fed. Rep. 458; 33 C. C. A. 625; 63 U. S. App 123.

44—Coats v. Chadwick, L. R. (1894) 1 Ch. D. 347.

45—Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co., 92 Fed. Rep. 774-779.

46—Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G. 614.

47—Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

48—Hennessy v. Budde, 82 Fed. Rep. 541.

49—Marcovitch v. Bramble, Wilkins & Co., Cox, Manual, No. 595.

fact he has not complied with it.⁵⁰ But wherever the court determines that the defendant has so altered his marks or packages that there is no longer any danger of the public mistaking his goods for those of the plaintiff, he will be discharged.⁵¹ Where, however, the change is only sufficient to avoid the letter of the decree, and the defendant's mark or package is still calculated to promote deception, under the English practice the injunction may be enlarged upon the hearing of the contempt proceedings so as to cover the new fraud, even though the motion to commit must be refused.⁵² The rulings of the courts in this regard have taken a wide range. There have been cases in which the court has declined to commit upon the defendant making an offer to devise such changes in his mark as would meet with the approval of the court,⁵³ and others where the court has directed the defendant to make such changes with the alternative of being committed.⁵⁴ Where an injunction is in part mandatory and in part prohibitive, and the mandatory portion is suspended by an appeal, the court cannot punish the defendant for contempt for the violation of such mandatory portion, although his act is a joint violation of both portions.⁵⁵

And a defendant who sells a stock of bottles, labels and wrappers to a third party, after a decree enjoining him from dealing in an infringing liquor put up in the bottles, under the labels and enclosed in the wrappers, under circumstances indicating that it was for the purpose of enabling the purchaser to supply defendant's former customers with the infringing goods, is guilty of contempt.⁵⁶ One who is enjoined from preparing, put-

50—Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

51—Swift v. Dey, 4 Robertson, 611; Cox, 319.

52—Cartier v. May, Cox, Manual, No. 200.

53—Croft v. Day (2), Cox, Manual, No. 77.

54—Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G.

614.

55—Schwarz v. Superior Court, 111 Cal. 106.

56—Societe Anonyme v. Western Distilling Co., 42 Fed. Rep. 96.

ting up, selling, offering or advertising for sale, any medicinal beverage made from fermented milk under the name of "Matzoon" is guilty of contempt if he aids another in doing the forbidden acts, as the agent or servant of the other.⁵⁷ Where the injunctive order runs against agents, servants and employes "there is no restraint laid upon the agent, servant, or employee personally, but merely as the agent, servant, or employee of the enjoined defendant."⁵⁸ One enjoined from using a firm name, who continues to use stationery bearing the name, left legible though having ink spread over it, is guilty of contempt,⁵⁹ as is one who publishes a circular reflecting upon the decree under which he is enjoined.⁶⁰

The foregoing rulings have been made in unfair trade cases. It would be foreign to our purpose to go into an extended discussion of the law governing contempts, which applies to this as to all other classes of cases. It is well to note, however, that in the federal courts, at least, while proceedings in contempt are not reviewable on error or appeal, they may be reached by *certiorari*.⁶¹

§ 169. Affidavits.—Applications for restraining orders and preliminary injunctions are usually founded upon and resisted by affidavits. A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case.⁶² The complainant's affidavits in chief must

57—*Dadirrian v. Gullian*, 79 Fed. Rep. 784.

58—Ibid; citing *Slater v. Merritt*, 75 N. Y. 268.

59—*Hildreth v. McCaul*, 74 N. Y. Supp. 1075.

60—*Janney v. Pan-Coast Ventilator & Mfg. Co.* (2), 131 Fed. Rep. 143.

61—*Re Chetwood*, 165 U. S. 443-462; *Schwarz v. Superior Court*, 111 Cal. 106. Compare *Butler v. Fayerweather*, 91 Fed. Rep. 458;

33 C. C. A. 625; 63 U. S. App. 123; holding that writ of error will lie to review an order committing for contempt a witness, not a party to the cause, for his refusal to answer questions.

62—*Lare v. Harper & Bros.*, 86 Fed. Rep. 481; 30 C. C. A. 373; *New York Asbestos Mfg. Co. v. Ambler Asbestos Air-cell Covering Co.*, 99 Fed. Rep. 85; *Diamond Match Co. v. Safe Harbor Match Co.*, 109 Fed. Rep. 154.

show all the facts necessary to establish a *prima facie* right to the injunction sought.⁶³ The defendant's affidavits may be by way of traverse, in which case no counter affidavits can be offered by the complainant; or they may set up matter by way of confession and avoidance, in which case the complainant may produce affidavits in reply. But where such affidavits are offered by the complainant in reply, no further affidavits can be offered by the defendant by way of rejoinder.⁶⁴

All affidavits so used must be entitled in the cause; otherwise they are mere extrajudicial oaths, perjury could not be assigned upon them, and they cannot be considered as evidence.⁶⁵

63—Leclanché Battery Co. v. Western Electric Co., 21 Fed. Rep. 538.

64—Day v. New England Car Spring Co., 3 Blatch. 154-159.

65—Hawley v. Donnelly, 8 Paige, 415; Buerk v. Imhaeuser, Fed. Case No. 2107a; 10 Off. Gaz 907; Goldstein v. Whelan, 62 Fed. Rep. 124.

CHAPTER XV.

COSTS.

§ 170. **Generally.**—In cases of unfair trade the same rules as to costs obtain as in other actions. The general rule is that costs follow the event. A successful plaintiff will be awarded costs,¹ and costs will be refused to one who is unsuccessful.²

So costs will be awarded to the successful plaintiff, even though he is denied damages,³ and against an infant,⁴ or a married woman having a separate estate.⁵

§ 171. **Avoiding costs by submission.**—We have had occasion elsewhere to refer to the rule laid down by Sir George Jessel, that the complainant in actions of the character now under consideration should not give

1—*Coats v. Holbrook*, 2 Sandf. Ch. 586; *Cox*, 20; *Seb.* 79; *Pierce v. Frank*, 15 L. J. Ch. 122; *Seb.* 81; *Rodgers v. Nowill*, 6 Hare, 325; *Seb.* 82; *Burgess v. Hately*, 26 Beav. 249; *Seb.* 169; *Burgess v. Hills*, 26 Beav. 244; 28 L. J. Ch. 356; *Seb.* 170; *Collins Co. v. Walker*, 7 W. R. 222; *Seb.* 171; *Jurgensen v. Alexander*, 24 How. Pr. 269; *Cox*, 298; *Seb.* 211; *Edelsten v. Edelsten*, 1 DeG. J. & S. 185; *Seb.* 213; *McAndrews v. Bassett*, 4 DeG. J. & S. 380; *Seb.* 234; *Chubb v. Griffiths*, 35 Beav. 127; *Seb.* 255; *Field v. Lewis*, *Seton* (4th ed.), 237; *Seb.* 280; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178; *Seb.* 387; *Compagnie Laferme v. Hendrick*, *Seb.* 512; *Sawyer v. Kellogg*, 9 Fed. Rep. 601; *Cox, Manual*, 682; *McLean v. Fleming*, 96 U. S. 245; *Chappell v. Davidson*, 2

K. & J. 123; *Seb.* 136; *Re Kuhn & Co.'s Trademark*, 53 L. J. Ch. 238. Costs "are always awarded to the successful side, unless there has been something in the conduct of the party which renders such a course inequitable and unjust to the losing side." *Nixon, J.*, in *Bunker v. Stevens*, 26 Fed. Rep. 245-249.

2—*Bass v. Dawber*, 19 L. T. N. S. 626; *Seb.* 310; *Appeal of the Putnam Nail Co.*, *Cox, Manual*, No. 725; *Weener v. Brayton*, 152 Mass. 101.

3—*Weed v. Peterson*, 13 Abb. Pr. N. S. 178; *Seb.* 387.

4—*Chubb v. Griffiths*, 35 Beav. 127; *Seb.* 255; *Cory v. Gertcken*, 2 Madd. 49; *Woolf v. Woolf*, 43 Sol. J. 127.

5—*Nicholls v. Kimpton*, 3 Times L. R. 674.

notice to the infringer before suit;⁶ and it has been held in this country that no demand or notice is necessary.⁷ It is of the gravest importance to the practitioner to bear this rule in mind, whether he be for the plaintiff or defendant. A failure to observe it will oftentimes involve an innocent and injured client in the payment of costs which would otherwise fall upon the other party; for it is no defense to an assessment of costs against the defendant that no demand was made or notice served before suit.⁸ A defendant who makes a full submission will not be mulcted in costs. Thus, a label manufacturer who had innocently made labels upon the order of a customer evaded costs by promising to desist from the manufacture, and offering to surrender the lithograph stone with which the work was done.⁹ Lord Romilly, in a leading case in which the defendants were forwarding agents holding as bailee goods bearing a spurious mark, gave the doctrine this succinct expression: "It is his (the defendant's) duty at once to give all the information required, and to undertake that the goods shall not be removed or dealt with until the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose. If, after that, the person injured files a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendant the costs of the suit, and he may have to pay them."¹⁰

This rule has been uniformly followed.¹¹ A defendant may make such an offer of submission, by answer or

6—Upmann v. Forester, L. R. 24 Ch. D. 231.

7—Sawyer v. Kellogg, 9 Fed. Rep. 601.

8—Ibid.

9—Bass, Ratcliff & Gretton v. Guggenheimer, 69 Fed. Rep. 271.

10—Upmann v. Elkan, L. R. 12 Eq. 140; Seb. 369.

11—Millington v. Fox, 3 Myl. & Cr. 338; Seb. 63; Burnett v. Leuchars, 13 L. T. N. S. 495; Seb. 253; Wharton v. Thurber, Cox, Manual, 663; Nunn v. D'Albuquerque, 34 Beav. 595.

otherwise, at any stage of the proceedings, and so throw upon the plaintiff all costs subsequently accruing.¹²

§ 172. Submission to avoid costs must be complete.—It is the necessary correlative of the rule stated in the preceding section that no submission can avail a defendant unless it is full, adequate and complete. Thus a submission, otherwise good, was rendered ineffective because the defendant did not couple with it an offer to pay all costs accrued.¹³ An offer of submission on condition that each party pay his own costs was held ineffective.¹⁴ Further adjudication in support of the general doctrine of this section will be found in the note.¹⁵

§ 173. Costs refused successful defendant.—There are a number of instances wherein a defendant against whom the plaintiff has been denied relief has been left to pay his own costs. These cases are not always predicated upon the defendant's absolute fraud, for, even where fraud could not be established, he may have been guilty of conduct so suspicious as to justify the imposition of his own costs.¹⁶ Thus where the defendant had dealt

12—"If the defendant had offered the plaintiffs all they were entitled to, and after that the plaintiffs had proceeded in the suit, I most certainly should not have given the plaintiffs a penny of the costs incurred after that period; indeed, I should have endeavored to make them pay them." Lord Romilly in *Burgess v. Hills*, 26 Beav. 244; Seb. 170. And to the same effect see the opinion of the same Master of the Rolls in *Moet v. Couston*, 33 Beav. 578; Seb. 235.

13—*Hutchinson v. Blumberg*, 51 Fed. Rep. 829; *McAndrews v. Bassett*, 4 DeG. J. & S. 380; Seb. 234; *Burgess v. Hately*, 26 Beav. 249; Seb. 169; *Burgess v. Hills*, 26 Beav. 244; Seb. 170; *Collins Co. v. Walker*, 7 W. R. 222; Seb. 171;

Coats v. Holbrook, 2 Sandf. Ch. 586; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178.

14—*Moet v. Couston*, 33 Beav. 578.

15—*Tonge v. Ward*, 21 L. T. N. S. 480; Seb. 321; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *Cox*, 20; Seb. 79; *Fennessy v. Day*, 55 L. T. N. S. 161.

16—*Talcott v. Moore*, 6 Hun, 106; Seb. 478; *Rose v. Loftus*, 47 L. J. Ch. 576; Seb. 608. Thus, where both plaintiff and defendant made cigars falsely marked "Habana," the English court of appeals dismissed the bill without costs and adjudged the costs of the appeal against the defendant. *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. N. S. 31.

in bitters, and assented to suggestions that they might be passed off on the public as the "Hostetter's Bitters" of the plaintiff, the court thought the facts did not warrant an injunction, but that the defendant had invited the litigation by his conduct and ought not to have his costs.¹⁷

§ 174. **Miscellaneous matters.**—Innocent wharfingers in whose possession was found champagne bearing a false brand, and who were made parties defendant to an action but at once submitted to act as the court might direct, were awarded their costs, and given a lien for their warehouse charges, and that lien given priority over the plaintiffs' claim for costs.¹⁸

Where the defendant is a retail dealer, who has acted innocently and handled only a small quantity of the infringing goods, a plaintiff may not be awarded costs even though the injunction issues.¹⁹ Some courts apply this rule where it appears that the defendant's sales have not been large enough to justify the expense of taking an account.²⁰

Where it appeared that the defendant had adopted

17—Hostetter v. Van Vorst, 62 Fed. Rep. 600.

18—Moet v. Pickering, L. R. 8 Ch. D. 372.

19—Thus where a small retailer was charged with infringing a cigarette trademark, and it was shown that the transaction related only to five hundred cigarettes, valued at 17s. 6d., which the defendant had bought in ignorance of the infringement, it was said: "I think that this is not the kind of action which ought to be encouraged. If the owner of a trademark finds that it is being pirated, surely it is not the small retailer who ought to be punished, but an endeavor ought to be made to

prosecute those who place the spurious goods on the market; and although I agree that the plaintiffs are entitled to an injunction, yet I cannot think it is the duty of the court in every case in which a small retail dealer who has innocently (and I think that the defendants in this case have acted innocently) happened to purchase a small quantity of the spurious goods, to say that he ought to be fixed with the costs of the action." Shilling, J., in American Tobacco Co. v. Guest, L. R. (1892) 1 Ch. D. 630-632.

20—Saxlehner v. Eisner & Mendelson Co., 88 Fed. Rep. 61-70.

plaintiff's trademark (which consisted of words understood by many simply to indicate quality), and did so in ignorance of the plaintiff's existence, the plaintiff was granted an injunction but without costs.²¹ A plaintiff may be denied costs because of his delay in instituting suit.²²

If in his bill the plaintiff makes specific charges against the defendant which he is unable to substantiate with proof, he may, under the English practice, obtain an injunction with costs, but be adjudged to pay all of the defendant's costs occasioned by the making of the unfounded charge.²³

Where the infringement was not innocent, but the defendants offered to pay costs and publish any reasonable advertisements announcing that they had no connection with the plaintiffs, it was held that by ignoring this offer the plaintiffs had lost their right to relief, and the action was dismissed. It is doubtful if this decision would be given much consideration by an American court.²⁴

One who procures the preparation of an article bearing an infringement of another's trademark will be liable to refund to the manufacturer such reasonable sum as he may pay to the owner of the trademark in compromise of an action for the infringement, together with the costs of such action.²⁵

In regard to appeals, the same general rules as to costs obtain as are applied by the inferior courts. Thus on an appeal from a committal for contempt, based on the violation of an injunction in a trademark case, the upper court sustained the ruling of the lower, but, because the violation seemed open to dispute, gave no costs of the appeal.²⁶

21—*Millington v. Fox*, 3 Myl. & Cr. 338; *Cox*, Manual, 642.

22—*Amoskeag Mfg. Co. v. Garner* (2), 54 How. Pr. 298.

23—*Saxlehner v. Apollinaris Co.*, L. R. (1897) 1 Ch. 893.

24—*Valentine v. Valentine*, 31 L. R. Ir. 488.

25—*Dixon v. Fawcus*, 3 Ell. & Ell. 537.

26—*Devlin v. Devlin*, 69 N. Y. 212.

In the leading case of *McLean v. Fleming* the defendant appealed from a decree awarding the plaintiff an injunction and accounting. The supreme court reversed the decree as to the accounting, on the ground that the plaintiff was guilty of laches, but let the decree of injunction stand. It then gave plaintiff his costs in the lower court, and the defendant the costs of the appeal.²⁷

The costs of an unsuccessful motion to commit for contempt will be taxed against the moving party.²⁸ The costs of contempt proceedings can be taxed against a defendant only where, upon the facts, he might have been committed.²⁹ While it would seem the better practice to make no order as to costs upon the entry of interlocutory decrees, and to withhold such order until the entry of final decree upon the master's report, we find very respectable authority for the contrary practice.³⁰

27—*McLean v. Fleming*, 96 U. Rep. 561-571. "Courts of equity, having a large discretion in matters of costs, frequently give costs in intermediate stages of a cause, without waiting for the final decree." Dick, J., in *Avery v. Wilson*, 20 Fed. Rep. 856-859.

28—*Hennessy v. Budde*, 82 Fed. Rep. 541.

29—*Dence v. Brand*, W. N. 1881, p. 31.

30—*The Collins Co. v. Oliver Ames & Son Corporation*, 18 Fed.



APPENDIX.

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- C. Trademark Act of August 14, 1876. Annotated.
- D. Trademark Act of March 3, 1881. Annotated.
- E. Trademark Act of August 5, 1882, and War Department Circulars.
- F. Trademark Provision of the Tariff Act of 1897. Annotated.
- G. Trademark Act of February 20, 1905. Annotated. Patent Office Rules, and Forms relative thereto.
- H. Trademark Statutes of the States and Territories. Annotated. With Forms for Registration Applications.
- I. Canadian Trademark and Design Act, with Rules and Forms.
- J. Bills of Complaint and Answers. Judicially Approved.
- K. Forms of Injunction—Interlocutory and Final Decrees.
- L. Classification of Registered Trademarks.
- M. American and English Bibliography.
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- P. Trademark Laws of Foreign Nations.
- Q. Trademark Treaties with Foreign Nations.

APPENDIX A.

ACT OF CONGRESS OF JULY 8, 1870.¹

SECTION 77.² And be it further enacted, that any person or firm domiciled in the United States, and any corporation created by the authority of the United States,

1—Although this act is no longer in force, having been held unconstitutional, and the acts of 1881 and 1905 having been since enacted, it is thought advisable to set forth the earlier act, in order that the decisions under it may be understood. In *Leidersdorf v. Flint* (1), 8 Biss. 327, the validity of the act of 1870 was questioned by the United States circuit court, on the ground that the constitution of the United States did not authorize legislation by congress on the subject of trademarks, except such as had been actually used in commerce with foreign nations and among the several states, or with the Indian tribes; and in *Trademark Cases*, 100 U. S. 82, the act was formally declared by the supreme court to be on this ground unconstitutional and invalid. But this does not entitle persons having marks registered under the invalid act to recover back the fees paid by them (*Woodman v. United States*, 15 Ct. of Cl. 541), though they will be credited with such fees when applying for registration under the new act. See Act of 1881, sec. 6, *infra*. Nor does the invalidity of the act justify

the disregard of injunctions granted under the general jurisdiction of the court. *United States v. Roche*, 1 McCrary, 385. And it has been held that registration of a mark under the invalid act, even without reregistration under the act of 1881, is sufficient to prevent registration of a similar mark under the new act of 1881. *Ex parte Lyon*, Dupuy & Co., 28 Off. Gaz. 191. Since the passing of the act of 1870, it has been considered in the Patent Office that while, on the one hand, the benefits of registration as trademarks were to be reserved for trademarks, and for trademarks only (*e. g.*, in *re Parker*, 13 Off. Gaz. 323, registration as a trademark was refused to that which could at most amount to a design), so, on the other hand, it was only by registering them as trademarks, and not by patenting them as designs (*Ex parte King*, Comm. Decis. 1870, p. 109; *Re Whyte*, id. 1871, p. 304), or registering them as labels (*Re Godillot*, 6 Off. Gaz. 641; *Re Simpson & Sons*, 10 id. 333; *Ex parte Davids & Co.*, 16 id. 94; *Ex*

2—See Act of 1881, secs. 1, 2.

or of any state or territory thereof, and any person, firm, or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to the citizens of the United States, and who are entitled to the exclusive use³ of any lawful trademark, or who intend to adopt and use any trademark,⁴ for exclusive use within the United States, may obtain protec-

parte Schumacher & Ettlinger (1), 19 id. 791), that the benefits of the statute could be obtained for trademarks. Descriptive words not registerable as trademarks were properly allowed to be registered as labels. *Ex parte* Waeferling, 16 id. 746; *Ex parte* Brigham, 20 id. 891; *Ex parte* Lutz, 33 id. 1389; and see *Re Park*, 12 id. 2, in which it was sought to register as part of a label a device for which the applicant had previously sought registration as a trademark. In *United States v. Marble*, 22 id. 1366, however, the supreme court of the District of Columbia held that the commissioner of patents had no authority to refuse registration to a label merely on the ground that it might have been registered as a trademark; but in the later case of *Ex parte* Schumacher & Ettlinger (2), 22 id. 1291, the commissioner again refused registration as labels to what he considered to be trademarks; and in *Ex parte* Moodie, 28 id. 1271, and *Ex parte* Wiesel, 36 id. 689, the commissioner repeated this decision, and his course was in the former case upheld on appeal by the supreme court of the District of Columbia in *Ex parte* Moodie, 28 id. 1271. The federal courts have also held that a trademark must be registered as such, and not copyrighted

as a label. *Schumacher & Ettlinger v. Wogram*, 35 Fed. Rep. 210. It is for the commissioner to decide whether what is presented to him is a trademark or label. *Ex parte* Moodie, 28 Off. Cas. 1271.

3—In *McElwee v. Blackwell*, 15 Off. Gaz. 658, it was held that although where registration had been wrongfully granted to one, it might subsequently be properly granted to another who was really entitled to the exclusive use, yet it would not be granted to another who was not entitled to the exclusive use, even though he might be entitled to use the mark to some extent. And see *Wright v. Simpson*, 15 id. 968; also *Sorg v. Welsh*, 16 id. 910, as to admissions of right in another; and *Yale Cigar Manufacturing Co. v. Yale*, 30 id. 1183. Under the act of 1881 registration will be refused where it appears that the applicant is only one of several who have a right to use the mark. *Ex parte* Langdon, 61 Off. Gaz. 286.

4—Under these words a new trademark might be registered prior to any actual use. *Re Rothschild*, 7 Off. Gaz. 220; and see *Hoosier Drill Co. v. Ingels*, 14 id. 785. This is not the case under the act of 1881. See secs. 1 and 2, notes, and *Ex parte* Strasburger & Co., 20 Off. Gaz. 155.

tion for such lawful trademark⁵ by complying with the following requirements,⁶ to wit:

First. By causing to be recorded in the Patent Office,⁷ the names of the parties and their residence and place of business,⁸ who desire the protection of the trademark.

Second. The class of merchandise⁹ and the particular description of goods¹⁰ comprised in such class, by which the trademark has been or is intended to be appropriated.

5—As to what is a lawful trademark, see *infra*, sec. 79. Registration cannot make a lawful trademark out of that which does not contain the necessary elements (Moorman v. Hoge, 2 Sawy. 78; Schumacher & Ettlinger v. Schwenke (2), 36 Off. Gaz. 457); but by sec. 7 of the act of 1881 registration is *prima facie* evidence of ownership. It has been doubted whether the use of a registered trademark can be restrained (Decker v. Decker, 52 How. Pr. 218); but in Glen Cove Manufacturing Co. v. Ludeman, 23 Blatchf. 46, an injunction was granted in such a case. See also Schumacher & Ettlinger v. Schwenke (2), 36 Off. Gaz. 457. Separate registration must be obtained for each mark which differs from another by the addition of a symbol: *e. g.*, "X," "XX," "XXX," were held to require separate registration. Re English, Comm. Decis. 1870, 142; and see Re Eagle Pencil Co., 10 Off. Gaz. 981.

6—Absolute compliance with these requirements is necessary on the part of applicants. Re Hankinson, 8 Off. Gaz. 89. But it is not necessary that the very words of

the act should be cited, so long as the spirit of it is satisfied. Re Vidvard & Sheehan, 8 id. 143.

7—In Lacroix v. Escobal, 37 La. Ann. 533, it was held that a French citizen, who had not deposited his mark in the United States patent office, as required by the convention of 1869 between the United States and France, was not entitled to maintain an action for infringement. But see Société, etc. de la Benedictine v. Micalovitch, 36 Alb. L. J. 364.

8—The registration of the name of a firm has been held to be sufficient, without giving the particulars as to each of the partners. Smith v. Reynolds (2), 3 Off. Gaz. 213; 10 Blatchf. 100.

9—This requirement has been interpreted to exclude from registration the marks of persons other than manufacturers or merchants: *e. g.*, a carpet cleaner. Re Hankinson, 8 Off. Gaz. 89.

10—It has been held that a description of the class and goods as "paints" is sufficient (Smith v. Reynolds (2), 10 Blatchf. 100), and so with "alcoholic spirits" (Re Boehm & Co., 8 Off. Gaz. 319); but that "fancy goods" is insuffi-

Third. A description of the trademark itself¹¹ with fac-similes thereof¹² and the mode in which it has been or is intended to be applied and used.¹³

Fourth. The length of time, if any, during which the trademark has been used.¹⁴

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents.¹⁵

Sixth. The compliance with such regulations as may be prescribed by the commissioner of patents.¹⁶

cient, as being too general a term. *Re Lisner*, 13 id. 455. Different persons may register the same trademark for different descriptions of goods even in the same class. *Sorg v. Welsh*, 16 id. 910. In *Smith v. Reynolds* (2), 10 Blatchf. 100, and s. c. (3), 3 id. 213, it was held that a firm which had registered a trademark for "paints" was not entitled to restrain the use of the mark on white lead by another firm which had used the mark on that variety of paint before the plaintiffs had used or registered their mark; and in the former case it was held that the registration being bad as to white lead was bad *in toto*, though but for that it might have been good.

11—The trademark must be sufficiently described for it to be possible to clearly distinguish between the essential and non-essential elements. *Re Volta Belt Co.*, 8 Off. Gaz. 144.

12—The *fac-simile* limits the ver-

bal description of the mark. *Duke v. Green*, 16 Off. Gaz. 1094.

13—The previous user of the applicants or their derivative title must be stated. *Ex parte Consolidated Fruit Jar Co.*, 16 Off. Gaz. 679. Only one example of the mode of use will be admitted. *Re Kimball*, 11 id. 1109. And see *Smith v. Reynolds* (2), 10 Blatchf. 100.

14—See *Ex parte Consolidated Fruit Jar Co.*, 16 Off. Gaz. 679.

15—A fee paid can only be recovered when it was paid by actual mistake: *e. g.*, a payment in excess, or one not required by law. When, therefore, an application has failed because the proposed mark was not registrable, the fee paid cannot be recovered, although a renewed application for the registration of an essentially different mark has proved successful. *Re Block & Co.*, 14 Off. Gaz. 235. See note 1, p. 411, *supra*, as to crediting fees paid under this invalid act.

16—See sec. 81, *infra*, and note thereto.

Seventh. The filing of a declaration,¹⁷ under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trademark has the right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive,¹⁸ and that the description and facsimiles presented for record are true copies of the trademark sought to be protected.

SECTION 78.¹⁹ And be it further enacted, that such trademark shall remain in force for thirty years from the date of such registration, except in cases where such trademark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trademark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods.²⁰ Provided that six months prior to the expira-

17—As to the necessity for the filing of this declaration, and for the production of sufficient evidence of it, on a trial for infringement, see *Smith v. Reynolds* (1), 10 Blatchf. 85, where an injunction was refused on the ground of the deficiency of such evidence.

person, firm or corporation has a right to the use of the same, or substantially the same, mark, is a sufficient compliance with this requirement. Re *Vidvard & Sheehan*, 8 Off. Gaz. 143.

19—See Act of 1881, secs. 5, 7, 11.

20—An illegal registration by a part owner not entitled to exclu-

tion of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the commissioner of patents, and the fee for such renewal shall be the same as for the original registration, certificate of such renewal shall be issued in the same manner as for the original registration, and such trademark shall remain in force for a further term of thirty years; And provided further, that nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trademark after the expiration of the term for which such trademark was registered.

SECTION 79.²¹ And be it further enacted, that any person or corporation who shall reproduce, copy, counterfeit, or imitate any such recorded trademark, and affix the same to goods of substantially the same description, properties and qualities as those referred to in the registration,²² shall be liable to an action on the case for damages for such unlawful use of such trademark at the suit of the owner thereof in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trademark, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful

sive use, was held not to justify issuing another certificate to another part owner of the same mark, in order to put him on an equal footing in court. *McElwee v. Blackwell*, 15 Off. Gaz. 658. In an interference, the applicant was granted registration as against a prior registrant whose user had been experimental and interrupted. *Sternberger v. Thalheimer*, 3 Off. Gaz. 120.

21—See Act of 1881, secs. 3, 7.

22—See *Osgood v. Rockwood*, 11 Blatchf. 310; Fed. Cas. No. 10605, where it was held that persons who had registered a trademark for prints made according to a patented process were not entitled under this act to an injunction against a person who had used the mark on prints not made in accordance with the patent.

use.²³ The commissioner of patents²⁴ shall not receive and record any proposed trademark which is not and cannot become a lawful trademark,²⁵ or which is merely

23—The United States circuit courts had jurisdiction under this act in cases of infringement of trademark, even when both parties were citizens of the same state. *Duwel v. Bohmer*, 14 Off. Gaz. 270; but see secs. 7 and 11 of the act of 1881.

24—The validity of the decisions of the acting commissioner was upheld in *Simpson v. Wright* (2), 15 Off. Gaz. 293.

25—The question what may be registered as being a "lawful trademark" has been considered in many cases. The device of a crown is a good trademark. *Smith v. Reynolds* (2), 10 Blatchf. 100. The arms of one of the states could not be registered as a trademark. *Ex parte Davids & Co.*, 16 Off. Gaz. 94. And it has been held that the same is the case with the Freemasons' square and compass, *Re Tolle*, 2 id. 415; and the word "Masonic," *Ex parte Smith* (3), 16 id. 764. In *Re Thomas*, 14 id. 821, the Freemasons' symbols were allowed to be registered in combination, and *Re Tolle*, *supra*, was overruled. In *Ex parte King* (2), 46 id. 119, the decision in *Re Thomas*, 14 id. 821, was followed, and the design of the badge adopted by the Grand Army of the Republic was allowed to be registered as a trademark for writing paper by a person who had no connection with that society, and it was said that, that society not having used

their badge as a mark on writing paper, they would be infringing the applicant's rights if they were to begin to do so. The words "Knights of Labor" were refused registration as a mark for whisky on this ground and because deceptive. *Ex parte Bloch & Co.*, 40 Off. Gaz. 443. A word which has become common, *e. g.*, "Calhoun" plow, cannot be registered. *Re Hall & Co.*, 13 id. 229. Registration has been refused to the following words and expressions, on the ground of descriptiveness: "Beeswax oil," *Re Hauthaway* (1), Comm. Decis. 1871, 97; *s. c.* (2), id. 284; "Razor Steel," *Re Roberts* (4), id. 100; "Invisible" face powder, *Ex parte Palmer*, id. 289; "A. Richardson's Patent Union Leather Splitting Machine," *Re Richardson*, 3 Off. Gaz. 120; "Für Familien-Gebrauch," and "Lawrence Feiner Familien-Flannel," *Re Lawrence*, 10 id. 163; "Iron Stone" drain pipes, *Re Rader & Co.*, Comm. Decis., 1878, 67; "Croup Tincture," *Re Roach*, 10 Off. Gaz. 333; "Crack-proof" India rubber, *Re Goodyear Rubber Co.*, 11 id. 1062; "Evaporated" articles of food, *Ex parte Alden*, 15 id. 389; "Standard A" cigars, *Ex parte Cohn* (1), 16 id. 680; "Drug-gists' Sundries," *Ex parte Cohn* (2), 16 id. 680; "Safety" powder, *Ex parte Safety Powder Co.*, 16 id. 136; "Medicated Prunes," *Ex parte Smith* (2), 16 id. 679; "Satin Pol-

ish," shoe polish, *Re* Brigham, Comm. Decis. 1881, 38; "Swing" scythe sockets, *Ex parte* Thompson, Derby & Co., 16 Off. Gaz. 137; "Granulated Dirt Killer" soap, *Ex parte* Waeflerling, 16 id. 764; "Famous," merchandise generally, *Re* Brand Stove Co., 62 Off. Gaz. 588; and "Splendid" flour, *Ex parte* Stokes, 64 Off. Gaz. 437. And the same has been the case with respect to the figure of a fish for fishing lines, *Re* Pratt & Farmer, 10 id. 866; and the representation of a twig with three leaves and a plum, for prunes, *Ex parte* Smith (2), 16 id. 679; and see *Popham v. Wilcox*, 66 N. Y. 69. On the other hand, "The Blanchard Churn," *Re* Porter Blanchard's Sons, Comm. Decis. 1871, 97; "Beaverine" boots and shoes, *Re* Francis & Mallon, id. 283; and "Dr. Lobenthal's Essentia Antiphthisica," *Re* Rohland, 10 Off. Gaz. 980, have been admitted to registration as being non-descriptive. In a series of cases registration has been refused on the ground that the term claimed, if properly applicable to the goods with respect to which it was used, was descriptive, but if not, was deceptive: *e. g.*, "Bromo-Quinine," *Re* Grove, 67 Off. Gaz. 1447; "American Sardines," *Re* American Sardine Co., 3 id. 495; "Egg Macaroni," *Re* Bole Bros., 12 id. 939; "Cachemire Milano," *Re* Warburg & Co., 13 id. 44; "French Paints," *Ex parte* Marsching & Co., 15 id. 294; "London" animal foods, *Ex parte* Knapp, 16 id. 318; but see *Re* Green, 8 id. 729, where registration

was granted to "German Syrup." On the latter ground of deceptiveness, the word "patent" cannot be registered as a part of a mark for an article made under an expired patent. *Re* Richardson, 3 id. 120. A geographical name is not usually registrable. *Armistead v. Blackwell*, 1 id. 603, "Durham" tobacco; *Re* Tolle, 2 id. 415, "Cherry Street Mills," and "Market Street Mills;" *Ex parte* Knapp, 16 id. 318, "London" animal foods; *Ex parte* Marsching & Co., 15 id. 294, "French Paints;" *Ex parte* Farnum & Co., 18 id. 412, "Lancaster" goods. But such a name may be registered when arbitrarily selected. *Re* Cornwall (2), 12 id. 312, "Dublin" soap. Similarly, numerals may be registered when arbitrarily selected. *Kinney v. Allen*, 1 Hughes, 106; *Ex parte* Dawes & Fanning, 1 Off. Gaz. 27; *American Solid Leather Button Co. v. Anthony*, 15 R. I. 338. But not otherwise. *Re* Eagle Pencil Co., 10 Off. Gaz. 91. It has been held that a peculiarity in the form of a barrel is not registrable as a trademark, *Moorman v. Hoge*, 2 Sawy. 78; nor a representation of such barrel when applied to the goods contained in it, *Ex parte* Halliday Bros., 16 Off. Gaz. 500; nor is a special kind of barrel-hoop registrable. *Re* Kane & Co., 9 id. 105. But see *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392. A special collar box was held not to constitute a trademark, *Carlington v. Libby*, 14 Blatchf. 128; and a sampler pattern was refused registration, *Re* Parker, 13 Off. Gaz. 323; and a strip of tobacco

intended to be wrapped around the mouthpiece of cigarettes, on the ground that it was intended to serve purposes of convenience rather than of identification, *Re Gordon*, 12 id. 517; and the use of a tin tag or ticket on the goods, irrespective of shape and design, is no trademark, *Lorillard v. Pride*, 28 Fed. Rep. 434; though a tin tag of special shape, size and color may be, *Lorillard v. Wight*, 15 Fed. Rep. 383. There is no trademark in the shape of a plug of tobacco, *Liggett & Myers Tobacco Co. v. Hymes*, 20 Fed. Rep. 883; or of a box, *Sawyer v. Horn*, 4 Hughes, 239; *Ball v. Siegel*, 116 Ill. 137; or of sticks of chewing gum, *Adams v. Heisel*, 31 Fed. Rep. 279; or of the frame of a sewing machine originally made under a patent, *Wilcox & Gibbs Sewing Machine Co. v. Gibbons' Frame*, 21 Blatchf. 431; *Brill v. Singer Manufacturing Co.*, 41 Ohio St. 127; nor in a manner of arranging in boxes cakes of soap wrapped in differently colored paper wrappers, *Davis v. Davis*, 27 Fed. Rep. 490; nor in a *nom de plume*, *Clemens v. Belford*, 11 Biss. 459. But registration has been granted to a peculiarly shaped stick intended to be so placed in a roll of carpet as to show an octagonal ring at each end, *Lowell Manufacturing Co. v. Larned*, Fed. Cas. No. 8570. Registration cannot be granted to minor and non-essential features in a compound mark. *Ex parte Coats*, 16 Off. Gaz. 544. Occasionally a mark has been allowed to be registered in alternative forms, *e. g.*, "The Star Shirt," the same words with the figure of a star, and "The * Shirt," *Morrison v. Case*, 9 Blatchf. 548;

the figure of a lion, the word "Lion," or both, *Re Weaver*, 10 Off. Gaz. 1; and see *Re Park*, 12 id. 2; *Re Thomas*, 14 id. 821; *Ex parte Peper*, 16 id. 678. A bad trademark does not become a good one by the addition of unobjectionable elements, *Re Blakeslee & Co.*, Comm. Decis. 1871, 284, "*Cundurango Ointment Co.*;" *Re Dick & Co.* 9 Off. Gaz. 538, "*D. D. & Co. tasteless*" drugs; *Re Rader & Co.*, 13 id. 596, "*Iron Stone*" in an oval border. But it appears to be possible for two marks, which separately are not good trademarks, to form one in combination. *Ex parte Davids & Co.*, 16 id. 94. A trademark cannot be registered for the purpose of being used by all the members of an association on goods of any quality, nor can a mark which is intended to be used in furthering a scheme for the restraint of trade, *Ex parte Cigar Makers' Association*, 16 id. 958; and in *Schneider v. Williams*, 44 N. J. Eq. 391, the court refused to protect such a mark at the instance of a member of the association. In *Strasser v. Moonelis*, 108 N. Y. 611; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Allen v. McCarthy*, 37 Minn. 347; and *Bloete v. Simon*, 49 Abb. N. C. 88, however, a different view was taken of the propriety of such a mark. It seems that the decision of a competent court as to the validity of a mark is binding upon the patent office. *Re India-rubber Comb Co.*, 8 Off. Gaz. 905. If an application is refused on the ground that the proposed mark is not registrable, a renewed application for the registration of a mark not open to objection must be treated as a new application, and it cannot be treat-

the name of a person, firm, or corporation only,²⁶ unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, or which is identical with the trademark appropriated to the same class of merchandise and belonging to a different owner and already registered or received for registration, or which so nearly resembles such last mentioned trademark as to be likely to deceive the public.²⁷ Provided, that this section shall not prevent the registry of any lawful trademark rightfully used at the time of the passage of this act.²⁸

ed as an amendment of the original application, nor can the fee originally paid be returned. *Re Block & Co.*, 14 id. 235.

26—Thus, in *Re Rowe & Post*, 9 Off. Gaz. 496, the name "The New York Cutlery Co." was refused registration as a new mark. As to the registration of names as old marks, see *Re Porter Blanchard's Sons*, Comm. Decis. 1871, 97; *Re Roberts* (1), id. 113; s. c. (2), id. 100; s. c. (3), id. 101; *Re India-rubber Comb Co.*, 8 Off. Gaz. 905; *Re Consolidated Fruit Jar Co.*, 14 id. 269; *Ex parte Davids & Co.*, 16 id. 94; *Re Creedmore Cartridge Co.*, 56 id. 1333. The prohibition does not extend to the registration of the name of a person other than the applicant, and such names may be registered, at all events with their owners' consent, if living. *Ex parte Sullivan & Burke*, 16 id. 765; *Ex parte Pace*, Talbott & Co., 16 id. 909.

27—Thus, in *Re American Lubricating Oil Co.*, 9 Off. Gaz. 687, registration was refused to the word "Star" as a trademark on oil, the device of a star having already been registered for the same article; so in *Re Coggin*,

Kidder & Co., 11 id. 1109, to a device in which the principal feature was the name "Haxall," which had long been the trademark of another firm; so in *Re Bush & Co.*, 10 id. 164, to a combination mark consisting of the applicant's own registered trademark and two other devices appropriated by other firms; so in *Ex parte Claire*, 15 id. 248, to the words "Black Swan," the word "Swan" being already registered; so in *Ex parte Smith* (1), 16 id. 679, to "A. S. California Family * Soap," "California" and "*" being already separately on the register; and see *Ex parte Weisert Bros.*, 16 id. 680. On the other hand, in *Re Imbs*, 10 id. 463, registration was granted, notwithstanding that two other marks contained somewhat similar features; and in *Re Cornwall* (1), 12 id. 138, a device of a star and a crescent was registered, although a star had previously been registered.

28—Under this proviso registration was granted to a name used as a trademark before 1870, *e. g.*, "The India-rubber Comb Co. of New York," *Re India Rubber Comb Co.*, 8 Off. Gaz. 905; "The Rubber

SECTION 80.²⁹ And be it further enacted, that the time of the receipt of any trademark at the Patent Office for registration shall be noted and recorded and copies of the trademark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the commissioner, shall be evidence in any suit in which such trademark shall be brought into controversy.

SECTION 81.³⁰ And be it further enacted, that the commissioner of patents is authorized to make rules and regulations³¹ and to prescribe forms for the transfer of

Clothing Co.," *Re Rubber Clothing Co.*, 10 id. 111. See *Re Dole Bros.*, 12 id. 939; *Re Consolidated Fruit Jar Co.*, 14 id. 369; *Ex parte Consolidated Fruit Jar Co.*, 16 id. 679. This saving proviso, is, however, omitted from the act of 1881, so that the prohibition as to names, etc., is universal. See Act of 1881, sec. 3, and *Ex parte Fairchild*, 21 Off. Gaz. 789, in which case registration was refused to a name which had been used as a trademark for twenty years, and had been registered under the Act of 1870.

29—See Act of 1881, secs. 3, 4.

30—See Act of 1881, sec. 12.

31—It was formerly decided that the authority given to the commissioner by section 81 to make regulations empowered him to declare an interference in a trademark case, for the purpose of deciding a question of title to the trademark, on the analogy of the practice in patent cases. *Lantz Bros. & Co. v. Schultz & Co.*, 9 Off. Gaz. 791; *Duke v. Green*, 16 id. 1094. And though it was thought in *Swift v. Peters*, 11 id. 1110, that the question whether a registered proprietor of a mark was entitled to the

exclusive use of it against an ex-partner was a question for a court of law, and not for the office, it was held in *Hoosier Drill Co. v. Ingels*, 14 id. 785, that, in investigating the title of the mark, all matters relating to the ownership should be gone into; and in *Hanford v. Wescott*, 16 id. 1181, Fed. Cas. No. 6022, it was held that a decision of the examiner of interferences, unappealed from, was conclusive as to the right to a mark; and see *Josselyn v. Swezey & Dart*, 15 Off. Gaz. 702, as to reopening the evidence taken on an interference, and *Simpson v. Wright* (1), 15 id. 248, and s. c. (2), 15 id. 293, as to rehearing an interference. After the case of *United States v. Steffens*, 100 U. S. 82, it was held that the Patent Office has no longer any authority to decide questions of disputed titles to trademarks, or to declare interferences in such cases. *Braun & Co. v. Blackwell*, 19 Off. Gaz. 481; and see *Ex parte Strasburger & Co.*, 20 id. 155, and *Jacoby & Co. v. Lopez & Co.*, 23 id. 342. And in *Yale Cigar Mfg. Co. v. Yale*, 30 id. 1183, it was decided that a declaration of interference is authorized

the right to use such trademarks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

SECTION 82.³² And be it further enacted, that any person who shall procure the registry of any trademark, or of himself as the owner thereof, or an entry respecting a trademark, in the Patent Office under this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

SECTION 83.³³ And be it further enacted, that nothing in this act shall prevent, lessen, impeach or avoid, any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if this act had not been passed.³⁴

SECTION 84.³⁵ And be it further enacted, that no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trademark which is used or claimed in any unlawful business or upon any article which is injurious in itself, or upon any trademark which has been fraudulently obtained, or which has been formed and used with the design of de-

by section 3 of the act of 1881. In such cases the only duty of the office is to decide whether the opponent has or has not a better title than the applicant, not to decide any further question. *Ibid.* If, on an interference between an applicant and a registered owner with respect to the same mark, the right to registration is adjudged to the applicant, notwithstanding the opposition of the registered owner, the result is, while strictly giving the applicant merely the right to

register, practically to displace the registered owner, though his mark is not removed from the register. *Ibid.* For the present rule as to interferences see note 7 to sec. 3 of the Act of 1881; and see § 7, Act of 1905.

32—See Act of 1881, sec. 9.

33—See Act of 1881, sec. 10.

34—See *Osgood v. Rockwood*, 11 Blatchf. 310; *Fed. Cas. No. 10605*; *United States v. Roche*, 1 McCrary, 385; *Fed. Cas. No. 16180*.

35—See Act of 1881, sec. 8.

ceiving the public in the purchase or use of any article of merchandise.³⁶

36—It seems that this act provided no means for removing from registration a mark which was wrongfully registered, *e. g.*, a mark which did not contain any of the essential particulars. See *Armistead v. Blackwell*, 1 Off. Gaz. 603; *McElwee v. Blackwell*, 15 id. 658; *Wright v. Simpson*, 15 id. 968; *Yale Cigar Mfg. Co. v. Yale*, 30 id. 1183.

APPENDIX B.

LABEL ACT OF JUNE 18, 1874.

(18 Statutes at Large, 78.)

An act to amend the law relating to patents, trademarks and copyrights.

SECTION 3. That in the construction of this act the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trademark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same.¹

1—This law can be sustained only under the constitutional delegation of authority to congress to legislate upon copyrights.

The provision quoted has reference only to such writings as are the result of intellectual labor and are founded in the creative powers of the mind.

"It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles,

and no possible influence upon science or the useful arts." Mr. Justice Field in *Higgins v. Keuffel*, 140 U. S. 428.

No action at law or in equity can be maintained for the infringement of a label so registered (copyrighted) unless the provision of the copyright law in regard to the notice has been complied with, *i. e.*, "by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words,

viz.: 'Entered according to Act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress, at Washington;' or (at the option of the registrant) the word 'Copyright,' together with the year the copyright was entered, and the name of the party by whom it was taken out;" thus, "Copyright, 18——, by A. B." *Higgins v. Keuffel*, 140 U. S. 428.

It is manifest that under this decision the act affords no protection to labels, and registration under it is idle. Luby, *Patent Office Practice*, p. 121. But until there is a decision declaring the law unconstitutional the Patent Office is open for this class of registration. *Ex parte* H. J. Heinz Co., 62 Off. Gaz. 1064. It is held, however, that a label will not be admitted to registry unless it has the same degree of artistic excellence as would entitle it to copyright in the office of the Librarian of Congress. *Ex parte* Palmer, 58 Off. Gaz. 383. And labels containing or consisting of matter constituting trademarks will not be registered until such trademark matter has been registered as trademark. *Ex parte* Diamond Laboratory Co., 44 MSS. Dec. 19; *Ex parte* Ruckstuhl, 56 Off. Gaz. 927. A label bearing the name and address of the owner, the name of the article to which it is applied, with the price and directions for use, exhibiting no attempt at artistic or literary merit, will not be registered. *Ex parte* Eldredge Co., 55 Off. Gaz. 1278. The same ruling has been made as to a label purely descriptive of the articles to which it is intended to be applied. *Ex parte* C. G. Hainline & Co., 58 Off. Gaz. 947.

Prints and labels defined.—"Registered labels or prints and trademarks are recognized by the terms of the law and decisions of the courts as applicable only to some kind of merchandise: labels, as giving the names of the manufacturers, place of manufacture, nature or quality of goods, directions for use, and the like." Doolittle, Assistant Commissioner, in *Ex parte* Parker, 13 Off. Gaz. 323.

Long prior to the decision of *Higgins v. Keuffel*, 140 U. S. 428 (*supra*), Judge Blatchford had held that this section was purely a copyright act, and that under the general copyright regulation of congress (sec. 4956, R. S.) no person could claim protection for a label so registered unless "before publication" he had deposited a printed copy of the title of the article in respect of which the copyright was claimed, in the Patent Office. *Marsh v. Warren*, 14 Blatchf. 263; 14 Off. Gaz. 678; Fed. Cas. No. 9121; 16 Fed. Cas. 821.

It has been held that the mere fact that words or designs which appear upon the label might be used as trademarks does not prevent registration under this act. *Ex parte* Orcutt & Son, 8 Off. Gaz. 276; and in another early case the applicant's label was admitted to registry, but certain "arbitrary words" and "fanciful figures" were first refused or stricken out of the label, and the commissioner suggested that they should be registered as trademarks. *Ex parte* W. Simpson & Sons, 10 Off. Gaz. 334. But as indicated in the first portion of this note, the prevailing doctrine was that "the presence in a label of matter registrable as a trademark excludes the whole

from registration." *Ex parte* Thaddeus Davids & Co., 16 Off. Gaz. 94. It has been held by the supreme court of the District of Columbia, however, that the commissioner of patents has no discretion to determine whether a particular label should be classed as a trademark or as only a label. That his duties as respects this act are purely ministerial, and *mandamus* will lie to compel him to register any label properly presented for registration. *United States ex rel. Wilcox & Gibbs Sewing Machine Co. v. Marble*, 1 Mackey, 284; 22 Off. Gaz. 1366; *United States ex rel. Schumacher v. Marble*, 3 Mackey, 32. And it is now settled that a print will not be refused registration "even though it may contain matter capable of sequestration as a trademark, not in fact registered as a trademark." Greeley, Commissioner, in *Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209, 1210.

In regard to this act, the Patent Office has adopted the following rule: "These sections of statutes (referring to sections 3, 4 and 5 of the act of June 18, 1874) are construed as authorizing the registry of 'prints' and 'labels.' A label is a device or representation not borne by an article of manufacture or vendible commodity. A print is a device or representation not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as a pictorial advertisement thereof. A label cannot be registered if it bear a device capable of registration as a trademark, until after such device is registered as a

trademark. Both labels and prints, in order to be entitled to registry, must be intellectual productions in the degree required by the copyright law."

The restriction contained in this rule as to the registration of labels containing a device capable of sequestration as a trademark does not apply to a print containing such a device, and it will be admitted to registration, even though it may contain a device so capable of sequestration as a trademark, and that device has not been registered. *Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209.

The Patent Office has furnished the following information to applicants for the registration of prints and labels under this act, and forms for use in making application for such registration:

"The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

"An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on petition, without fee.

"The word 'print,' as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic representation or intellectual production not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as an advertisement thereof.

"The word 'label,' as used in this act, so far as it relates to registra-

tion in the Patent Office, is defined as an artistic representation or intellectual production impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the contents of the package, the name of the manufacturer, or the place of manufacture, the quality of goods, directions for use, etc.

"By the words 'articles of manufacture' (to which such print or label is applicable by this act) is meant all vendible commodities produced by hand, machinery, or art.

"No print or label can be registered unless it properly belongs to an article of commerce and is as above defined.

"To entitle the proprietor of any such print or label to register the same in the Patent Office, the application for the registration thereof must be made to the commissioner of patents, and said application should be signed by the proprietor or his agent. There must also be filed in the Patent Office five copies of the print or label one of which, when the print or label is registered, shall be certified under the seal of the commis-

sioner of patents and returned to the proprietor.

"The certificate of such registration will continue in force for twenty-eight years.

"The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate, and complying with all other regulations with regard to original applications. Within two months from the date of said renewal, the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

"The fee for registration of a print or label is \$6, to be paid in the same manner as fees for trade-marks.

"The attention of persons contemplating the registry of a print or label in the Patent Office is called to the decision of the United States supreme court in *Higgins v. Keuffel*, 55 O. G. 1139; 140 U. S. 428; to the decision of the United States circuit court in *Marsh et al. v. Warren et al.*, 14 O. G. 678, and to the decisions of the commissioner of patents in *Ex parte United States Playing Card Co.*, 82 O. G. 1209, and *Ex parte Mahn*, 82 O. G. 1210."

RULES GOVERNING THE REGISTRATION OF PRINTS AND LABELS IN THE PATENT OFFICE.

UNITED STATES PATENT OFFICE,
Washington, D. C., July 1 1902.

The following rules, designed to be in strict accordance with the provisions of the copyright law, for the registration of prints and labels, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on pages 438-441.

F. I. ALLEN,
Commissioner of Patents.

CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the Commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents"; and all remittances by postal order, check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application.

Complaints against the examiner, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to registered prints and labels should refer to the name of registrant and number and date of certificate.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not generally be allowed.

9. The office can not undertake to respond to inquiries propounded with a view to ascertain whether certain prints and labels have been registered, or, if so to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express charges, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office can not aid in the selection of any attorney. An applicant may be represented by any person who is registered under the provisions of Rule 17 of the Rules of Practice of the Patent Office to prosecute applications for patents.

12. Before any attorney, original or associate, will be

allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the Commissioner may refuse to recognize any person as an attorney either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

WHO MAY REGISTER A PRINT OR LABEL.

16. The author of any print or label, who is a citizen or resident of the United States, or who is a subject or citizen of any country to whose subjects or citizens the United States has extended the benefits of copyright, is privileged to obtain registration in the United States.

Any person to whom an author who has the privilege of copyright in the United States has transferred his copyright can apply for and obtain a copyright entry as a proprietor.

17. By the act of March 3, 1891, which went into effect on July 1 of the same year, the United States Congress,

by amendment of the then existing copyright law, removed the limitation of the privilege of copyright to citizens of the United States and made it possible for foreign authors to obtain copyright in the United States upon the same terms as native authors. The last section of this statute limits its application as follows:

That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as (to) its own citizens, and when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this act may require.

Under the operation of this provision, the privileges of copyright in the United States have been extended by Presidential proclamations to the authors of Belgium, Chile, Costa Rica, Denmark, France, Germany, Great Britain and her possessions (Australia, Canada, India, etc.), Italy, Mexico, Netherlands (Holland) and possessions, Portugal, Spain, and Switzerland.

The authors of the countries named, therefore, and their assigns, as copyright proprietors, can obtain copyright protection for their prints and labels in the United States upon the same conditions as American authors.

Under the authority of the opinions of the Attorney-General dated December 2, 1898, and February 19, 1902, residents of Cuba, Hawaii, and Porto Rico are entitled to the benefits of the copyright laws relating to the registration of prints and labels.

THE APPLICATION.

18. To entitle the author or proprietor of any such print or label to register the same in the Patent Office, the application for registration thereof must be made to the Commissioner of Patents, and the said application should

be signed by the author or proprietor, or for the author or proprietor by a duly authorized agent.

19. A complete application comprises—

(a) A statement addressed to the Commissioner of Patents, disclosing applicant's name, nationality, and place of doing business; whether author or proprietor, and, if proprietor, a disclosure of the nationality of the author; the title of the print or label, and the name of the article of manufacture for which the print or label is to be used.

(b) Ten copies of the print or label, one of which, when the print or label is registered, shall be certified under the seal of the Commissioner of Patents and returned to the author or proprietor.

(c) A statement of its nonpublication prior to date of filing.

(d) A fee of \$6.

20. The title of the print or label must appear on the copies filed.

21. The deposit of the 10 copies required should be made before the publication of the print or label, the law providing that no person shall be entitled to a copyright unless he shall also not later than the date of publication thereof, in this or any foreign country, deliver the required copies of the print or label in the office of registry.

22. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a print or label by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the office.

EXAMINATION OF APPLICATIONS.

23. The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

24. All applications for registration are considered in the first instance by the examiner. Whenever on examination of an application registration is refused for any reason whatever the applicant will be notified thereof. The reasons for such rejection will be stated, and such information will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

25. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

AMENDMENTS.

26. The application may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, and if the copies of the prints or labels furnished are for any reason not registrable under the copyright law, the applicant may substitute copies which conform to the requirements of said law.

27. In every amendment the exact word or words to be stricken out or inserted must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

28. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the Commissioner.

Amendments may be made after the allowance of an application on the recommendation of the examiner, approved by the Commissioner, without withdrawing the case from issue.

29. After the completion of the application, the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers

which he wishes to amend, the office will furnish them on the usual terms. (See Rule 42.)

SUBJECT-MATTER OF APPLICATION

30. The word "print," as used in section 3 of the copyright act, so far as it relates to registration in the Patent Office, is defined as an artistic and intellectual production designed to be used for an article of manufacture, and in some fashion pertaining thereto but not borne by it; such, for instance, as an advertisement thereof.

31. The word "label," as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic and intellectual production impressed or stamped directly upon the article of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the article of manufacture.

32. No print or label can be registered unless it properly belongs to an article of manufacture, and is descriptive thereof, and is as above defined, and unless the application is filed before publication thereof.

APPEALS.

33. An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the Commissioner in person, on appeal, without fee.

ISSUE, DATE, AND DURATION OF CERTIFICATE.

34. When the requirements of the law and of the rules have been complied with, and the office has adjudged a print or label registrable, a certificate will be issued by the Commissioner under his seal, to the effect that the applicant has complied with the law, and that he is entitled to the protection of his print or label in such case

made and provided. Attached to the certificate will be a copy of the print or label.

35. The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

36. A certificate of registry shall remain in force for twenty-eight years from its date.

37. The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate and complying with all other regulations with regard to original applications. Within two months from the date of said renewal the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

ASSIGNMENTS.

38. Prints and labels are assignable in law by an instrument in writing. This should state the names of the assignee and assignor, the title of the print or label assigned; the date of filing the application, or, if registered, the date and number of the certificate, a statement of a "valuable consideration," and should be dated and signed.

Every assignment must be recorded in the Patent Office within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.

COPIES AND PUBLICATIONS.

39. After a print or label has been registered, copies thereof can be furnished, when authorized by the Commissioner, upon the payment of the fee.

40. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the proprietor; otherwise an extra charge will be made

for the time consumed in making the search for such assignment.

41. The Official Gazette of the Patent Office will contain a list of all the prints and labels registered, with the name and address of the registrant in each case, the title of the print or label, and a statement of the particular goods to which it is to be applied, together with the date of filing the application.

FEES.

42. On filing an application for registration of a print or label..	\$6.00
For manuscript copies for every 100 words or fraction thereof..	.10
For recording every assignment, agreement, power of attorney, or other paper of 300 words or less.....	1.00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words.....	2.00
For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words.....	3.00
For abstracts of title:	
For the certificate of search.....	1.00
For each brief from the digests of assignments.....	.20
For assistance to attorneys and others in the examination of records, one hour or less.....	.50
Each additional hour or fraction thereof.....	.50
For single printed copy, when authorized by the Commissioner.	.05
If certified, for the grant.....	.50
For the certificate.....	.25

43. The fee for registration of a print or label is to be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this can not be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders and checks should be made payable to the "Commissioner of Patents."

44. All money sent by mail, either to or from the Patent Office, will be at the risk of the sender. All payments to the office must be made in specie, Treasury notes, national-bank notes, certified checks, or money orders.

REPAYMENT OF MONEY.

45. Upon refusal of the Commissioner to register the print or label, and on application by the applicant, or his duly authorized agent, the fee may be returned.

NOTICE OF COPYRIGHT.

46. It is necessary, in order to maintain an action for infringement of a copyright, that the claim of copyright be printed on each copy of the article protected. The wording of the notice is determined by the copyright statute, section 4962, and should be as follows: Copyright, 19—, by (inserting full name of author or proprietor).

FORMS OF APPLICATION FOR REGISTRATION OF PRINTS.

(1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, A. B., a citizen (or subject, as the case may be) of the ———, residing at ———, ———, and doing business at No. ——— street, in said city, hereby applies as author (or proprietor, as the case may be) (if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated) for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ———, and it is used for advertising purposes for ———.

A. B.,
Author or Proprietor.

Dated this — day of ———, 190—.

(2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of ———, State of ———, and doing business at No. ——— street, in said city, and composed of the following members ———, citizens of (or subjects, as the case may be) ———, hereby apply as author (or proprietor, as the case may be) (if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated) for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ———, and it is used for advertising purposes for ———.

C. D. & Co.,
Author or Proprietor,

By C. D., *a member of the firm.*

Dated this — day of ———, 190—.

(3) FOR A CORPORATION.

To the Commissioner of Patents:

The applicant, The E. & F. Company, a corporation duly created by authority of the laws of the State of ——— (or other authority, as the

case may be), located in the city of ———, county of ———, in said State, and doing business at No. ——— street, in said city, hereby applies as proprietor (the nationality of the author from whom title is derived should be stated) for registration of the print shown in the accompanying copies, ten of which are furnished.

The print has not been published; its title is ———, and it is used for advertising purposes for ———.

THE E. & F. COMPANY,

By G. H., *the President (or other officer.)*

Dated this — day of ———, 190—.

FORMS OF APPLICATION FOR REGISTRATION OF LABELS.

(1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, A. B., a citizen (or subject, as the case may be), of the ———, residing at ———, ———, and doing business at No. ——— street, in said city, hereby applies as author (or proprietor, as the case may be) (if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated) for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

A. B., *Author or Proprietor.*

Dated this — day of ———, 190—.

—————

(2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, C. D. & Co., a firm domiciled in the city of ———, county of ———, State of ———, and doing business at No. ——— street, in said city, and composed of the following members, ———, citizens of (or subjects, as the case may be) ———, hereby apply, as author (or proprietor, as the case may be, if the application is made by the proprietor, the nationality of the author from whom title is derived should be stated), for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

C. D. & Co.,

Author or proprietor,

By C. D.,

A member of the firm.

Dated this — day of ———, 190—.

—————

(3) FOR A CORPORATION.

To the Commissioner of Patents:

The applicant, The E. and F. Company, a corporation duly created by authority of the laws of the State of ——— (or other authority, as

the case may be), located in the city of ———, county of ———, in said State, and doing business at No. ——— street, in said city, hereby applies as proprietor (the nationality of the author from whom title is derived should be stated) for registration of the label shown in the accompanying copies, ten of which are furnished.

The label has not been published; its title is ———, and it is to be used on ———.

THE E. & F. COMPANY,

By G. H.,

The President (or other officer).

Dated this — day of ———, 190—.

APPENDIX C.

PENAL ACT OF AUGUST 14, 1876.

(19 Statutes at Large, 141.)

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:

SECTION 1. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trademark pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trademark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by a fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

SECTION 2. That every person who fraudulently affixes, or causes or procures to be fraudulently affixed, any trademark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 3. That every person who fraudulently fills,

or causes or procures to be fraudulently filled, any package to which is affixed any trade-mark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, with any goods of substantially the same descriptive properties as those referred to in said registration knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representations, likeness, copy, or colorable imitation of any die, plate, brand, engraving or mold of any private label, brand, stamp, wrapper, engraving on paper or other substance or trademark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trademark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 6. That any person who shall, with intent to injure or defraud the owner of any trademark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession

any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trademark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 7. That if the owner of any trademark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe, that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or moulds, of his said registered trademark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trademark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trademark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search-warrants, and may issue a search-warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trademarks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and said empty boxes, envelopes, wrappers, cases, bottles or other packages that can be found; and

upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, colorable imitations thereof, labels, brands, stamps, or other substance, moulds, counterfeit trademarks, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trademarks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

SECTION 8. That any person who shall, with intent to defraud any person or persons, knowingly and wilfully aid or abet in the violation of any of the provisions of this act, shall upon conviction thereof, be punished by a fine not exceeding five hundred dollars, or imprisonment not more than one year, or both such fine and imprisonment.¹

1—This act is important because of its connection with the Trademark Cases, 100 U. S. 82. In that case the supreme court declared the act of 1870 to be unconstitutional because this act was by its express terms confined to frauds, counterfeits, and unlawful use of trademarks which were registered under the provisions of the former act. The registration act being invalid, the criminal enactment intended to protect the rights of registrants fell with it. Trademark Cases, 100 U. S. 82-99.

It was held that there could be no conviction under this act unless

the certificate of registration contained words to show that the alleged owner acquired an exclusive property in the mark claimed. *United States v. Braun*, 39 Fed. Rep. 775.

This statute having been judicially declared void could not be and was not made operative by the enactment of the statute of 1881. *United States v. Koch*, 40 Fed. Rep. 250.

The requirements of an application for a search-warrant under § 7 of this act were discussed by Judge Treat in *Re O'Donnell*, Fed. Case No. 10434, 14 Off. Gaz. 379.

APPENDIX D.

TRADEMARK ACT OF MARCH 3, 1881¹.

An act to authorize the registration of trademarks
and protect the same.

Be it enacted by the Senate and House of Representatives of the United States in Congress assembled:

§ 1.² That owners³ of trademarks⁴ used in commerce with foreign nations or with the Indian tribes,⁵

1—This act has been usually treated as valid. *South Carolina v. Seymour*, 153 U. S. 353; 67 Off. Gaz. 1191; *L. H. Harris Drug Co. v. Stucky*, 46 Fed. Rep. 624; *Hennessey v. Braunschweiger*, 89 Fed. Rep. 664. But in a late case Judge Jenkins said: "There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful." *Illinois Watch Case Co. v. Elgin National Watch Co.*, 94 Fed. Rep. 667-669; 87 Off. Gaz. 2323; 35 C. C. A. 237.

The supreme court, in affirming the decree of the court of appeals in this case, expressly declined passing upon the question of the constitutionality of the act. *Elgin National Watch Co. v. Illinois Watch Case Co.* (2), 179 U. S. 665-677.

This act presupposed the existence of a valid trademark which might be registered on compliance with the requirements of the act, and registration under the act did not in any manner affect the nature or function of the mark. *Ed-*

ison v. Thomas A. Edison, Jr., Chemical Co., 128 Fed. Rep. 1013.

2—See Notes, Act of 1870, sec. 77, *ante*, p. 411.

3—Ownership is a prerequisite. A carpet cleaner was refused registration for the mark used by him on his wagons and upon carpets cleaned by him, because he could not comply with the clause of the act of 1870 requiring a statement of the class of merchandise and the particular description of goods to which he applied the mark. *Re Hankinson*, 8 Off. Gaz. 89. An official fish inspector has no trademark in the official brand used by him, because he has no private ownership therein. *Chase v. Mays*, 121 Mass. 343. A certificate of registration of trademark will not be issued to the applicant and his assignee jointly. *Ex parte Spinner*, 35 MSS. D., July, 1887. A trademark adopted by a real-estate dealer for use in the course of his business cannot be registered. *Ex parte Roy*, 54 Off. Gaz. 1267. When it appears that several parties have the right to the use of the

mark, independent registration will not be granted to either of them. *Ex parte* Langdon, 61 Off. Gaz. 286. A certificate will not be issued to the assignee of the applicant. *Ex parte* Roasted Cereals Co., 57 MSS. D. 455. Even when the assignment has been recorded. *Ex parte* Bassett, 55 Off. Gaz. 997; *Ex parte* Spinner, 35 MSS. D. 15.

Thus registration was refused where the facts showed that "applicant is a voluntary association or league of flour manufacturers, all members of which use the mark upon their product and have an interest severally and in common in its protection; and the present application for registration is made by the association through its secretary, an officer duly authorized to that end. The applicant is not a corporation, nor is it, in strict use of the term, a partnership; but it is a voluntary association or league or union of the kind recognized by the laws and courts of the state of its domicile, and by the laws and courts of nearly all the states of the Union, as lawful and of the kind to which they extend protective and other relief in proper cases. As an association it does not itself make, brand, or sell the flour to which its mark is applied; but its members by its authority use the selected mark on wheat flour of their own manufacture. The league states its objects to be: 'To oppose the adulteration of flour, to assist in enforcing the law, to protect its honest millers from dishonest competition, to expose fraud, to maintain the integrity of the American milling trade, and to afford buyers a guarantee that they can obtain from members of this league absolutely pure

flour.' As to its membership, the rule is: 'Any miller who does not adulterate flour can join this league upon the payment of ten dollars membership fee, and executing the affidavit and contract which are conditions of the membership.' * * * But the ownership of the mark is, by agreement of all interested parties, vested in the association, and the right to its use by any individual arises only from permission of the association and is subject to forfeiture upon failure to comply with the prescribed terms." The commissioner saying: "I can find no authority in the trademark act permitting this office to register a trademark, the right to use which is farmed out and which is not actually used by the would-be registrant. While the verified declaration accompanying the statement in this case sets forth that no other person, firm or corporation has any right to use the mark, yet the brief of counsel shows that all of the members of the association, which is stated to be composed of a majority of the principal flour manufacturers of the United States, have a right, under certain conditions, to use the mark." Duell, Commissioner, in *Ex parte* The Anti-Adulteration League, 86 Off. Gaz. 1803.

A word to be used as the name of or mark for a patented article will not be admitted to registration. In so ruling the commissioner has said: "In view of the fact that under the trademark act of 1881 a certificate of registry remains in force for thirty years from its date, I do not think this office should register trademarks which, though lawful trademarks

at the date when registry is sought, will become public property before the expiration of the thirty years. By so doing the patent office would be placed in the light of attempting to aid in prolonging a monopoly, which manifestly, under the decisions of the courts, is unwarranted. To thus attempt to give the petitioner a monopoly for many years longer than is given by the patent would be a fraud upon the public." Duell, Commissioner, in *Ex parte Velvrl Co.*, 84 Off. Gaz. 807. To the same effect see *Ex parte F. H. Gilson Co.*, 83 Off. Gaz. 1992.

4—"Under the statute of March 3, 1881, 'owners of trademarks,' under certain conditions as to use and upon compliance with certain requirements which need not now be considered, are entitled to obtain registration therefor. The phrase 'owners of trademarks' manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trademark. It is therefore incumbent upon the various tribunals of the office having in charge the registration of trademarks, when an application for registration is filed, to decide at the outset two questions: (1) Is applicant the *owner*, and (2) is that which he seeks to register a *trademark*? Manifestly the tribunals of this office, in deciding the question of ownership, are not precluded by the statement and declaration of ownership, made by the applicant from considering and deciding whether he is or is not the *owner* of the thing sought to be registered. It is not

unusual to refuse registration because of the absence of legal title in the applicant—for example, when it appears that before applicant adopted and used his alleged mark the identical thing has been adopted and used by another. Equally is it the province and duty of the tribunals of the office having jurisdiction of the registration of trademarks to decide whether the *thing* presented for registration is a *trademark*. An applicant may be the owner of the thing alleged to be his trademark, and yet the thing presented for registration may not be a trademark. The statement and declaration of applicant that the thing presented for registration is a trademark are not conclusive. The question is what the thing *is*, and not what it is *called*. That the statute vests in this office the power to pass upon these two questions I believe, and to pass upon such questions has been the uniform practice of my predecessors ever since the enactment of the trademark law of 1881." Duell, Commissioner, in *Ex parte The Bronson Co.*, 87 Off. Gaz. 1782; and in *Ex parte Buffalo Pitts Co.*, 89 Off. Gaz. 2069.

5—Commerce with the Indian tribes may be conducted wholly within the limits of a single state. "The power of congress is not determined by the locality of the traffic, but extends wherever intercourse with Indian tribes, or with any member of an Indian tribe, is found, although it may originate and end within the limits of a single state." Prentice & Egan, Commerce Clause of the Federal Constitution, p. 346, citing *United States v. Holliday*, 3 Wall. 407; *Territory v. Guyott*, 9 Mont. 46.

provided such owners shall be domiciled in the United States or located in any foreign country or tribe, which, by treaty, convention, or law,⁶ affords similar privileges to citizens of the United States, may obtain registration⁷ of such trademarks by complying with the following requirements:

6—The fact that a mark is lawful in a foreign country is no test of its registrability here. *Re Moët & Chandon*, 18 MSS. D. 259. In that case registration was refused although the mark had been registered in France. On the other hand, the words "Germania" and "Goliath" have been registered in the United States by citizens of Germany, notwithstanding the fact that the words could not be registered in Germany as trademark, because it appeared that citizens of the United States had been permitted to register marks in Germany for which German citizens would not be allowed registration. *Re Manske & Co.*, 64 Off. Gaz. 858; *Re Schmidt*, 53 MSS. D. 7. Under this act a foreigner is entitled to no other or further rights than a citizen of the United States. *Ex parte Buffalo Pitts Co.*, 89 Off. Gaz. 2069.

The distinction between the terms "treaty" and "convention" is purely artificial. "A treaty is primarily a contract between two or more independent nations." Mr. Justice Field, in *Whitney v. Robertson*, 124 U. S. 190-194.

The International Convention for the Protection of Industrial Property, signed at Paris, March 20, 1883, and acceded to by presidential proclamation on behalf of the United States, March 29, 1887, cannot become operative in the absence of federal legislation. Opin-

ions of the Attorney-General, 1889, p. 253; 47 Off. Gaz. 398; *Ex parte Zwack & Co.*, 76 Off. Gaz. 1855.

For treaties and conventions, 1776-1887, see "Treaties and Conventions Between the United States and Other Powers:" Government Printing Office, 1889. See *post*, Appendix Q.

The declaration with Great Britain is drawn so as to confer mutual trademark rights upon the subjects and citizens of each of the contracting parties throughout the dominions and possessions of the other. Citizens or residents of British colonies are therefore permitted to register their trademarks under this treaty whenever it is satisfactorily shown that in the respective colonies similar protection is afforded to citizens of the United States.

7—"Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark; or in cases where it is necessary to give jurisdiction to the United States courts." Hawley, J., in *Hennessy v. Braunschweiger*, 89 Fed. Rep. 664. To the same effect see *Waukesha Hygeia Mineral Springs Co. v. Hygeia Distilled Water Co.*, 70 Off. Gaz. 1319; 63 Fed. Rep. 438; 11 C. C. A. 277; *Sarrazin v. W. R. Irby Cigar & Tobacco Co.*, 93 Fed. Rep. 624-627; *Brower v. Boulton*, 53 Fed. Rep.

1st. By causing to be recorded in the Patent Office a statement specifying name,⁸ domicile,⁹ location,¹⁰ and citizenship¹¹ of the party applying; the class of merchandise and the particular description of goods comprised in such class to which the particular trademark

389; *Adams v. Heisel*, 31 Fed. Rep. 279-281.

The act does not define trademarks.—"It will be observed that the statute (referring to the act of 1870) does not define the term 'trademark,' or say of what it shall consist. The term is used as though its signification was already known to the law. It speaks of it as an already existing thing, and protects it as such. The thing to be protected must be an existing lawful trademark, or something that may then for the first time be adopted as a lawful trademark independent of the statute. There must be a lawful trademark adopted without reference to the statute, and then, by taking the prescribed steps, that trademark, so already created and existing, may receive certain further protection under the statute." *Moorman v. Hoge*, 2 Sawy. 78. The reasoning of this opinion is equally applicable to the act of 1881. *L. H. Harris Drug Co. v. Stucky*, 46 Fed. Rep. 624-628; *Ex parte M. Block & Co.*, 40 Off. Gaz. 443.

8—The christian name of the applicant should be given in all cases, instead of the initial only, for reasons indicated in *Monroe Cattle Co. v. Becker*, 147 U. S. 47; *United States v. Upham*, 43 Fed. Rep. 68.

9—Domicile, i. e., the place of residence of the applicant; "that place in which he has fixed his habitation, without any present in-

tention of departing therefrom." *Gordon, J.*, in *Carey's Appeal*, 75 Pa. St. 201-205.

10—Where an application shows the applicant to be a citizen of one foreign country and located in another, his application will be governed by the existing treaty, convention or law of the country of his location. By location is meant the *situs* of the factory or other place of business of the applicant. *Re Haggenmacher*, 60 Off. Gaz. 438.

11—What the applicant's citizenship may be is wholly immaterial. His right to registration is governed by the country of his location, which may or may not be identical with that of his citizenship. *Re Haggenmacher, supra*.

Citizenship defined.—Citizenship means "residence with intention of remaining permanently at that place. A man may reside in a state for an indefinite period of time without becoming a citizen, but the moment a man takes up his residence in a state different from that where he formerly was domiciled or was a citizen, with intent and purpose of making the new place of residence his future home, that moment he loses his former domicile, and becomes domiciled in the new place; or in other words, he ceases to be a citizen of the former place of residence and becomes a citizen of the state of his adoption." *Turner, J.*, in *Winn v. Gilmer*, 27 Fed. Rep. 817.

has been appropriated;¹² a description of the trademark itself¹³ fac-similes thereof,¹⁴ and a statement of the mode

12—The fact that the Amoskeag Manufacturing Company had applied its mark to cotton goods except prints did not give it an exclusive right to its use on all cotton goods including prints. *Amoskeag Mfg. Co. v. Garner*, 55 Barb. 151. The term "Fancy Goods" includes too many sub-classes to be allowed in one registration. *Re Lisner*, Comm. Decis. 1878, p. 46. Registration has been refused for a mark to cover an indurated blood compound and the various articles, such as door knobs, to be made from it. *Re Dibble Mfg. Co.*, 18 MSS. D. 428. Application for registration of a mark to be used upon druggists' sundries was refused because the words were too indefinite. *Re Maw, Son & Thompson*, 22 MSS. D. 403.

What one registration may cover.

—A single trademark may be registered to be applied to all goods made of hard rubber. *Re India Rubber Comb Co.*, 16 MSS. D. 38. Bourbon, wheat and rye whiskies, wines, brandies and gins, may be included in one registration. *Re Boehm & Co.*, Comm. Decis. 1875, p. 103; as may "agricultural implements," *Re Manny & Co.*, 17 MSS. D. 155; "canned goods," *Re Fitzpatrick, Davis & Co.*, 18 MSS. D. 278; and "cutlery," *Re Kampfe Bros.*, 58 MSS. D. 306; as well as proprietary medicinal and toilet compounds, *Re Knight*, 38 MSS. D. 341. One registration may, however, cover all the classes of goods upon which the trademark has been used. *Ex parte Clark-Jewell-Wells Co.*, 83 Off. Gaz. 915.

But a picture and a word cannot be embodied in the same registration unless they are true alternatives. *Ex parte J. D. Richards & Sons*, 54 MSS. D. 425; *Ex parte Adam Roth Gro Co.*, 62 Off. Gaz. 315; *Ex parte Kinney*, 72 Off. Gaz. 1349; *Ex parte Muir*, 87 Off. Gaz. 357; *Ex parte Lazarus Schwarz & Lipper*, 64 Off. Gaz. 1396.

13—The description must distinguish the essential from the non-essential features of the mark. *Re Volta Belt Co.*, 8 Off. Gaz. 144. The essential features being those serving to distinguish the goods of the applicant, an essential feature cannot be anything that is not a valid trademark, such as the geographical word "Lancaster." *Re Farnum & Co.*, Comm. Decis. 1880, p. 155; 18 Off. Gaz. 412; *Re Adriance, Platt & Co.*, Comm. Decis. 1881, p. 52; 20 Off. Gaz. 1820; *Re Pierce*, 23 MSS. D. 16. The description and fac-simile incorporated in the certificate of registration are evidence to show the extent of the owner's claim of trademark, when he sues for its protection as a common-law trademark. *Richter v. Reynolds*, 59 Fed. Rep. 577; *Kohler Mfg. Co. v. Beeshore*, 53 Fed. Rep. 262; s. c., 8 C. C. A. 215. The essential feature of a trademark is not that which the registrant elects to designate as such, but that which would strike the public mind as its most salient feature. *Ex parte Standard Fashion Co.*, 89 Off. Gaz. 189.

14—This section does not contemplate registration of form, material, or color. Materials are not

in which the name is applied and affixed to goods,¹⁵ and the length of time during which the trademark has been used.¹⁶

subject to appropriation as trademark; it has been so held in regard to tin used as tags upon plug tobacco, *Lorillard v. Pride*, 28 Fed. Rep. 434; nor is a method of bronzing horse-shoe nails, *Putnam Nail Co. v. Bennet*, 43 Fed. Rep. 800; 59 Fed. Rep. 909; 8 C. C. A. 362; nor the form of sticks of chewing gum, *Adams v. Heisel*, 31 Fed. Rep. 279; nor the method in which goods are arranged in packages, *Ibid.*, and *Davis v. Davis*, 27 Fed. Rep. 490.

For further discussion of form, color, etc., see *ante*, pp. 247 et seq.

A fac-simile need not contain any unessential portion of the mark sought to be registered. *Re Watson*, 16 MSS. D. 467; *Re Armstrong & Co.*, 26 MSS. D. 260.

One fac-simile only is sufficient to illustrate the mode of using the mark. *Re Kimball*, Comm. Decis. 1887, p. 54.

Fac-simile defined.—"A fac-simile is an exact counterpart of an original, and a fac-simile represented by a drawing is an exact counterpart of an original, so far as the nature of a drawing permits. A close adherence to the language of the statute would seem to require that in each case the trademark and nothing but the trademark should be represented by the drawing, and while, perhaps, it would be going too far to apply in all cases a rule so rigorous, it is certainly within the discretion of the office to insist upon it in cases where . . . legitimate doubts arise as to whether protec-

tion should not be sought through the law relating to designs. In my judgment the cases are very rare in which the registration of a trademark under the statute requires or should permit of any other matter than the fac-simile of the trademark." Mitchell, Commissioner, in *Ex parte Hudson*, 55 Off. Gaz. 1401. Applicants are restricted to symbols which conform to their fac-similes as well as to their verbal descriptions. *Duke v. Green*, 16 Off. Gaz. 1094.

15—The statement of the mode of application must be given. *Ex parte Hudson*, 55 Off. Gaz. 1401. It must appear that the trademark is intended to be used upon "goods or manufactured articles, the general objects of commerce." *Ex parte Roy and Nourse*, 54 Off. Gaz. 1267. The use of a trademark upon bill-heads, letter-heads, cards and circulars used in a business does not come within the contemplation of the statute; although it would be properly a trademark if used thereon as articles of commerce and not as mere vehicles of communication between a dealer and other persons. *Ibid.* The things to which a trademark may be affixed so as to be entitled to registration are goods, wares and merchandise—articles that may be transported, in contradistinction to those fixed species of property which the law includes under the term real estate. *Ibid.* Registration under this act is limited to marks used upon manufactures or merchandise. *Re Hankinson*, 8 Off.

2d. By paying into the treasury of the United States the sum of twenty-five dollars,¹⁷ and complying with such regulations as may be prescribed by the Commissioner of Patents.

Gaz. 89. It is a sufficient application if the mark is used in advertising, and a lithographed reproduction of it inserted in each box containing the merchandise. *Hay & Todd Mfg Co. v. Querns Brothers*, 86 Off. Gaz. 1323.

16—The language of the Act of 1871 was "the length of time, *if any*, during which the trademark has been used." This was construed to admit marks to registration that never had been used in commerce. *Re Rothschild*, 7 Off. Gaz. 220. It must now be shown as a prerequisite to registration that there has been actual application of the mark to merchandise and actual user in commerce. *United States v. Seymour*, 66 Off. Gaz. 1167. Registration under this statute avails nothing if the name or symbol is never used. *Siegert v. Abbott*, 72 Hun, 243.

It was held in one case that a citizen of France who had not deposited his mark in the Patent Office under the provisions of the treaty of 1869 between the United States and France could not maintain an action for infringement. *Lacroix v. Escobal*, 37 La. Ann. 533. But in a later case it is held that a registration under the Act of 1881 by a French citizen renders the deposit of the mark under the terms of that convention unnecessary. *Société de la Benedictine v. Micalovitch*, 36 Alb. L. J. 364. The dates of adoption set forth in the applications of two

rival registrants are not conclusive. *Einstein v. Sawhill*, 61 Off. Gaz. 287. Where actual user appears to have been first made after application for registry, the mark may be admitted to registration upon the filing of a supplemental application. *Einstein v. Sawhill* (2), 64 Off. Gaz. 1533.

User in a foreign country alone does not entitle an applicant to registration under this section. *Farmers Mfg. Co. v. W. R. Harrison & Co.*, 96 Off. Gaz. 2062; *Leprince v. Iler & Morris*, 92 Off. Gaz. 189. "Limited sales in this country by a foreign manufacturer upon especial orders to supply particular customers" do not give a common law right to the mark "since they did not constitute a use of the mark in such circumstances as to publicity and length of use as to show an intention to adopt it as a trademark." *Allen, Commissioner, in Farmers Mfg. Co. v. W. R. Harrison & Co.*, 96 Off. Gaz. 2062.

17—The fee cannot be refunded because registration is refused. *Re Thayer*, 54 Off. Gaz. 957. Where the domestic branch of a house having offices in the United States and abroad, filed an application in ignorance of the fact that an identical application had been made by one of the foreign offices, the fee paid on the second application was refunded. *Re Finlayson, Bousfield & Co.*, 61 Off. Gaz. 152.

§ 2.¹⁸ That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm,¹⁹ or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trademark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive,²⁰ that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated,²¹ and that the description and fac-similes presented for registry truly represent the mark sought to be registered.²²

§ 3.²³ That the time of the receipt of any such application shall be noted and recorded. But no alleged trademark shall be registered unless the same appear to

18—See Act of 1870, sec. 77, *ante*, p. 411.

19—An application of a partnership cannot properly be made by one not a member of the firm but merely a so-called "director." *Ex parte* Kirker, Greer & Co. (Ltd.), 37 MSS. D. 392.

20—Registration will be refused whenever in the opinion of the commissioner the mark offered is so similar to a registered mark as to be likely to lead to mistake or confusion. *Ex parte* Coon, 58 Off. Gaz. 946. In case of doubt concerning such similarity, that doubt will be resolved against the applicant. *Re* Bowe, 50 MSS. D. 168; *Re* Bogardus, 50 MSS. D. 2.

21—The declaration on oath that there has been a user of the mark in the classes of commerce specified is insisted on by the Patent Office. *Ex parte* Strasburger & Co., 20 Off. Gaz. 155.

22—A word and a figure which are true alternatives constitute a single mark. *Morrison v. Case*, 9 Blatchf. 548; 2 Off. Gaz. 544. Hence they may be covered by one registration. *Re* Weaver, 10 Off. Gaz. 1; *Ex parte* Kinney, 72 Off. Gaz. 1346. But where they are not true alternatives, as in the case of the word "Crescent" and the figure of the crescent moon, and the word and figure might convey wholly different meanings to the observer, they will not be registered upon a single application. *Ex parte* Lazarus Schwarz & Lipper, 64 Off. Gaz. 1396; *Ex parte* Roth Grocery Co., 62 Off. Gaz. 315.

23—See Act of 1870, secs. 79, 80, *ante*. The fact that this act does not expressly exclude descriptive words from registration does not raise a presumption that descriptive words should be admitted to registration. L. H.

be lawfully²⁴ used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely

Harris Drug Co. v. Stucky, 46 Fed. Rep. 624-627.

24—See cases cited in note to sec. 79 of the Act of 1870, *ante*.

A mark that is deceptive in its nature will not receive registration. *Ex parte* Bloch & Co., 40 Off. Gaz. 443; *Re* Chichester Chemical Co., 52 Off. Gaz. 1061; *Re* American Sardine Co., Comm. Decis. 1873, p. 82; *Re* Grove, 67 Off. Gaz. 1447. The coat-of-arms of the United States, or either of the states, will not be admitted to registration. *Ex parte* Schmachtenberg Bros., 51 MSS. D. 204.

Nor will a descriptive word: as "Albany Beef," for canned sturgeon, *Re* Ames, 23 Off. Gaz. 344; "Chili Colorow," for table sauce, *Re* Railton, 25 MSS. D. 321; "Time-Keeper," for watches, *Ex parte* Strasburger & Co., 20 Off. Gaz. 155; "Cristalline," for artificial jewels, *Ex parte* Kipling, 24 Off. Gaz. 899.

Nor a picture or word that is descriptive or deceptive. *Ex parte* Martin, 89 Off. Gaz. 2258; *Ex parte* Wolf, 80 Off. Gaz. 1271; *Ex parte* Grove, 67 Off. Gaz. 1447.

Nor a geographical word: as "Cromarty," for dried fish, *Re* Proctor, Jr., 51 Off. Gaz. 1785; "Trenton," for saws, *Re* American Saw Co., 58 Off. Gaz. 521; "Cloverdale," *Re* Hendley, 72 Off. Gaz. 1654. In many instances, however, where the commissioner has deemed the geographical word to be used in a purely arbitrary sense

it has been admitted to registration. *Re* Cornwall & Bros., 12 Off. Gaz. 312; *Ex parte* Tietgens & Robertson, 87 Off. Gaz. 2117. The following extracts from leading rulings of the Patent Office may serve as guides for applicants seeking registration for geographical words. Their registrability "is to be determined in view of the circumstances of each particular case. . . . One geographical name might be either descriptive or deceptive; another geographical name applied to the same article might be neither." Thus, it was held that it having become a common practice to apply the words "Irish," "Limerick," etc., to soap, there was no objection to registering the word "Dublin," as applied to soap; in view of the state of the trade and the nature of the article, "Dublin" applied to soap manufactured in this country, was neither descriptive nor deceptive. This doctrine was announced in a decision of Acting Commissioner Doolittle, refusing registration for the word "French" as applied to American made paints on the ground that it was deceptive. *Re* J. Marsching & Co., 15 Off. Gaz. 294. In a later decision, refusing registration to the word "Cloverdale" as a trademark for canned fruits and vegetables, Acting Commissioner Fisher announced the following classification: "Geographical names may for convenience be divided into three classes; first, those that are well known

the name of the applicant,²⁵ nor which is identical with a registered or known trademark²⁶ owned by another and

and in common use—such, for example, as ‘United States,’ ‘New York,’ ‘San Francisco,’ etc. The law is settled that words coming under this class ought not to be registered. The second class includes words which in their primary significance are not geographical, even though they may appear in the Postal Guide or similar publications. Such words as ‘trilby,’ ‘creole,’ ‘puritan’ and ‘volunteer,’ are good examples of this class. These words, it seems to me, ought not to be refused registration on the ground that they are geographical, since it cannot fairly be said that they are ‘words in common use as designating locality or section of a country.’ The third class would logically occupy a position between the two classes mentioned above, and it consists of words which primarily have a geographical meaning—for example, terms ending or compounded with such words as ‘city,’ ‘town,’ ‘shire,’ ‘mount,’ or ‘mont.’ Such words, I think, should not be registered, for the reason that they are clearly geographical in their primary significance, even if it cannot be said that they are widely enough known to come strictly under the first class. It seems to me that the word in question, ‘Cloverdale,’ clearly comes under the third class.” *Ex parte* Hendley, 72 Off. Gaz. 1654. A geographical word does not become properly registrable by being enclosed in a geometrical figure. So the word “Yucatan” was refused registration as a mark for leather, even though enclosed in a square figure. *Ex parte* Weil, 83 Off. Gaz. 1802.

25—This prohibition is strictly enforced. Even a name used as a mark for twenty years, and admitted to registration under the act of 1870 has been refused registration under this statute. *Re Fairchild*, 21 Off. Gaz. 789. Congress by an enactment under date of August 5, 1882, provided: “That nothing contained in the law (of March 3, 1881), shall prevent the registry of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.” 22 Stats. at Large, p. 298. This proviso has admitted to registration names of corporations, as, for example, the words “Union Metallic Cartridge Co.,” which were in use as merchandise marks prior to March 3, 1881. But no name of a corporation not used prior to that time as a mark can now be admitted to registration. *Ex parte* Creedmore Cartridge Co., 56 Off. Gaz. 1333. And see note to the act of August 5, 1882. Registration has been refused to a name as part of a trademark which also included a device. *Ex parte* Adriance, Platt & Co., 20 Off. Gaz. 1820. But a name used as part of an old combination trademark has been admitted to registry. *Ex parte* Frieberg & Workum, 20 Off. Gaz. 1164. A proper name joined to a geographical name does not constitute a valid trademark, therefore “Buffalo Pitts” was refused registration as a trademark for threshing machines. *Ex parte* Buffalo Pitts Co., 89 Off. Gaz. 2069.

26—Registration has been refused where the applicant's mark,

appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trademark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.²⁷ In an application for registration the commissioner of patents shall decide the presumptive lawfulness of claim to the alleged trademark;²⁸ and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the

"Triumphant" for flour, had been registered by another under the act of 1870, and not re-registered under the act of 1881. *Ex parte* Lyon, Dupuy & Co., 28 Off. Gaz. 191; Dyrenforth, Acting Commissioner, tersely observing that "To decide otherwise would be to open Pandora's box and turn loose fraud upon individuals and imposition upon the public." The fact that the applicants used the mark in foreign commerce while the record did not show the registrant to have done so was held immaterial. *Ibid*; and to the same effect, *Yale Mfg. Co. v. Yale*, 30 Off. Gaz. 1183. A trademark consisting of a design will not be admitted to registration, when the same design has been embodied in a design patent granted to another. *Ex parte* Lee & Shepard, 24 Off. Gaz. 1271.

27—The commissioner must decide, "first, if the applicant has actually used the trademark in lawful commerce with foreign nations or with the Indian tribes, and then if he has the right to the use of it at all. If he finds that the alleged trademark is the name of the applicant or any other name which cannot lawfully be converted into a trademark at common law, or that it is identical with the trademark of another,

registered or unregistered, or is a deceptive imitation of another, or that it is not the property of the applicant, he cannot admit it to registration, though he may be satisfied that the applicant has used it in regular commerce with foreign nations or the Indian tribes." Court of Appeals, District of Columbia, by Sheppard, J., in *United States v. Seymour*, 66 Off. Gaz. 1167-1169. Where a part of the applicant's mark was the word "Railway," which word had been registered by another, the application was refused. *Ex parte* Strasburger & Co., 20 Off. Gaz. 155. The question presented to the commissioner upon an issue of anticipation is "whether the trademark sought to be registered is so similar to any trademark already registered for use upon the same class of articles as to be calculated to deceive purchasers using ordinary caution." Frothingham, Assistant Commissioner, in *Ex parte* George B. Hurd & Co., 59 Off. Gaz. 1763; and to the same effect, *Ex parte* Coon, 58 Off. Gaz. 946.

28—No court can grant registration nor direct the action of the commissioner by *mandamus*. His duties are not ministerial, but require the exercise of judgment and discretion. His performance of

practice of courts of equity of the United States in analogous cases.²⁹

§ 4. That certificates of registry of trademarks shall be issued in the name of the United States of America under the seal of the Department of the Interior, and shall be signed by the commissioner of patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trademarks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trademarks shall be brought in controversy.³⁰

those duties will not be reviewed on or controlled by *mandamus*. United States v. Seymour, 66 Off. Gaz. 1167-1172, 153 U. S. 353, 38 L. Ed. 742.

29—Under this provision the commissioner has power to declare an interference, even between a partnership and one of its members. If the applicant shows better title he will be admitted to registration notwithstanding a prior registry. Yale Mfg. Co. v. Yale, 30 Off. Gaz. 1183. In such a case the burden of proof to establish priority is upon the applicant. Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721. In cases of interference the question presented to the commissioner is substantially the same as would arise in a court of equity if either of the parties were seeking to enjoin the other from the use of the mark. Ibid. In interferences the issue is as broad as the broadest claim. S. Hershheim Bros. & Co. (Ltd.) v. J. H. Hargrave & Son, 81 Off. Gaz. 503; Joseph Banigan Rubber Co. v. Bloomingdale, 89 Off. Gaz. 1670. By section 9 of the act establishing the court of appeals of the District of Columbia that court is

given the determination of appeals from the decision of the commissioner of patents "in any interference case." That court has held that this clause does not refer to or include trademark interferences. Einstein v. Sawhill, 65 Off. Gaz. 1918. An applicant presented for registration a mark substantially the same as one registered by another under the act of 1870, which had not been re-registered under the act of 1881. Registration was refused by the examiner. The applicant then sought to institute an interference; this was refused because the former registration was void. Under all the facts the commissioner notified the registrant under the act of 1870 that an application for registry was pending with which his registry would interfere if it were a registry under the act of 1881, and that sixty days would be allowed wherein the former registrant might make an application under the act of 1881 with a view to interference. *Ex parte American Lead Pencil Co.*, 61 Off. Gaz. 151.

30—The decision of the commissioner of patents upon interfer-

§ 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trademark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trademark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of thirty years, such registration may be renewed on the same terms and for a like period.³¹

§ 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the treasury of the United States with intent to procure protection for the same trademark.³²

§ 7. That registration of a trademark shall be *prima facie* evidence of ownership.³³ Any person who shall

ence proceedings was held under the act of 1870 to render the issues presented to him *res adjudicata* and they cannot be reopened in a subsequent proceeding between the parties. *Hanford v. Westcott*, Fed. Case No. 6,022, 16 Off. Gaz. 1181. But in passing upon the same question under the Act of 1881 Judge Adams said, of *Hanford v. Westcott*, "if the reasoning of that case was ever persuasive, it cannot be considered so in the light of the changes in the law since it was rendered." *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 123 Fed. Rep. 149, 152.

31—See Act of 1870, sec. 78, *ante*.

32—The fee for registration under the act of 1881 was required to be paid upon filing the application.

The sum of \$10 paid as a first

fee under the act of 1870 was credited upon this payment on applications pending in the Patent Office when the act of 1881 went into effect.

But all persons to whom registration was granted under the act of 1870 were entitled to register under this act without additional charge. *Jacoby & Co. v. Lopez*, 23 Off. Gaz. 342.

33—As to the evidenciary value of the certificate of registration, see *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S., 665-672; *Brower v. Boulton*, 7 C. C. A. 567, 58 Fed. Rep. 888; *United States v. Duell*, 17 App. Cas. (D. C.) 478; *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 824; *Hennessey v. Braunschweiger*, 89 Fed. Rep. 664; *Welsbach Light Co. v. Adam*, 107 Fed. Rep. 463. That this section has no bearing upon the jurisdiction of a state court in a proceeding under a state statute

reproduce, counterfeit, copy or colorably imitate any trademark registered under this act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration,³⁴ shall be liable to an action on the case for damages for the wrongful use of said trademark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trademark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.³⁵

§ 8. That no action or suit shall be maintained under the provisions of this act in any case when the trademark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of

see *People v. Molins*, 10 N. Y. Supp. 130.

Thus the registration of a mark by another throws the burden of proving priority upon one who subsequently applies for registration for the same mark. *Manitowoc Mfg. Co. v. Dickerman*, 57 Off. Gaz. 1720. See act of 1870, sec. 78, 79; *ante*.

34—As to what is "merchandise of substantially the same descriptive properties," see *Air-Brush Mfg. Co. v. Thayer*, 84 Fed. Rep. 640; *Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan*, 96 Fed. Rep. 206.

Blanks and envelopes used by a telegraph company are not "merchandise" within the meaning of

this section. *Postal Tel. Cable Co. v. Netter*, 102 Fed. Rep. 691.

35—Registration of a mark common to the trade does not confer an exclusive right to its use. *Stachelberg v. Ponce*, 128 U. S. 686. Registration of a mark is not conclusive. Its use may be restrained at the suit of one who has a prior right to its use. *Glen Cove Mfg. Co. v. Ludeling*, 22 Fed. Rep. 824, 826; *Schumacher v. Schwenke* (2), 36 Off. Gaz. 457; *Hennessy v. Braunschweiger*, 89 Fed. Rep. 664.

The registrant will not be protected in the use of his trademark if it is found to contain a material false representation. *Seabury v. Grosvenor*, 14 Blatchf. 262.

Jurisdictional amount. — The

merchandise, or under any certificate of registry fraudulently obtained.³⁶

§ 9. That any person who shall procure the registry of a trademark, or of himself as the owner of a trademark, or an entry respecting a trademark, in the office of the commissioner of patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damage sustained in consequence thereof to the injured party, to be recovered in an action on the case.³⁷

§ 10. That nothing in this act shall prevent, lessen, impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed.³⁸

§ 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trademark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trademark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.³⁹

amount in controversy is the value of the trademark. *Symonds v. Greene*, 28 Fed. Rep. 834; *Hennessey v. Herrmann*, 89 Fed. Rep. 669.

36—This provision is merely in declaration of the common law. See act of 1870, sec. 84, *ante*.

37—See act of 1870, sec. 82, *ante*.

38—See act of 1870, sec. 83, *ante*. "The present act does not abridge or qualify the common-law right, but by the express term of section 10 preserves it intact." *Wallace, J., in LaCroix v. May*, 15 Fed. Rep. 236.

39—See Act of 1870, sec. 78, *ante*.

Where both parties are citizens of the same state the averments of the complaint must show that both the parties are using the mark in commerce with foreign nations or with the Indian tribes. *Ryder v. Holt*, 128 U. S. 525; *Luyties v. Hollender* (1), 21 Fed. Rep. 281; *Schumacher v. Schwenke*, 26 Fed. Rep. 818; *Luyties v. Hollender* (2), 30 Fed. Rep. 632; *Gravely v. Gravely*, 42 Fed. Rep. 265; *Prince's Metallic Paint Co. v. Prince Mfg. Co.*, 53 Fed. Rep. 493. Such an averment is

§ 12. That the commissioner of patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trademarks and for recording such transfers in his office.⁴⁰

§ 13. That citizens and residents of this country wishing the protection of trademarks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trademarks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.⁴¹

necessary only where the proceeding is between citizens of the same state. It is not necessary where the complainant is an alien. *Hennessy v. Braunschweiler*, 89 Fed. Rep. 664.

40—See Act of 1870, sec. 81. This section provides for transfers only being registered. An instrument affecting the use of a trade-mark, but not amounting to a transfer or assignment thereof, cannot legally be registered in the Patent Office. *Waukesha Springs Co. v. Hygeia Water Co.*, 63 Fed. Rep. 438-442.

41—"One reading the section would infer that foreigners have been allowed under the preceding sections some privilege; but a careful reading of the act fails to disclose that a foreigner is entitled to any other or further rights than those given to citizens of the United States. The phrase 'as is above allowed to foreigners' renders the section meaningless." Duell, Commissioner, in *Ex parte Buffalo Pitts Co.*, 39 Off. Gaz. 2069.

APPENDIX E.

ACT OF AUGUST 5, 1882.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:

That nothing contained in the law entitled "An act to authorize the registration of trademarks and protect the same," approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act.¹

Approved August 5, 1882.

[1905. Department Circular No. 40. Division of Customs.]

TREASURY DEPARTMENT, OFFICE OF THE SECRETARY,

Washington, March 21, 1905.

To Collectors of Customs and Others Concerned:

The attention of officers of the customs and others is invited to the following provisions of section 27 of the act approved February 20, 1905, effective April 1, 1905:

"Section 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to

1—This act applies only to such marks as were lawful trademarks prior to March 3, 1881, and only such marks can be admitted to registration. Long prior to 1881 it had been established that no one could exclusively appropriate a surname as a trademark. Therefore a surname cannot be registered under the act of 1881. *Ex parte* Gale Mfg. Co., 85 Off. Gaz. 1907.

aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of his name, the name of the locality in which his goods are manufactured, or of his registered trademark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs."

The provisions of this section give to manufacturers and traders located in foreign countries, which, by treaty stipulations, give similar privileges to the United States, the same advantages as are given to domestic manufacturers and traders. The act does not affect names or trademarks heretofore recorded in the Treasury Department, and as to them the protection so far as concerns prohibition of importation will continue. Nor does the act appear to make it compulsory on the part of domestic manufacturers or traders, or foreign manufacturers or traders, to register names (not trademarks) with the Commissioner of Patents, in order to prevent illegal importations.

Domestic manufacturers and traders, and foreign manufacturers and traders, to avail themselves of the privileges of the act, so far as concerns trademarks, are required to register their trademarks with the Commissioner of Patents before the Treasury Department can act.

Applications for recording the names and trademarks in this Department under section 27 will state the name of the owner, his residence and the locality in which his goods are manufactured, and in the case of trademarks should be accompanied with a certified copy of the certificate of registration of his trademark issued in accordance with the provisions of the act and the names of the ports to which fac-similes should be sent. In the case of the name of a domestic manufacture, manufacturer or trader (not registered as a trademark in the Patent Office) the application must be accompanied by the proper proof of ownership and proof as to the country or locality in which the goods are manufactured, which must consist of the affidavit of the owner or one of the owners, certified by an officer entitled to administer oaths and having a seal.

On the receipt by a customs officer of any such fac-similes, with information from the Department that they have been recorded therein, he will properly record and file them and exercise care to prevent the entry at the custom-house of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trademarks in the Treasury Department and custom-houses.

A sufficient number of fac-similes should be forwarded to enable the Department to send one copy to each port named in the application, with ten additional copies for the files of the Department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured," and collectors and other officers of the customs are instructed to use due diligence to prevent violations of this provision.

The provisions of the act also apply to Porto Rico, the Philippine Islands, Hawaii, and any other territory under the jurisdiction and control of the United States.

LESLIE M. SHAW,
Secretary.

APPENDIX F.

TRADEMARK PROVISION OF THE TARIFF ACT OF 1897.

(30 Statutes at Large, 151.)

Section 11 of this chapter provides: "That no article of imported merchandise which shall copy or simulate the name or trademark of any domestic manufacture or manufacturer, or which shall bear a name or mark, which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom house of the United States. And in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer who has adopted trademarks may require his name and residence and a description of his trademarks to be recorded in a book which shall be kept for that purpose in the department of the treasury, under such regulations as the secretary of the treasury shall prescribe, and may furnish to the department fac-similes of such trademarks; and thereupon the secretary of the treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of the customs." (30 Stats. at Large, p. 207.)

In this connection the following circular has been issued by the treasury department:

[1897. Department Circular No. 116. Division of Customs.]

TREASURY DEPARTMENT, OFFICE OF THE SECRETARY,

Washington, D. C., August 3, 1897.

To Officers of the Customs and Others:

The attention of officers of the customs and others is invited to the following provision of section 11 of the act of July 24, 1897: [quoting above section.]

Applications for the recording of names or trademarks in this de-

partment will state the name and residence of the domestic manufacturer, and furnish a description of the mark and the names of the ports to which the fac-similes should be sent. No such name or trademark will be received unless accompanied by the proper proof of ownership and proof that the owner is a domestic manufacturer, which must consist of the affidavit of the owner or one of the owners, certified by a notary public, or other officer entitled to administer oaths, and having a seal.

On the receipt by a customs officer of any such fac-similes, with information from the department that they have been recorded therein, he will properly record and file them, and will exercise care to prevent the entry at the custom-house of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trademarks in the department and custom-houses.

A sufficient number of fac-similes should be forwarded to enable the department to send one copy to each port named in the application with ten additional copies for the files of the department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States," and collectors and other officers of the customs are instructed to use due diligence to prevent violations of this provision.

W. B. HOWELL,
Assistant Secretary.

No fees are charged for recording trademarks under this section. Applicants must state the name and residence of the domestic manufacturer and specify the ports to which fac-similes are to be sent. Synopsis Treasury Decisions, 1895, p. 926; *Id.*, 1896, p. 70. The treasury department cannot determine the validity of a trademark. Its powers are limited to the exclusion of articles which copy or simulate trademarks filed for record with the department. Synopsis Treasury Decisions. 1895, p. 929.

Compare sec. 6, Tariff Act of Aug. 27, 1894; and sec. 7 of the Act of Oct. 1, 1890.

APPENDIX G.

ACT OF FEBRUARY 20, 1905.

An act to authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:

That the owner of a trademark used in commerce with foreign nations, or among the several states, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trademark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trademark is appropriated; a description of the trademark itself, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trademark has been used. With this statement shall be filed a drawing of the trademark, signed by the applicant, or his attorney, and such number of specimens of the trademark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the require-

ments of this act and such regulations as may be prescribed by the Commissioner of Patents.

The enactment of a law whose provisions should extend to the owners of trademarks used in interstate commerce was inspired by the omission of such a provision in the Act of 1881. Concerning that act, Mr. Chief Justice Fuller has said: that, "Obviously the act was passed in view of the decision that the prior act was unconstitutional, and it is, therefore, strictly limited to lawful commerce with foreign nations and with Indian tribes. It is only the trademark used in such commerce that is admitted to registration, and it can only be infringed when used in that commerce, without right, by another than its owner."¹

Section 1 of the Act of 1881 was substantially identical with the above section in other respects, except that the above section requires specimens of the trademark as actually used to be filed, and reduces the government fee from twenty-five dollars to ten dollars.

SEC. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application, to be the owner of the trademark sought to be registered, and that no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to such use, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trademark is used in commerce among the several states, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trademark sought to

1—Warner v. Searle and Hereth Co., 191 U. S. 195, 204.

be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trademark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the states thereof. The verification required by this section may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent holding commission under the government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular of the United States.

This section embraces the matter included in Section 2 of the Act of 1881, with additional provisions concerning the requirements of the statements to be made by a resident of a foreign country.

SEC. 3. That every applicant for registration of a trademark, or for renewal of registration of a trademark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trademark of which such applicant may claim to be the owner, brought under the provisions of this act. or under other laws of the United States, may be served.

with the same force and effect as if served upon the applicant or registrant in person. For the purposes of this act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

This section is new and made desirable by the provisions of Section 2 providing for the registration of marks by persons domiciled in foreign countries. In the manner indicated, effective service can be had in case suit is instituted involving the mark registered.

SEC. 4. That an application for registration of a trademark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States, an application for registration of the same trademark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trademark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

This section is new in the present act, and is intended for the protection of applicants who have previously filed an application for registration in a foreign country wherein reciprocal privileges are extended to citizens of the United States. Its provisions are in furtherance of Article 4 of the International Convention, which see.

SEC. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter;

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any state or municipality, or of any foreign nation: *Provided*, That trademarks which are identical with a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: *Provided further*, That no portrait of a living individual may be registered as a trademark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states, or with Indian tribes, which was in actual and exclusive use as a trademark of the applicant or his pre-

decessors from whom he derived title for ten years next preceding the passage of this act.

This section embraces some of the provisions of Section 3 of the Act of 1881. The meaning and effect of the last proviso are yet to be determined. Read according to its terms, it admits to registration any mark in use by the applicant or its predecessors for ten years next preceding the passage of the act, regardless of whether such mark comprises immoral or scandalous matter, the flag or coat of arms of the United States, or the portrait of a living individual; without regard as to whether or not such old mark is identical with or in near resemblance to the registered or known trademark of another, and even where the mark consists merely in the name of an individual, etc., without any particular or descriptive type or association.

What benefit could possibly accrue from admitting a mark to registration which is not a trademark at common law, it is left to the courts to decide.

SEC. 6. That on the filing of an application for registration of a trademark which complies with the requirements of this act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trademark registered under the provisions of this act, the commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in Section 2 of this act. If no notice of opposition is filed within said time the commissioner shall

issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the commissioner shall notify the applicant, giving him his reasons therefor.

The provisions of this section for publication and opposition are among the most valuable features of the present act. Owners of trademarks not desiring to register are thus enabled, by proper and vigilant action, to prevent registration of an identical or similar mark by another.

SEC. 7. That in all cases where notice of opposition has been filed the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trademark which is substantially identical with a trademark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trademark, or a known trademark owned and used by another, as, in the opinion of the commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trademark, and in every case of interference or opposition to registration he shall direct the examiner in charge of interferences to determine the question of the right of registration to such trademark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the commissioner may by rules prescribe.

The commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trademark, for the person first to adopt and use the mark, if otherwise entitled to register the same unless an appeal is taken, as herein-

after provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the commissioner may prescribe.

As to oppositions, this section is supplemental to Section 6. This section further provides for the creation of interfering proceedings, which have formed a large part of the proceedings in the Patent Office under the Trademark Act of 1881 and the patent statutes. It further provides for an appeal from the decision of the commissioner in cases of opposition and interference.

SEC. 8. That every applicant for the registration of a trademark, or for the renewal of the registration of a trademark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trademark, may appeal from the decision of the examiner in charge of trademarks, or the examiner in charge of interferences, as the case may be, to the commissioner in person, having once paid the fee for such appeal.

This section relates to the right of appeal to the commissioner from the examiner of the trademark division of the Patent Office, or the examiner in charge of interferences. It is modeled on § 4909, R. S. U. S., relating to appeals in applications for letters patent.

SEC. 9. That if an applicant for registration of a trademark, or a party to an interference as to a trademark, or a party who has filed opposition to the registration of a trademark, or party to an application for the cancellation of the registration of a trademark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules

of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

This section, for the first time, creates the right of appeal to the Court of Appeals of the District of Columbia from the decision of the commissioner in trademark applications, interferences and oppositions.

SEC. 10. That every registered trademark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or state in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The commissioner shall keep a record of such assignments.

The first sentence of this section is merely a declaration of the law concerning the assignability of trademarks as it has been settled by the courts. The remainder of the section relates to the formalities attending upon the execution and recording of the assignment of registered marks.

SEC. 11. That certificates of registration of trademarks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was received in the Patent Office. Certificates of registration of trademarks may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Written or printed copies of any records, books, papers, or drawings relating to trademarks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

This section provides for the formalities attendant upon the issuance of certificates of registration, and to the issue of certified copies of the data relating to trademarks belonging to the Patent Office, and of certificates of registration.

SEC. 12. That a certificate of registration shall remain in force for twenty years, except that in the case of trademarks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trademark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this act, upon request of the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same period as certificates issued under the provisions of this act, and when so renewed shall have the same force and effect as certificates issued under this act.

Under Section 5 of the Act of 1881, a certificate of registration remains in force for thirty years from its date. That period is curtailed by the above section to twenty years.

SEC. 13. That whenever any person shall deem himself injured by the registration of a trademark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the commissioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of the examiner of interferences.

This is a provision for the cancellation of a registration wrongfully secured.

SEC. 14. That the following shall be the rates for trademark fees:

On filing each original application for registration of a trademark, ten dollars: *Provided*, That an application for registration of a trademark pending at the date of the passage of this act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this act without the payment of further fee.

On filing each application for renewal of the registration of a trademark, ten dollars.

On filing notice of opposition to the registration of a trademark, ten dollars.

On an appeal from the examiner in charge of trademarks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-

mark or canceling the registration of a trademark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

The foregoing provisions as to fees do not provide for the fee to be paid upon an application to cancel registration, although a fee is fixed for the appeal from the decision of the examiner of interferences in such cases.

SEC. 15. That sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trademark fees.

The sections of the Revised Statutes of the United States, referred to in the above section are as follows:

SECTION 4935.

“Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever.”

SECTION 4936.

“The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depositary, to the credit of the treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents.”

SEC. 16. That the registration of a trademark under the provisions of this act shall be *prima facie* evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trademark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several states, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

This section substantially embodies the provisions of Section 7 of the Act of 1881, besides providing for increasing the actual damages found, to a sum not exceeding three times the amount of the verdict.

The first sentence of this section cannot receive from the court a more liberal interpretation than was given to the same sentence in the Act of 1881; and as to that provision in the former act, it was expressly held that registration could not serve as the foundation for preliminary injunction.¹

Obviously, a certificate of registration may be introduced in evidence as *prima facie* proof of ownership. This would follow if the provision were not expressed in the act, as otherwise any registration act would be idle.

1—A. Leschen Sons Rope Co. v. Broderick & Bascom Rope Company, 123 Fed. Rep., 149, 152.

SEC. 17. That the circuit and territorial courts of the United States and the Supreme Court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this act, arising under the present act, without regard to the amount in controversy.

This section designates the courts having original and appellate jurisdiction in cases involving registered trademarks. As to the appellate jurisdiction in trademark cases generally, see *ante*. § 116, title "Appeals."

SEC. 18. That writs of *certiorari* may be granted by the Supreme Court of the United States for the review of cases arising under this act in the same manner as provided for patent cases by the act creating the circuit court of appeals.

This section is substantially identical with the corresponding section of the Judiciary Act of 1891, § 6. As to the issuance of the writ of *certiorari* by the supreme court, see *ante*, § 116, title "*Certiorari*."

SEC. 19. That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trademark registered under this act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trademark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to

increase such damages, in its discretion, as is given by section sixteen of this act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

This section is substantially identical in its provisions with § 4921, R. S. U. S., relating to patent cases, with the addition of providing for the manner of assessing profits. See *ante*, § 116, title "Increase of Damages in Equity."

SEC. 20. That in any case involving the right to a trademark registered in accordance with the provisions of this act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trademark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trademark registered in accordance with the provisions of this act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court or judge thereof, in the United States, or by the Supreme Court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or

judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

This section is modeled upon § 4966, R. S. U. S., relating to copyrights.

SEC. 21. That no action or suit shall be maintained under the provisions of this act in any case when the trademark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

Except as to the provision concerning abandoned trademarks, this section is substantially identical with § 8 of the Act of 1881.

SEC. 22. That whenever there are interfering registered trademarks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trademark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

This section is new and extends the jurisdiction of courts of original jurisdiction to include the power to decree the cancellation of a certificate of registration, the decree to be carried into effect by the Commissioner of Patents.

SEC. 23. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed.

This section is identical with § 10 of the Act of 1881. See notes to that section, *ante*.

SEC. 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this act.

As the Act of 1881 was still in effect at the time when the present act went into operation, this provision was intended to give pending applications the benefit of the new act, if amended so as to be brought within its terms.

SEC. 25. That any person who shall procure registration of a trademark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

This section is reproduced from § 9 of the Act of 1881.

SEC. 26. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trademarks provided for by this act.

Pursuant to this section, the Commissioner of Patents has made and published the rules and forms which are hereinafter set forth.

SEC. 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this act, or shall bear a name or

mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of his name, the name of the locality in which his goods are manufactured, or of his registered trademark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

This section is substantially identical with the provisions of § 11 of the Act of July 24, 1897, entitled, "An Act to Provide Revenue for the Government and to Encourage the Industries of the United States," the provisions of that act being extended in order to give manufacturers domiciled abroad the same protection as is given to manufacturers located within the United States.

SEC. 28. That it shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U.

S. Pat. Off.," or when, from the character or size of the trademark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

This section is modeled upon the corresponding section of the Patent Statutes, § 4900, R. S. U. S. See *ante*, § 97, title, "The Disadvantages of Registration."

SEC. 29. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trademark" includes any mark which is entitled to registration under the terms of this Act and whether registered or not, and a trademark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by,

or with which the goods are packed or inclosed or otherwise prepared for sale or distribution.

This section is new with the present Act. It is a collection of definitions made for the purpose of preventing repetition in the preceding sections, as well as to specifically bring the owners of marks located in Porto Rico, the Philippines, and any other territory under the jurisdiction and control of the United States within the benefits of the Act. Each of such territories is defined to be a state within the meaning of the Act, as are also the Territories of the United States, and the District of Columbia.

SEC. 30. That this Act shall be in force and take effect April first, nineteen hundred and five. All Acts and parts of Acts inconsistent with this Act are hereby repealed except so far as the same may apply to certificates of registration issued under the Act of Congress approved March third, eighteen hundred and eighty-one, entitled "An Act to authorize the registration of trademarks and protect the same," or under the Act approved August fifth, eighteen hundred and eighty-two, entitled "An Act relating to the registration of trademarks."

Approved, February 20, 1905.

RULES GOVERNING THE REGISTRATION OF
TRADEMARKS UNDER THE ACT APPROVED
FEBRUARY 20, 1905, TO TAKE EFFECT
APRIL 1, 1905.

UNITED STATES PATENT OFFICE,
Washington, D. C., April 1, 1905.

The following rules, designed to be in strict accordance with the provisions of the act approved February 20, 1905, for the registration of trademarks, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on page 509, et seq.

FREDERICK I. ALLEN,
Commissioner of Patents.

CORRESPONDENCE.

1. All business with the Office should be transacted in writing. Unless by the consent of all parties, the action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the Office with decorum and courtesy. Papers presented in violation of this requirement will be returned; but all such papers will first be submitted to the Commissioner, and only be returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by money order, check, or draft should be to his order.

4. A separate letter should, in every case, be written in relation to each distinct subject of inquiry or appli-

eration. Complaints against the examiner in charge of trademarks, assignments for record, fees, and orders for copies or abstracts must be sent to the Office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant, the serial number of the application, and the date of filing. Letters relating to registered trademarks should refer to the name of the registrant, the number and date of the certificate, and the merchandise to which the trademark is applied.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not generally be allowed.

9. The Office can not undertake to respond to inquiries propounded with a view to ascertain whether certain trademarks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The Office can not aid in the selection of any attorney.

A register of attorneys is kept in this Office, on which

will be entered the names of all persons entitled to represent applicants before the Patent Office. The names of persons in the following classes will, upon their written request, be entered on this register:

(a) Any person who, on June 18, 1897, was engaged as attorney or agent in the active prosecution of applications for patent before this Office, or had been so engaged at any time within five years prior thereto and is not disbarred, or is or was during such period a member of a firm so engaged and not disbarred, provided that such person shall, if required, furnish information as to one or more applications for patents so prosecuted by him.

(b) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(c) Any person who has been regularly recognized as an attorney or agent to represent claimants before the Department of the Interior, or any bureau thereof, and is in good standing, provided that such person shall furnish a statement of the date of his admission to practice as such attorney or agent, and shall further show, if required by the Commissioner, that he is possessed of the necessary qualifications to render applicants valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

(d) Any person not an attorney at law who shall file a certificate from a judge of a United States, State, or Territorial court, duly authenticated under the seal of the court, that such person is of good moral character and of good repute and possessed of the necessary qualifications to enable him to render applicants valuable service, and is otherwise competent to advise and

assist them in the presentation and prosecution of their applications before the Patent Office.

(e) Any firm which, on June 18, 1897, was engaged in the active prosecution, as attorneys or agents, of applications for patents before the Patent Office, or had been so engaged at any time within five years prior thereto, provided such firm or any member thereof is not disbarred, provided the names of the individuals composing the firm are stated, and provided also that such firm shall, if required, furnish information as to one or more applications prosecuted before the Patent Office by them.

(f) Any firm, not entitled to registration under the preceding sections, which shall show that the individuals composing the firm are each and all recognized as patent attorneys or agents, or are each and all entitled to be so recognized under the preceding sections of this rule.

The Commissioner may demand additional proof of qualifications, and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

Any person or firm, not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally, may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent any certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

No person, not registered, as above provided, will be permitted to prosecute, as attorney, applications before the Patent Office.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind his power of attorney must be filed. General powers given by a principal to an associate can not be consid-

ered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association may be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and, when so revoked, the Office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct, the Commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

WHO MAY REGISTER A TRADEMARK.

Act of Feb. 20, 1905, sec. 1.

16. A trademark may be registered by any person, firm, corporation, or association domiciled within the territory of the United States, or residing in or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, and who is entitled to the use of any trademark and uses the same in commerce with foreign nations, or among the several States, or with Indian tribes, upon payment of the fee required by law and other due proceedings had. (See rules 17 and 19.)

Act of Feb. 20, 1905, secs. 1, 2, and 4.

17. No trademark will be registered to an applicant residing or located in a foreign country unless such

country by treaty, convention, or law, affords similar privileges to the citizens of the United States, nor unless the trademark has been registered by the applicant in the foreign country in which he resides or is located. In such cases it is not necessary to state in the application that the trademark has been used in commerce with the United States or among the States thereof. (See Rule 31.)

WHAT MAY BE REGISTERED AS A TRADEMARK.

Act of Feb. 20, 1905, secs. 1, 5, and 21.

18. No trademark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several States, or between the United States and some foreign nation or Indian tribe; no trademark will be registered to an owner residing in or located in a foreign country unless said country by treaty, convention, or law affords similar privileges to the citizens of the United States; no trademark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or which is identical with a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely

in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term; no portrait of a living individual will be registered as a trademark, except by the consent of such individual, evidenced by an instrument in writing; and no trademark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

Act of Feb. 20, 1905, sec. 5.

19. Any mark used in commerce with foreign nations or among the several States or with Indian tribes may be registered if it has been in actual and exclusive use as a trademark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of the act of February 20, 1905. (See Rule 30.)

THE APPLICATION.

Act of Feb. 20, 1905, sec. 1.

20. An application for the registration of a trademark must be made to the Commissioner of Patents and must be signed by the applicant.

Act of Feb. 20, 1905, sec. 1.

21. A complete application comprises:

(a) A petition, requesting registration, signed by the applicant. (See Form 1, p. 509.)

(b) A statement specifying the name, domicile, location, and citizenship of the party applying; the class of merchandise, and the particular description of goods comprised in such class, to which the trademark is appropriated; a description of the trademark itself, and a statement of the mode in which the same is applied and affixed to the goods, and of the length of time dur-

ing which the trademark has been used, and, if the applicant be a corporation or association, it must be set forth under the laws of what State or nation organized. (See sec. 29 of the statute, and Forms 2, 4, and 6, pp. 509 et seq.)

(c) A declaration, complying with section 2 of the statute. (See Forms 3, 5, 7, 8, and 9, pp. 509 et seq.)

(d) A drawing of the trademark, which shall be a facsimile of the same as actually used upon the goods. (See Rules 34 and 35 and Form page 513.)

(e) Five specimens (*or facsimiles, when, from the mode of applying or affixing the trademark to the goods, specimens can not be furnished*) of the trademark as actually used upon the goods.

(f) A fee of ten dollars.

22. The petition, the statement, and the declaration must be in the English language and written on one side of the paper only.

23. The name of the applicant will appear in the certificate of registration precisely as it is signed to the statement of the application, and, therefore, the signature to the statement must be the correct signature of the applicant, and the name of the applicant wherever it appears in the papers of the application must agree with the name as signed to the statement.

24. No information will be given without authority of the applicant respecting the filing of an application for the registration of a trademark by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the Office.

Act of Feb. 20, 1905, secs. 14 and 24.

25. All applications for registration pending in the Patent Office at the time of the passage of the act of February 20, 1905, may be amended with a view to bringing them and the certificates issued under such

applications under the provisions of said act, and the prosecution of such applications may be proceeded with under its provisions without the payment of further fee. When such an application is amended to bring it under the act of February 20, 1905, it will be given a serial number and date of filing under said act.

A trademark registered under the act of March 3, 1881, may be registered under the act of February 20, 1905, but the application for such registration will be subject to examination in the same manner as other applications filed under said act of February 20, 1905.

Act of Feb. 20, 1905, sec. 4.

26. An application for registration of a trademark, filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law affords similar privileges to the citizens of the United States an application for registration of the same trademark, shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trademark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country.

Act of Feb. 20, 1905, sec. 3.

27. Every applicant for registration of a trademark, or for renewal of registration of a trademark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trademark of which such applicant may claim to be the owner may be served. This notice shall be indorsed upon the file wrapper of the application.

Act of Feb. 20, 1905, sec. 3.

28. In proceedings relating to an application or a registration under the act of February 20, 1905, it shall be deemed sufficient to serve notice upon the applicant, registrant, or representative by leaving a copy of the process or notice of proceedings addressed to him at the last address of which the Commissioner of Patents has been notified.

DECLARATION.

Act of Feb. 20, 1905, sec. 2.

29. The application must be accompanied by a written declaration verified by the applicant, or by a member of the firm, or by an officer of the corporation or association applying, to the effect that he believes himself, or the firm, corporation, or association in whose behalf he makes the declaration, to be the owner of the trademark sought to be registered, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use the trademark, either in the identical form or any such near resemblance thereto as might be calculated to deceive; that such trademark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description, drawing, and specimens (*or facsimiles*) truly represent the trademark sought to be registered. (See Rule 17 and Forms 3, 5, 7, 8, and 9, p. 509 et seq.)

30. Where application is made under section 5 of the act of February 20, 1905, on the ground that the mark has been in actual and exclusive use as a trademark by the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of said act, the applicant shall, in addition to the requirements of section 2 of said act, make oath to such actual use of the mark as a trademark by himself, or his predecessors, or by those from whom title to the same is derived, for the period specified, and that, to the best of

his knowledge and belief, such use has been exclusive. (See Form 8, page 511.)

Act of Feb. 20, 1905, sec. 2.

31. If the applicant resides or is located in a foreign country, the declaration required shall also set forth that the trademark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration or of the application therefor, as the case may be. In such cases, it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. (See Form 9, page 512.)

Act of Feb. 20, 1905, sec. 2.

32. The declaration may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by the certificate of a diplomatic or consular officer of the United States, the declaration being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the same is made.

33. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed.

DRAWING.

34. (1) The drawing must be made upon pure white paper of a thickness corresponding to two-sheet Bristol

board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges, a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than $1\frac{1}{4}$ inches is to be left blank for the heading of title, name, number, and date. (See specimen of drawing page 513.)

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

Act of Feb. 20, 1905, sec. 1.

(4) The name of the proprietor of the trademark, signed by himself or his attorney of record, must be placed at the lower right-hand corner of the sheet within the marginal lines, but in no instance should it encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side, and the heading should be placed at the right and the signature at the left, occupying the same space and position as in an upright view, and being horizontal when the sheet is held in an upright position.

(6) Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board. They should not be rolled or folded.

(7) An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

35. The Office, at the request of applicants, will furnish the drawings at cost.

EXAMINATION OF APPLICATIONS.

Act of Feb. 20, 1905, sec. 6.

36. All complete applications for registration are considered, in the first instance, by the examiner in charge of trademarks. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such refusal will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

37. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

Act of Feb. 20, 1905, sec. 6.

38. If, on examination of an application for the registration of a trademark, it shall appear that the applicant is entitled to have his trademark registered under the provisions of the law, the mark will be published in the Official Gazette at least once. Such publication shall be at least thirty days prior to the date of registration.

If no notice of opposition be filed within thirty days after such publication, the applicant or his attorney will be duly notified of the allowance of his application, and a certificate of registration will be issued as provided in Rule 52.

The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the third Tuesday thereafter.

AMENDMENTS.

39. The statement may be amended to correct informalities, or to avoid objections made by the Office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trademark will be permitted unless warranted by something in the specimens (*or facsimiles*) as originally filed.

40. In every amendment, the exact word or words to be stricken out or inserted in the statement must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant or attorney.

41. When an amendatory clause is amended, it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire statement to be rewritten.

42. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the Commissioner.

Amendments may be made after the allowance of an application, if the case has not been printed, on the recommendation of the examiner, approved by the Commissioner, without withdrawing the case from issue.

43. After the completion of the application, the Office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the Office will furnish them on the usual terms.

INTERFERENCE, OPPOSITION, AND CANCELLATION.

Act of Feb. 20, 1905, sec. 7.

44. In case of conflicting applications for registration of a trademark, or in any dispute as to the right to use the same, which may arise between an applicant and a registrant, the Office will declare an interference, in order that the parties may have an opportunity to prove priority of use, and the proceedings on such interference will follow, as nearly as practicable, the practice in interferences between applications for patents.

Act of Feb. 20, 1905, secs. 6 and 14.

45. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing, in duplicate, a written notice of opposition (see Form 10, page 514), stating the grounds therefor, within thirty days after the publication (see Rule 38) of the mark sought to be registered, which notice of opposition shall be accompanied by the fee required by law, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 32.)

Act of Feb. 20, 1905, sec. 13.

46. Any person deeming himself to be injured by the registration of a trademark in the Patent Office, may at any time make application (see Form 11, page 514) to the Commissioner to cancel the registration thereof. Such application shall be filed in duplicate, shall state the grounds for cancellation, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. (See Rule 32.)

Act of Feb. 20, 1905, sec. 13.

47. If it appear, after a hearing before the examiner of interferences, that the registrant was not entitled to

the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner in charge of interferences shall so decide, the Commissioner shall cancel the registration of the mark, unless appeal be taken within the limit fixed.

48. In cases of opposition and of applications for cancellation, the examiner in charge of trademarks shall forward the files and papers to the examiner in charge of interferences, who shall give notice thereof to the applicant or registrant. The applicant or registrant must make answer at such time, not less than thirty days from the date of the notice, as shall be fixed by the examiner in charge of interferences.

49. The proceedings on oppositions and on applications for cancellation shall follow, as nearly as practicable, the practice in interferences between applications for patents.

APPEALS.

Act of Feb. 20, 1905, secs. 8 and 14.

50. From an adverse decision of the examiner in charge of trademarks upon an applicant's right to register a trademark, or to renew the registration of a trademark, or from a decision of the examiner in charge of interferences, an appeal may be taken to the Commissioner in person, upon payment of the fee required by law.

Act of Feb. 20, 1905, sec. 9.

51. From the adverse decision of the Commissioner of Patents upon the right of an applicant to register a trademark, or to renew the registration of a trademark, or from the decision of the Commissioner in cases of interference, opposition, or cancellation, an appeal may be taken to the court of appeals of the District of Columbia in the manner prescribed by the rules of that court.

ISSUE, DATE, AND DURATION OF CERTIFICATES.

Act of Feb. 20, 1905, sec. 11.

52. When the requirements of the law and the rules have been complied with, and the Office has adjudged a trademark registrable, a certificate will be issued, signed by the Commissioner, under the seal of the Patent Office, to the effect that the applicant has complied with the law and that he is entitled to registration of his trademark. The certificate shall state the date on which the application for registration was received in the Patent Office. Attached to the certificate will be a photolithographed copy of the drawing of the trademark and a printed copy of the statement and the declaration.

Act of Feb. 20, 1905, sec. 12.

53. A certificate of registration shall remain in force twenty years from its date, except that, in case a trademark be previously registered in a foreign country, such certificate shall cease to be in force on the day on which the trademark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed.

Act of Feb. 20, 1905, secs. 12 and 14.

54. A certificate of registration may be, from time to time, renewed for like periods on payment of the renewal fees required, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificate of registration was issued or renewed.

Act of Feb. 20, 1905, sec. 12.

55. Certificates of registration in force on the 1st day of April, 1905, shall remain in force for the period for which they were issued, and shall be renewable on

the same conditions and for the same periods as certificates issued under the provisions of the act of February 20, 1905, and, when so renewed, shall have the same force and effect as certificates issued thereunder.

Act of Feb. 20, 1905, sec. 4.

56. A certificate of registration shall not be issued to an applicant located in a foreign country for any trademark for registration of which he has filed an application in such foreign country, until such mark has been actually registered by him in the country in which he is located.

ASSIGNMENTS.

Act of Feb. 20, 1905, sec. 10.

57. Every registered trademark and every mark for the registration of which application has been made, together with the application for registration thereof, shall be assignable in connection with the good-will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed. Provision is made for recording such assignments in the Patent Office; but no such assignment will be recorded unless it is in the English language, nor unless an application for the registration of the mark shall have been first filed in the Patent Office, and such assignment must identify the application by serial number and date of filing, or, when the mark has been registered, by the certificate number and date thereof. No particular form of assignment is prescribed.

Act of Feb. 20, 1905, sec. 10.

58. An assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it be recorded in the Patent Office within three months from the date thereof.

59. The certificate of registration may be issued to

the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

COPIES AND PUBLICATIONS.

Act of Feb. 20, 1905, secs. 11 and 14.

60. After a trademark has been registered, printed copies of the statement and declaration in each case, with a photolithographed copy of the drawing of the trademark, may be furnished by the Office upon the payment of the fee. (See Rule 63.)

61. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the applicant; otherwise an extra charge will be made for the time consumed in making a search for such assignment.

62. The Official Gazette of the Patent Office will contain a list of all trademarks registered, with the name and address of the registrant in each case, a description of the trademark itself, and a recitation of the particular description of goods to which it is applied.

FEEES.

Rev. Stat., 4893; act of Feb. 20, 1905, sec. 14.

63. On filing each original application for the registration of a trademark.....	\$10.00
On filing each application for renewal of the registration of a trademark.....	10.00
On filing notice of opposition to the registration of a trademark	10.00
On appeal from the examiner in charge of trademarks to the Commissioner of Patents.....	15.00
On appeal from the decision of the examiner in charge of interferences, awarding ownership of a trademark or canceling the registration of a trademark, to the Commissioner of Patents.	15.00
For manuscript copies, for every 100 words or fraction thereof10
For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less.....	1.00
For recording every assignment, agreement, power of attorney, or other paper of more than 300 words and less than 1,000 words	2.00

For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words.....	3.00
For abstracts of title:	
For the certificate of search.....	1.00
For each brief from the digest of assignments.....	.20
For searching titles or records, one hour or less.....	.50
Each additional hour or fraction thereof.....	.50
For a single printed copy of statement, declaration, and drawing05
If certified, for the grant, additional.....	.50
For the certificate25

Rev. Stat., 4935.

64. Money required for Office fees may be paid to the Commissioner of Patents, or to the Treasurer, or to any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, and such officer shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this can not be done without inconvenience, the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders, drafts, and checks should be made payable to the "Commissioner of Patents."

65. All money sent by mail, to the Patent Office, will be at the risk of the sender. All payments to the Office must be made in specie, Treasury notes, national-bank notes, certificates of deposit, money orders, or certified checks.

REPAYMENT OF MONEY.

Rev. Stat., 4936; act of Feb. 20, 1905, sec. 15.

66. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the Office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trademark, or

to withdraw an appeal, will not entitle a party to demand such a return.

NOTICE OF REGISTRATION.

Act of Feb. 20, 1905, sec. 28.

67. It shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or "Reg. U. S. Pat. Off.," or, when from the character and size of the trademark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; otherwise, on a suit for infringement, no damages shall be recovered except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

AMENDMENTS OF THE RULES.

68. All amendments of the foregoing rules will be published in the Official Gazette.

QUESTIONS NOT SPECIFICALLY PROVIDED FOR.

69. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

FREDERICK I. ALLEN,
Commissioner of Patents.

DEPARTMENT OF THE INTERIOR.

Approved, to take effect April 1, 1905.

E. A. HITCHCOCK,
Secretary.

FORMS FOR PATENT OFFICE PRACTICE.

The following forms illustrate the manner of preparing papers for applications for registration of trademarks. Applicants will find their business facilitated by following them closely:

(1) PETITION.

To the Commissioner of Patents:

The undersigned presents herewith a drawing and five specimens (or *fac-similes*) of his trademark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

(Signature) _____.

Dated _____, 19—.

(2) STATEMENT FOR AN INDIVIDUAL.

To all whom it may concern:

Be it known that I, _____, a citizen (or *subject, as the case may be*) of the _____, residing at _____, and doing business at No. _____ street, in said city, have adopted for my use a trademark of which the following is a description:

My trademark consists of _____.

The trademark has been continuously used in my business since _____.

The class of merchandise to which the trademark is appropriated is _____, and the particular description of goods comprised in said class upon which I use said trademark is _____.

The trademark is displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [or *state other modes of application to the goods*].

(Signature) _____.

(3) DECLARATION FOR AN INDIVIDUAL.

STATE OF _____, COUNTY OF _____, ss:

_____, being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by him in commerce among the several States of the United States and (or) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; and that the description, drawing, and specimens (or *fac-*

similes) presented truly represent the trademark sought to be registered.

(Signature) _____.

Subscribed and sworn to before me, a _____, this _____ day of _____, 19—.

[L. s.]

(Signature) _____.

[Official character.]

(4) STATEMENT FOR A FIRM.

To all whom it may concern:

Be it known that we, _____, a firm domiciled in _____, county of _____, State of _____, and doing business at No. _____ street, in said city, and composed of the following members, _____, _____, _____, citizens of (or subjects, as the case may be) _____, have adopted for our use a trademark, of which the following is a description:

Our trademark consists of _____.

The trademark has been continuously used in our business since _____.

The class of merchandise to which the trademark is appropriated is _____, and the particular description of goods comprised in said class upon which said trademark is used is _____.

The trademark is displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [or state other modes of application to the goods].

(Signature) _____.

By _____,

A member of the firm.

(5) DECLARATION FOR A FIRM.

STATE OF _____, COUNTY OF _____, ss:

_____, being duly sworn, deposes and says that he is a member of the firm, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said firm is the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by said firm in commerce among the several States of the United States and (or) between the United States and foreign nations or Indian tribes, and particularly with [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description, drawing, and specimens (or fac-similes) presented truly represent the trademark sought to be registered.

(Signature) _____.

Subscribed and sworn to before me, a _____, this _____ day of _____, 19—.

[L. s.]

(Signature) _____.

[Official character.]

(6) STATEMENT FOR A CORPORATION OR ASSOCIATION.

To all whom it may concern:

Be it known that ———, a corporation (or association) duly organized under the laws of the State of ——— (or country), and located in the city of ———, county of ———, in said State (or country), and doing business at No. ——— street, in said city of ———, has adopted for its use a trademark of which the following is a description:

The trademark consists of ———.

The trademark has been continuously used in our business since ———.

The class of merchandise to which the trademark is appropriated is ———, and the particular description of goods comprised in said class upon which said trademark is used is ———.

The trademark is displayed on the packages containing the goods, by placing thereon a printed label on which the same is shown [or state other modes of application to the goods].

(Signature) ———.

By ———,

Secretary (or other officer).

(7) DECLARATION FOR A CORPORATION OR ASSOCIATION.

STATE OF ———, COUNTY OF ———, ss:

—————, being duly sworn, deposes and says that he is the secretary (or other officer) of the corporation (or association), the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation (or association) is the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by said corporation (or association) in commerce among the several States of the United States, and (or) between the United States and foreign nations or Indian tribes, and particularly with [here name one or more foreign nations or Indian tribes, or both, as the case may be]; and that the description, drawing, and specimens (or facsimiles) presented truly represent the trademark sought to be registered.

(Signature) ———.

Subscribed and sworn to before me, a ———, this ——— day of ———, 19—.

[L. S.]

(Signature) ———.

(Official character.)

(8) DECLARATION FOR APPLICANTS UNDER THE TEN-YEAR PROVISIO.

STATE OF ———, COUNTY OF ———, ss:

—————, being duly sworn, deposes and says that he is the

applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said mark is used by him in commerce among the several States of the United States, and (or) between the United States and foreign nations or Indian tribes, and particularly with [*here name one or more foreign nations or Indian tribes, or both, as the case may be*]; that the description, drawing, and specimens (or facsimiles) presented truly represent the mark sought to be registered; and that the mark has been in actual use as a trademark of the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of the act of February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.¹

(Signature) _____.

Subscribed and sworn to before me, a _____, this _____ day of _____, 19—.

[L. S.]

(Signature) _____.

(Official character.)

(9) DECLARATION FOR FOREIGNERS.

STATE OF _____, COUNTY OF _____, ss:

_____, being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark has been registered in [*here name the foreign country in which applicant resides or is located, and the date and number of the registration*], (or) that an application for registration of said trademark was filed by him on the _____ day of _____, 19—, in [*here name the foreign country in which applicant resides or is located*]; that the description, drawing, and specimens (or facsimiles) presented truly represent the trademark sought to be registered.¹

(Signature) _____.

Subscribed and sworn to before me, a _____, this _____ day of _____, 19—.

[L. S.]

(Signature) _____,

(Official character.)

¹ In case the applicant is a firm, corporation, or association, the declaration should be modified accordingly.



Proprietor.

By

Attorney.

(10) NOTICE OF OPPOSITION.

To the Commissioner of Patents:

In the matter of an application for the registration of a trademark for —, No. —, filed —, —, by —, of —, I, —, residing at No. — street, in the city of —, State of —, hereby give notice of my intention to oppose the registration of said trademark which was published on page —, No. —, of the Official Gazette of —, 19—.

The grounds for opposition are as follows: —.

Dated this — day of —, 19—.

(Signature) —.

STATE OF —, COUNTY OF —, ss:

On this — day of —, 19—, before me, a —, in and for —, —, personally appeared —, the above-named party, who, being duly sworn, deposes and says that, to the best of his knowledge and belief, the facts above stated are true.

[L. s.]

(Signature) —,

(Official character.)

(11) FORM FOR APPLICATION FOR CANCELLATION OF TRADE-MARK.

To the Commissioner of Patents:

In the matter of trademark No. —, registered —, 19—, by —, of —, and published on page —, vol. —, No. —, of the Official Gazette for —, 19—, I, the undersigned, residing at No. — street, in the city of —, State of —, hereby apply for the cancellation of the registration of the above-noted trade-mark. The grounds for cancellation are as follows: —.

(Signature) —.

Dated this — day of —, 19—.

STATE OF —, COUNTY OF —, ss:

On this — day of —, 19—, before me, a —, in and for —, —, personally appeared —, the above-named party, who, being duly sworn, deposes and says that, to the best of his knowledge and belief, the facts above stated are true.

[L. s.]

(Signature) —,

(Official character.)

APPENDIX H.

TRADE-MARK STATUTES OF THE STATES AND TERRITORIES.

ALABAMA.

No registration law.

Article 8, c. 196, Code, 1896, an Act relating to the unauthorized use or defacement of the bottles, siphons, kegs, etc., of manufacturers, bottlers and venders of soda water and other beverages.

Act of March 1, 1901. An Act for the protection of labels of labor unions.

ALASKA.

Carter's Annotated Alaska Codes, Page 18.

§ 84. Knowingly Using or Counterfeiting Trade-marks, etc. That if any person shall wilfully and knowingly use or cause to be used any private brand, label, stamp, or trademark of another, either by counterfeiting the same or using any impression, or copy thereof made or prepared by the proprietor thereof, or shall wilfully and knowingly use or cause to be used any colorable imitation of such brand, label, stamp, or trademark, with intent to deceive any one, such person, upon conviction thereof, shall be punished by imprisonment in the county jail not less than one month nor more than six months, or by fine not less than twenty nor more than three hundred dollars.

ARIZONA.

ACT of 1899.

An act concerning the protection of trademarks and labels and providing a penalty for the imitation of the same.

Section 1. Whenever any corporation, association or union of workmen have adopted or shall hereafter adopt for its or their protection any label, trademark, or form of advertisement announcing that goods to which such label, trademark, or form of advertisement shall be attached, were manufactured by it or by a member or members of such union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark or form of advertisement; every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or by fine and imprisonment.

Sec. 2. Any person who shall use any counterfeit or imitation of any label, trademark or form of advertisement of any such corporation, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a term of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or by both.

Sec. 3. Every such association, union or corporation that has heretofore adopted or shall hereafter adopt a label, trademark or form of advertisement, as aforesaid, shall file the same in the office of the secretary of the territory, by leaving two copies, counterparts or fac-similes thereof with the secretary of the territory;

said secretary shall deliver to such corporation, association or union so filing the same, a duly attested certificate of the record of the same, for which he shall receive a fee of three dollars; such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said union, corporation or association, to adopt the same.

Sec. 4. Every person who shall use or display the genuine label, trademark or form of advertisement of any such association, corporation or union in any manner not authorized by such association, corporation or union, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 5. Any person or persons who shall in any way use the name or seal of any such association, corporation or union, or officer thereof, in and about the sale of goods, or otherwise not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars, nor more than two hundred dollars, or both.

Sec. 6. It shall be the duty of the secretary of the territory to see that all associations, unions, or corporations enjoying the benefits of labels, trademarks, or forms of advertisements herein described shall comply with the foregoing provisions in all respects.

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved March 6, 1899.

ARKANSAS.

Sandels & Hill's Digest, Statutes of Arkansas, Chapter CL.

SECTION 7347. Protection in use of, how secured.

SEC. 7348. Declaration under oath of party claiming.

SEC. 7349. Secretary of state not to record name unaccompanied by marks distinguishable from others.

SEC. 7350. Copies of trademark, etc., under seal of secretary of state, may be used as evidence.

SEC. 7351. Trademarks to remain in force twenty-five years; exception.

SEC. 7352. Penalty for violating trademark.

SEC. 7353. No action allowed to protect trademark used in unlawful business or obtained by fraud, etc.

SEC. 7354. Persons obtaining trademark by fraud liable for damages.

SEC. 7355. Construction of act.

Section 7347. Any person or firm in this state, or any of the United States or territories thereof, and any corporation created by the authority of this state, or the United States or any of the states or territories thereof, and any person, firm or corporation, resident, or located in any foreign country, which, by treaty or convention, affords similar privileges to citizens of the United States, and who may be entitled to the exclusive use of any lawful trademark or device, or who may intend to adopt and use any trademark or device for exclusive use in this state, may obtain protection for such lawful trademark or device by complying with the following requisites and requirements.

First—By making out and filing in the office of the Secretary of State of this state, to be there registered or recorded, a statement specifying the names of the parties and their residence and place of business who desire the protection of the trademark, the class of merchandise, and particular description of goods comprised in such class, by which or to which the trademark has been or is intended to be appropriated; a description of the trademark itself or device, or combination of words,

letters or figures or characters used or intended to be used as such, and the mode in which it has been or is intended to be applied and used, and the length of time, if any, during which the trademark has been in use.

Second—By making payment to the Secretary of State, for the use of the state, of a fee of not less than twenty-five nor more than one hundred dollars, to be determined by the Secretary according to a schedule of fees arranged with reference to the number of words, figures, characters, etc., contained in such statement, which schedule it is made the duty of the Secretary to make and keep posted up in his office.

Sec. 7348. The certificate prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration, verified by the person or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming the protection for the trademark has a right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance therto as might be calculated to deceive, and that the fac-similes presented for record are true copies of the trademark sought to be protected.

Sec. 7349. The Secretary shall not receive and record any proposed trademark which is not and can not become a lawful trademark, or which is merely the name of a person, firm or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trademark appropriated to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trademark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trademark rightfully in use on the first day of May, 1883.

Sec. 7350. The time of the receipt of any trademark at the office of the Secretary of State, for registration or record, shall be noted and recorded. Copies of the trademark, and of the date of receipt thereof, and of the statement filed therewith, under the seal of the secretary of state shall be furnished by the Secretary to any person who may apply therefor, and pay the fee therefor fixed by the Secretary, not exceeding the fee required for the original registration thereof, and such copies shall be evidence in any suit or proceeding in which such trademark shall be brought in controversy.

Sec. 7351. A trademark registered as above prescribed shall remain in force for twenty-five years from the date of such registration, except in case where such trademark is claimed for, and applied to, articles not manufactured in this state, and in which it receives protection under the laws of some other state, territory or foreign country for a shorter period, in which case it shall cease to have any force in this state, by virtue of this act, at the same time that it becomes of no effect elsewhere.

Sec. 7352. Such trademark, during the period it remains in force, shall entitle the person, firm or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath, as aforesaid, and no other party shall lawfully use the same trademark, or substantially the same or so nearly resembling it as to be calculated to deceive, on substantially the same description of goods, or obtain, use or employ any article or thing whatever upon which such trademark, or substantially the same, or one so nearly resembling it as to be calculated to deceive, has been printed, painted, stamped, woven, branded or in any manner put or placed, for the purpose of putting up, shipping, selling, or otherwise disposing of substantially the same description of goods as those to which the

same has been appropriated by the party rightfully entitled to the use of such trademark; and any person or member of any firm, or agent, or officer of any corporation, not entitled so to do, who shall knowingly use such trademark, or obtain, use or employ, as aforesaid, any such article or thing, or shall reproduce, counterfeit, copy or imitate any recorded trademark, and affix the same to, or, for the purpose of having the same used or disposed of, to affix to goods of substantially the same descriptive properties and qualities as those referred to in the registration, or who shall, with intent to defraud, deal in or sell, or keep, or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trademark registered in pursuance of this act, to which, or to the package in which the same are put up, is fraudulently affixed said trademark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine article, or goods referred to in said registration, shall be deemed guilty of a high misdemeanor, and upon conviction thereof, shall be punished by a fine not exceeding one thousand dollars, or imprisonment not exceeding one year, or both such fine and imprisonment, and such person, and also the firm of which he is a member, or the corporation of which he is an agent or officer, and which may have countenanced or connived at his act, shall moreover be liable to an action for damages for such wrongful act, at the suit of the owner of such trademark, and the party aggrieved shall also have his remedy according to the course of equity, to enjoin the wrongful use of his trademark, and to recover compensation therefor in any court of competent jurisdiction, and in any such action or suit such owner or aggrieved party shall be entitled to recover a reasonable amount for attorney's fees, to be paid by the party or parties held liable therein.

Sec. 7353. No action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trademark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trademark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

Sec. 7354. Any person who shall procure the registry of any trademark, or of himself as the owner of a trademark, by making false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the person injured thereby.

Sec. 7355. Nothing in this act shall prevent, lessen, impeach or avoid any remedy at law, or in equity, which any party aggrieved by any wrongful use of any trademark might have, if the provisions of this act had not been enacted, and nothing in this act contained shall be construed by any court as abridging, or in any manner affecting unfavorably, the claim of any person to any trademark after the expiration of the term for which such trademark was registered.

Act March 31, 1883.

An act approved April 20, 1895, is entitled "An act to provide for the registration of brands, trademarks, etc., of boxes, fountains, syphons, bottles or other receptacles of carbonated goods, and prescribing penalties for violation of said act."

A synopsis of its contents is as follows:

SECTION 1. Manufacturers or dealers in carbonated goods may file in office of county clerk a fac-simile of mark, brand, etc., used on goods. Fee of \$1.00 for such recording. Description, fac-simile, etc., to be published for three weeks, and gives protection as a trademark.

SEC. 2. Unlawful to fill any bottle, etc., marked with registered brand, or to obliterate such mark.

SEC. 3. To sell such bottles, except by contract or permission of manufacturer, a misdemeanor. Employee equally liable with principal so offending.

SEC. 4. Penalty. Fines for each offense.

SEC. 5. Prosecutions may be made upon information by owner or manufacturer or agent. Information. How given. What to state. Justice to issue search warrant. If goods are found, officer to arrest parties.

SEC. 6. Purchaser of contents to return bottles, vessels, etc. If return is demanded by manufacturer or owner before vessels are empty, owner to refund price of contents paid.

SEC. 7. Fines under this act to be turned into county treasury.

SEC. 8. Repeals laws in conflict. Act takes effect from passage.

CALIFORNIA.

POLITICAL CODE.

Section 3196. The phrase "trademark" as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description, and also any name or names, marks or devices, branded, stamped, engraved, etched, blown, or otherwise attached or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package used, by any mechanic manufacturer, druggist, merchant or tradesman, to hold, contain

or inclose the goods so imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description. [Amendment approved March 3, 1903.]

Sec. 3197. Any person may record any trademark or name by filing with the Secretary of State his claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member) is the exclusive owner, or agent of the owner, of such trademark or name. [Amendment approved March 12, 1885.]

66 Cal. 78; 102 Cal. 44.

Sec. 3198. The Secretary of State must keep for public examination a record of all trademarks, or names filed in the office, with the date when filed and name of claimant; and must, at time of filing, collect from such claimant a fee of three dollars in gold coin, to be paid into the State Library Fund. [Stats. 1863, p. 155.]

NOTE.—Fee for filing and issuing certificate is \$5.00. See amendment to fee bill, Political Code, § 416, subdivision 15 (Statutes of 1903, page 27).

Sec. 3199. Any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property and is entitled to the same protection by suits at law, and any court of competent jurisdiction may restrain, by injunction, any use of trademarks, or names, in violation of this chapter.

Sec. 3200. Any trade union, labor association, or labor organization, organized and existing in this state, whether incorporated or not, may adopt and use a trademark and affix the same to any goods made, produced

or manufactured by the members of such trade union, labor association, or labor organization, or to the box, cask, case, or package containing such goods, and may record such trademark by filing or causing to be filed with the secretary of state its claim to the same, and a copy or description of such trademark, with the affidavit of the president of such trade union, labor association, or labor organization, certified to by any officer authorized to take acknowledgements of conveyances, setting forth that the trade union, labor association, or labor organization, of which he is the president, is the exclusive owner, or agent of the owner, of such trademark; and all the provisions of Article III., Chapter VII., Title VII., Part III., of the Political Code, are hereby made applicable to such trademark.

Sec. 3201. The president or other presiding officer of any trade union, labor association, or labor organization, organized and existing in this state, which shall have complied with the provisions of the preceding section, is hereby authorized and empowered to commence and prosecute in his own name any action or proceedings he may deem necessary for the protection of any trademark adopted or in use under the provisions of the preceding section, or for the protection or enforcement of any rights or powers which may accrue to such trade union, labor association, or labor organization by the use or adoption of said trademark.

CIVIL CODE.

Section 655. There may be ownership of all inanimate things which are capable of appropriation or of manual delivery; of all domestic animals; or all obligations; of such products of labor or skill as the composition of an author, the good-will of a business, trademarks and signs, and of rights created or granted by statute.

Sec. 991. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trademark, any form, symbol or name, which has not been so appropriated by another, to designate the origin or ownership thereof, but he cannot exclusively appropriate any designation, or part of a designation, which relates only to the name, quality or the description of the thing or business, or the place where the thing is produced or the business is carried on.

Sec. 1772. One who sells or agrees to sell any article to which there is affixed or attached a trademark there-by warrants that mark to be genuine and lawfully used.

PENAL CODE.

Sec. 350. Every person who wilfully reproduces, copies, imitates, forges, or counterfeits, or procures to be reproduced, copied, imitated, forged, or counterfeited, any trademark usually affixed by any person to his goods, which has been duly recorded in the office of the Secretary of State, or with the Commissioner of Patents in the United States Patent Office, or any label or brand, composed in whole or in part of a reproduction of said trademark, or who affixes the same to goods of essentially the same descriptive properties and qualities as those referred to in the registration of such trademark, with intent to pass off, or to assist other persons to pass off, any goods to which such reproduced, copied, imitated, forged, or counterfeited trademark, or label, or brand is affixed, or intended to be affixed, as the goods of the person, firm, company, or corporation owning the said trademark, is guilty of a misdemeanor. [Approved March 27, 1897.]

Sec. 351. Every person who sells, or keeps for sale, or manufactures or prepares, for the purpose of sale, any goods upon, or to which any reproduced, copied,

imitated, forged, or counterfeited trademark, or label, or brand, composed in whole or in part of such a reproduced, copied, imitated, forged, or counterfeited trademark has been affixed, after such trademark has been recorded in the office of the Secretary of State, or with the commissioner of patents in the United States Patent Office, intending to represent such goods as the genuine goods of the person, firm, company, or corporation owning the said trademark, knowing the same to be reproduced, copied, imitated, forged, or counterfeited, is guilty of a misdemeanor. [Approved March 27, 1897.]

Sec. 352. The phrases "forged trademarks" and "counterfeited trademarks," or their equivalents, as used in this chapter, include every alteration or imitation of any trademark so resembling the original as to be likely to deceive.

Sec. 353. The phrase "trademark," as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Sec. 354. Every person who has in his possession, or who uses any cask, bottle, vessel, case, cover, label, brand, or other thing bearing, or having in any way connected with it, the trademark of another, which has been duly recorded in the office of the Secretary of State, or with the commissioner of patents in the United States Patent Office, or the trade name of another, for the purpose of disposing of any article other than that which such cask, bottle, vessel, case, cover, label, brand, or other thing originally contained, or is connected with by the owner of such trademark or trade name, with intent to deceive or defraud, is guilty of a misdemeanor.

Sec. 354 *a*. Every person who wilfully sells, or traffics in any cask, keg, bottle, vessel, siphon, can, case, or other package bearing the duly filed trademark or name of another, printed, branded, stamped, engraved, etched, blown or otherwise attached or produced thereon, or refills any such cask, keg, bottle, vessel, siphon, can, case, or other package with intent to defraud the owner thereof, without the consent of the owner thereof, or unless the same shall have been purchased from the owner thereof, is guilty of a misdemeanor.

Sec. 354 *b*. Every person who shall wilfully deface, erase, obliterate, cover up, or otherwise remove, destroy, or conceal the duly filed trademark, or name of another, printed, branded, stamped, engraved, etched, blown, impressed, or otherwise attached to, or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package, for the pupose of selling, or trafficking in such cask, keg, bottle, vessel, siphon, can, case, or other package, or refilling such cask, keg, bottle, vessel, siphon, can, case, or other package, with intent to defraud the owner thereof, without the consent of the owner, or unless the same shall have been purchased from the owner, is guilty of a misdeameanor.

Sec. 991. Civil Code, provides that "one who conducts a particular business may appropriate to his exclusive use as a trademark any form, symbol, or name, which has not been so appropriated by another to designate the origin or ownership thereof." Under this section, the name "Cyclops Machine Works" has been protected against infringement, although used only as the name of a machine shop, and not as a trademark.¹

The Act of March 31, 1891, amended March 5, 1903, is entitled "An act to protect the owners of bottles, boxes, siphons and kegs used in the sale of soda waters, mineral or aerated waters, porter, ale, cider, ginger

1—Hainque v. Cyclops Iron Works, 136 Cal. 351, 68 Pac. Rep. 1014.

ale, milk, cream, small beer, lager beer, weiss beer, beer, white beer, or other beverages."

The secretary of state has prescribed the following form for applications for registration:

STATE OF CALIFORNIA, }
COUNTY OF _____, }

_____, being duly sworn, deposes and says that he is _____ located and doing business in the _____, State of California. That the said _____ is the exclusive owner of the trademark described in the specification accompanying this affidavit, and he petitions that the said trademark may be filed in the office of the Secretary of State of the State of California, in accordance with the law in such cases made and provided.

Subscribed and sworn to before me, this _____ day of _____, 19—.

Notary Public in and for the said _____, State of California.

SPECIFICATION.

To all whom it may concern:

Be it known that _____ of _____, State of California, being engaged in the business of _____, _____ adopted for _____ use a trademark, of which the following is a description:

This trademark consists _____.

It has generally been arranged as shown in the accompanying facsimile, _____.

(Space for attaching label.)

This trademark has been used in its business since the _____ day of _____, _____.

The class of merchandise and the particular goods upon which the trademark is used is _____.

It has been the custom to imprint it upon _____.

Witnesses:

_____.

COLORADO.

AN ACT to confer exclusive rights to the use of labels, trademarks, terms, designs, devices or forms of advertisement and provide for the recording of the same, to provide a remedy for the violation of such right, and the penalty for the unlawful use of labels, trademarks, terms, designs, devices and forms of advertising, and to repeal all acts and parts of acts inconsistent herewith.

Be it enacted by the General Assembly of the State of Colorado:

Section 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such labels, trademark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can

or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed shall be punished by a fine of not more than five hundred dollars (\$500), or by imprisonment for not more than three months, or by both such fine and imprisonment.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and description of the goods to which it has been or is intended to be appropriated stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right of such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement. so many duly attested certificates of the recording of the same as such

person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association. But the said Secretary shall file and record under this act any label, trademark, term, design, device or form of advertisement, which may have been previously filed by any person, or any association or union of workingmen, provided the person, association or union seeking to file and record under this act is the same person, association or union that previously filed or recorded the same label, trademark, term, design, device or form of advertisement.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design, or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding five hundred dollars (\$500) or by imprisonment not exceeding three months, or by both such fine and imprisonment.

Sec. 5. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit for damages to enjoin the manufacture, use,

display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunction to restrain such manufacture, use, display or sale and award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendant to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars (\$500).

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine or not more than five hundred dollars (\$500).

Sec. 8. In case the plaintiff is successful in maintaining his action either for damages or for permanent relief by injunction, or for nominal damages only, he shall be entitled to recover a reasonable attorney's fee,

to be taxed by the court as a part of the costs, and merged in the judgment.

Sec. 9. All acts and parts of acts inconsistent herewith are hereby repealed; provided, that this act shall not be construed as impairing any rights heretofore accrued, nor as affecting the remedies therefor heretofore existing.

Approved April 10, 1899.

FORM FOR APPLICATION FOR REGISTRATION.

_____, 19—.
To the Honorable the Secretary of State of the State of Colorado:

I, _____, being desirous of availing myself of the provisions of An Act of the Legislature of the State of Colorado, in relation to trademarks and labels, approved April 10, 1899, have adopted a certain trademark for the purpose of designating and distinguishing a certain article in manner and form as follows, viz.: _____

That the said _____ has the right to use the same and that no other person, firm, association, union or corporation has the right to use the same, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the facsimiles or counterparts filed herewith are true and correct.

STATE OF _____, ss:

On this _____ day of _____, A. D. 19—, before me personally appeared the above named _____, to me personally known, and made oath that the foregoing statement by him subscribed is true and correct.

My commission expires _____.

_____,
Notary Public.

CONNECTICUT.

General Statutes, Revision of 1902.

SECTION 4899. RECORD OF CERTIFICATE. Every person entitled to the exclusive use of any trademark, or who intends to adopt and use any trademark not previously adopted or used by another, may file for record in the office of the Secretary of State a certificate setting forth: his name, residence and place of business; the class of merchandise, and the particular description of goods comprised in such class, to which such trademark has been or is to be appropriated; a description of such trademark, and of the mode in which it is to be applied and used; the date when such trademark was first used or adopted; that he has a right to the use of it; and that no other person has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive. A fac-simile of such trademark shall be incorporated in or annexed to such certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record-book, if practicable. Such certificate shall be signed by the person in whose behalf it is filed, or by his agent, and the person so signing it shall make oath or affirm that all the statements therein contained are true to the best of his knowledge and belief.

SEC. 4900. LIABILITY FOR FALSE SWEARING. Every person who shall wilfully swear or affirm falsely, in any such affirmation or affidavit, as to any matter therein required to be set forth, shall be guilty of perjury, and shall pay treble damages to every party injured thereby.

SEC. 4901. MANDAMUS TO COMPEL RECORD. If the secretary of state has reason to apprehend, on the filing of any such certificate, that the statements therein contained, or any of them, are untrue, he may decline to record the same, unless the party filing it shall obtain

a writ of mandamus to compel such recording. Such writ may be granted, but without costs to the Secretary, by any proper court, on due proof that all the statements in such certificate are true, but no final hearing on the application therefor shall be had until such notice thereof as said court may order has been advertised in one or more newspapers published in the county where the party filing such certificate resides. Any persons who desire may appear and intervene as defendants and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

SEC. 4902. EFFECT OF RECORDING. Every person having the right to make and file such a certificate and affidavit, upon the recording of the same in said office, shall be entitled to the exclusive use of the trademark therein described for so long as he or his assigns shall continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right shall be assignable in writing, but all assignments thereof shall be good only against the assignor and his personal representatives until lodged for record in said office.

SEC. 4903. COPIES PRIMA FACIE EVIDENCE. The secretary shall retain all such certificates on file, and cause the same and all assignments of trademark rights to be recorded at length in his office. Copies of the record of any such certificate attested by him under the seal of the state, shall be *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trademark therein described for the periods limited in Sec. 4902.

SEC. 4904. COUNTERFEIT OR IMITATION. Every person who shall reproduce, copy, counterfeit, or imitate any such recorded trademark, knowing the same to have been recorded, and affix such reproduction, copy, counterfeit, or imitation to goods resembling or designed to

resemble those to which such trademark is so appropriated, shall pay to the owner of such trademark double damages, and also such sum, not more than five hundred dollars, as the court before which the action is brought may order to be added to the damages found by the verdict or judgment.

SEC. 4905. EXISTING RIGHTS NOT AFFECTED. The provisions of this chapter shall not abridge any rights to any trademarks existing on the twenty-second day of April, 1880, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trademarks.

SEC. 4906. USE WITH INTENT TO DECEIVE. Every person who fraudulently and with intent to deceive, affixes any trademark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle, or package similar in descriptive properties to those to which such trademark is appropriated; or who fraudulently and with intent to deceive places in any receptacle or package to which is lawfully affixed a recorded trademark, goods other than those which said trademark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trademark fraudulently affixed as above described in this section, or any goods contained in any package or receptacle having a lawful trademark, which are not such goods as such trademark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

DEVICES ON BOTTLES, SIPHONS AND BOXES are protected by sections 4913 to 4918 inclusive.

FORM FOR APPLICATION FOR REGISTRATION.

Know all men by these presents:

That ———, residing in the town of ———, county of ———, and State of ———, and having ——— place of business in ——— and

engaged in the ——— and sale of ———, ha— adopted the following trademark, to be applied by label, or by engraving, or stamping said trademark upon said goods or the packages containing them, or in advertising the same.

(Here insert trademark if possible, and send extra copies for record and certified copies, or accurately describe.)

And ——— further certify that said trademark was first used by ——— on or about the ——— day of ———, A. D. 19—, and that ——— have the exclusive right to the use of the same.

STATE OF ———, COUNTY OF ———. ss:

———, 19—.

Personally appeared, ———, and made oath to the truth of the foregoing certificate, before me,

———, *Notary Public. Justice of the Peace.*

DELAWARE.

Chapter 699, Volume 19, Laws of Delaware.

[Page 552, Code of 1893.]

AN ACT to protect associations and unions of workingmen and persons in their labels, trademarks and forms of advertising.

Be it enacted by the Senate and House of Representatives of the State of Delaware in General Assembly met:

SECTION 1. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection, any label, trademark, or form of advertisement announcing that goods to which such label, trademark, or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark, or form of advertisement. Every person violating this section shall, upon conviction, be punished by imprisonment in

the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars (\$100), or both.

SEC. 2. Every person who shall use any counterfeit or imitation of any label, trademark, or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more [than] one hundred dollars (\$100), or both.

SEC. 3. Every person, association or union, that has heretofore adopted, or shall hereafter adopt, a label, trademark, or form of advertisement as aforesaid, may file the same in the office of the Secretary of State, by leaving two copies, counterparts or fac-similes thereof with the secretary of state; said secretary shall deliver to such person, association or union so filing the same a duly attested certificate, for which he shall receive one dollar. Such certificate of filing shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of such person, association or union to adopt the same. No label shall be received and filed by the Secretary of State that probably would [be] mistaken for a label already filed.

SEC. 4. Every such person, association or union adopting a label, trademark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display, or sale, and shall award the complainant in such suit such damages, resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, and shall require the de-

endants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession, or under the control, of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

SEC. 5. Every person who shall use or display the genuine label, trademark, or form of advertisement of any such person, association or union in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by fine of not less than fifty nor more than one hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any member or officer of such association or union on behalf of and for the use of such association or union.

SEC. 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both.

SEC. 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complainant shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid.

SEC. 8. This shall be deemed and taken to be a public act.

Passed at Dover, March 29, 1893.

Chapter 92, vol. 16, Laws of Delaware (Code 1893, p. 551), relates to the protection of manufacturers and vendors of mineral water, porter, ale, or other beverages against the unauthorized use of or injury to their bottles.

Chapter 226, p. 435, of the Laws of Delaware of 1898-1899, relates to the protection of any labor organization in the adoption and use of a label or seal.

FLORIDA.

CHAPTER 4974—(No. 90).

AN ACT to authorize any person, association or union of workingmen to adopt and use a label or trademark, to protect the same by law, to provide for its record, to prevent counterfeiting the same, or using the original or any package containing the same; and to prevent using the name or seal thereof without authority, and fixing penalties for violations thereof.

Be it enacted by the Legislature of the State of Florida:

Section 1. Whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided, any label, trademark, term, wording, design, device, color or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, wording, design, device, color or form of advertisements, or knowingly to use, sell, offer for sale, or in any other way utter or circulate any counterfeit, or imitation of any such label, trademark, term, wording, design, device, color or form of advertisement.

Sec. 2. Whoever counterfeits or imitates any such label, trademark, term, wording, design, device, color or form of advertisement, or knowingly sells, offers for

sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, wording, design, device, color or form of advertisement; or knowingly purchases and keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly purchases with intent to sell or dispose of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or having knowingly purchased, keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than five hundred dollars, or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, wording, design, device, color or form of advertisement as provided in section 1 of this act, may file the same for record in the office of Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, wording, design, device, color or form of advertisement shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trademark, term, wording, design, device, color or form

of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union or corporation has the right to use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct.

There shall be paid for such filing and recording a fee of two dollars. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, wording, design, device, color or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which the Secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, wording, design, device, color or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, wording, design, device, color or form of advertisement that would probably be mistaken for any label, trademark, term, wording, design, device, color or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall, for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, wording, design, device, color or form of advertisement in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars, or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trademark, term, wording, design, device, color or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from any such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainants, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trademark, term, wording, design, device, color or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars.

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall, in any way, use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. Any person using the trademark so adopted and filed by any other person, or any imitation of such trademark, or any counterfeit thereof; or who shall in any manner mutilate, deface, destroy or remove such trademark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second-hand packages, which has contained the same or been used therefor, with the intention of using such empty or second-hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first used; and any person who shall use any such empty or second-hand package for the purpose aforesaid, without the consent in writing of the person whose trademark was first applied thereto or placed thereon, shall, upon conviction thereof, be fined in any sum not less than five hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles contained in any such second-hand package or packages shall be forfeited to the original user of such package or packages whose trademark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular articles or packages shall be held to be a separate offense.

Sec. 9. The word "person" in this act shall be construed to include a person, copartnership, corporation, association or union of workingmen.

Sec. 10. This act shall take effect immediately upon its passage and approval by the Governor.

Approved May 29, 1901.

GEORGIA.

CODE 1895, and Supp., 1901.

§ 1736. Whenever any person, association or union of workmen have adopted, or shall hereafter adopt for their protection, any label, trademark, or form of advertisement announcing that goods to which such label, trademark, and forms or advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark, or form of advertisement with intent to use the same for the purpose of deceiving the public in the sale of the goods.

§ 1737. Every person who shall use any counterfeit or imitation of any label, trademark, or form of advertisement of any such person, union, or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor.

§ 1738. Every person, association, or union of workmen that has adopted or shall hereafter adopt a label, trademark, or form of advertisement, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac similes thereof, with the secretary of state. Said secretary shall deliver to such person, association, or union, a duly attested certificate of the record of the same, for which he shall receive the fee of one dollar; such certificate of record shall, in all suits under this chapter, be sufficient proof of the adoption of such label, trademark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

§ 1739. Every such person, association, or union

adopting a label, trademark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunction to restrain such manufacture, use, display or sale, and shall award the complainant in such suits such damages resulting from such wrongful manufacture, use, display, or sale as may by said courts be deemed just and reasonable, and shall require the defendant to pay such person, association, or union the profit derived from such wrongful manufacture, use, display, or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

§ 1740. In all cases where such associations or unions are not incorporated, suits may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

§ 1741. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, knowing that such use is unauthorized, with the intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor.

§ 4035. Any attempt to encroach upon the business of a trader, or other person, by the use of similar trademarks, names or devices, with the intention of deceiving and misleading the public, is a fraud for which equity grants relief.

§ 6676. Whenever any person, firm, corporation or association shall adopt and use in their business, for their protection, any label, trademark, trade name or form of advertisement, it shall be unlawful for any per-

son, firm, corporation or association to counterfeit or imitate such label, trademark, trade name or form of advertisement, with intent to use the same for the purpose of deceiving the public in the sale of goods. Every person violating this section shall be guilty of a misdemeanor and punished therefor.

§ 6677. Every person, firm, corporation or association who shall use any counterfeit or imitation of any label, trademark, trade name or form of advertisement of any person, firm, corporation or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor and punished therefor.

§ 6678. Every person, firm, corporation or association who shall use or display the genuine label, trademark, trade name or form of advertisement of any person, firm, corporation or association, in any manner not authorized by law, such person, firm, corporation or association, knowing that such use is not authorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and be punished therefor.

§ 6679. Any firm, person, corporation or association who shall use the name or seal of any other person, firm, corporation or association, in and about the sale of goods or otherwise, not being authorized to use the same, knowing that such use is unauthorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and punished therefor.

§ 6680. Any person, firm, corporation or association that shall be found guilty of violating the provisions of this act, or any of them as aforesaid, shall be punished as prescribed in section 1039 of the Penal Code.

The Act of December 20, 1893, entitled "An Act for the Protection of Union Labels, trademarks, and form of advertisement, and providing penalties for counterfeiting the Same" has been held to be designed exclusively for the protection of the labels, trademarks

and forms of advertisement of labor unions and associations.

Comer v. State, 103 Ga. 69, 29 S. E. Rep. 501.

IDAHO.

POLITICAL CODE, 1901.

Sec. 635. Whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement, for the purpose of designating, making known or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workingmen, or by a member or members of such association, or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

Sec. 636. Every such person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section 635, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac similes thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term,

design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association; and any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design or form of advertisement in the office of the secretary of state under the provisions of this subdivision, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction.

Sec. 637. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid may proceed

by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture and may award the complainant in any such damage resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such persons, association, or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed; and in all cases where such association or union is not incorporated, suits may be commenced and prosecuted by an officer or members of such association or union, on behalf of, and for the use of such association or union.

PENAL CODE OF 1901.

Sec. 4950. Whoever counterfeits or imitates any label, trademark, term, design, device or form of advertisement, described in section 635 of the Political Code, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any label, trademark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent

that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be guilty of a misdemeanor and be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

Sec. 4951. The phrases "forged trademark" and "counterfeit trademarks," or their equivalents, as used in this chapter, includes every alteration or imitation of any trademark so resembling the original as to be likely to deceive.

Sec. 4952. The phrase "trademark," as used in section 4950, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him other than any name, word, or expression generally denoting any goods to be of some particular class or description.

Section 4999. Any person who shall for himself or on behalf of any other person, association, or union procure the filing of any label, trademark, term, design or form of advertisement in the office of the secretary of state, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of, the party injured thereby in any court having jurisdiction, and shall be guilty of a misdemeanor and be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months.

Section 5000. Every person who shall use or display the genuine label, trademark, term, design, device or

form of advertisement of any such person, association or union, in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars.

Section 5001. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

ILLINOIS.

STARR & C. ST. 1896, Vol. 3, Pages 3955-3957.

AN ACT to protect associations, unions of workingmen and persons in their labels, trademarks and forms of advertising.

Par. 6, § 1. Whenever any person or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

Par. 7, § 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of

advertisement, or sells, offers for sale or in any way utters, or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement, or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells, or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not less than one hundred (100) dollars, nor more than two hundred (200) dollars, or by imprisonment for not less than three (3) months nor more than one (1) year, or by both such fine and imprisonment.

Par. 8, § 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section one (1) of this act, shall file the same for record in the office of the secretary of state, by leaving two (2) copies, counterparts or *fac similes* thereof with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to

which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac simile* copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding two hundred (200) dollars or by imprisonment not exceeding one (1) year or both such fine and imprisonment. The secretary of state shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for

any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

Par. 9, § 4. Every such person, association or union adopting a label, trademark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations; and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant to be destroyed.

Par. 10, § 5. Every person who shall use or display the genuine label, trademark, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

Par. 11, § 6. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the

same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

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Paragraph 1, § 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complaining shall so elect, and in case of conviction before such justice of the peace the offender shall stand committed to the county jail until the fine and costs are fully paid, under the provisions of section 8, article IX, of an act to revise the law in regard to criminal jurisprudence, in force July 1, 1874, or otherwise. The first process under this section in all prosecutions for the recovery only of the fines, shall be a summons: provided, however, that a warrant for the arrest of the offender, as in other cases when justices of the peace have original criminal jurisdiction, may issue upon the affidavit of any person that any of the provisions of this act have been violated, and that the person making the complaint has just and reasonable grounds to believe the party charged is guilty thereof. (Section as amended by act approved April 22, 1902).

An Act of May 11, 1901, Hurd's Revised Stat., 1901, p. 1793, relating to the unlawful buying and selling of receptacles, and for the registration of marks in connection with such articles. This Act has been held to be unconstitutional, as being beyond the police power of the state and in contravention of § 22, article 4 of the Illinois Constitution of 1870 in *Horwich vs. Walker-Gordon Laboratory Co.*, 205 Ill. 497, 68 N. E. Rep. 938. A similar statute passed in 1873 (Rev. Stat. 1874, p. 1084, Chap. 140) was held unconstitutional in *Lippman v. People*, 175 Ill. 101, 51 N. E. Rep. 872.

That union labels are properly within the protection of paragraph 6, sections 1 to 6, See *Cohn v. People*, 149 Ill. 486, 37 N. E. Rep. 60 and see *Vogt v. People*, 57 Ill. App. 684.

§ 2, Chap. 32, Rev. Stat. 1893, forbidding the incorporation of two companies under the same name, does not prevent the incorporation of separate concerns under the corporate names, "Elgin Creamery Company" and "Elgin Butter Company"; the word "Elgin" being geographical, and there being no proof of any intent, act or artifice to mislead the public as to the identity of the corporation.

Elgin Butter Co. v. Sands, 155 Ill. 127, 40 N. E. Rep. 616.

That a warrant in aid of a suit for trademark infringement was improperly issued under the general search warrant act see *White v. Wagar*, 185 Ill. 195; *White v. Wagar*, 83 Ill. App. 592.

APPLICATION FOR REGISTRATION OF TRADEMARK.

STATE OF ———, }
COUNTY OF ——— }

The undersigned ——— being duly sworn on oath, says that ——— makes this statement in ——— behalf, in pursuance of Chapter 140 of "Hurd's" Revised Statutes of the State of Illinois.

That he files herewith two copies which are counterparts or fac-similes of a certain ——— which ——— has adopted and intends to appropriate for the purpose of designating, making known or distinguishing the following described goods, wares, merchandise or products of labor, to-wit: ———

That he has the right to use the said ——— and that no other person, firm or association has a right to use, either in the identical form herein set forth or in any such near resemblance thereto as may be calculated to deceive. And that the fac-simile copies or counterparts filed herewith are true and correct.

The essential part of said _____.

Subscribed and sworn to before me by the said _____ this _____ day of _____, A. D. 19—.

[SEAL.]

_____,
Notary Public.

INDIANA.

BURNS' ANNOTATED INDIANA STATUTES, REVISION OF 1901.

8681. That any firm, person, corporation or voluntary association that are citizens of the state of Indiana, except foreign corporations, and who are entitled to the exclusive use of any lawful trademark, label, brand, stamp or wrapper, may obtain protection for such lawful trademark, label, brand, stamp or wrapper by complying with the following requirements: First, by causing to be filed with the secretary of state a statement specifying the names of the parties, and the residences and places of business, who desire the protection of the trademark, label, brand, stamp or wrapper, the class of merchandise and the particular description of goods comprised in such class, by which the trademark, label, brand, stamp or wrapper has been, or is intended to be protected. A description of trademark, label, brand, stamp or wrapper, with *fac simile* thereof, showing the mode in which it has been and is intended to be applied and used, and the length of time, if any, during which the trademark, label, brand, stamp or wrapper has been in use. Second, by making a payment of a fee of two dollars to the secretary of state, whose duty it will be to file and record said statement in a book kept for the purpose to be procured by him as other books in his office of like nature are procured.

8682. Any certificate or statement prescribed in the

preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or some member of the firm or officer of the corporation or voluntary association by whom it is filed, to the effect that the party claiming the protection for the trademark, label, brand, stamp or wrapper, has a right to the same and that no other person, firm, corporation or voluntary association has the right to such use either in the identical form or in any such near resemblance as might be calculated to deceive; and that the description and *fac simile* presented for record are true copies of the trademark, label, brand, stamp or wrapper sought to be protected.

8683. The time of the receipt of any trademarks, label, brand, stamp or wrapper at the office of the secretary of state for registration shall be noted and recorded. Certified copies of the trademark, label, brand, stamp or wrapper, and the date of the receipt thereof, and of the statement and affidavit filed therewith shall be *prima facie* evidence of the facts and statements and affidavit record in any suit in which such trademark, label, brand, stamp or wrapper shall be brought into controversy.

8684. A trademark, label, brand stamp or wrapper shall remain in force so long as it is used continuously; after a disuse of six months it shall be deemed out of existence. Such trademark, label, brand, stamp or wrapper may be sold or assigned, or pass to personal representatives by will, or become assets of an estate. In any case where ownership changes of such trademark, label, brand, stamp or wrapper, before it can be used by the successor in title, a statement of such change of ownership shall be filed with the secretary of state, and he shall record the same in the book kept for the purpose of recording trademarks, labels, brands, stamps and wrappers, and such secretary shall receive

two dollars for recording such statement; and it shall be unlawful to use such trademark, label, brand, stamp or wrapper till such change of ownership has been filed as aforesaid.

8685. Such trademark, label, brand, stamp or wrapper shall entitle the person, firm, corporation, or voluntary association registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person, firm, corporation or voluntary association can lawfully use the same trademark, label, brand, stamp or wrapper, or substantially the same, or so nearly resembling it as to be calculated to deceive upon substantially the same description of goods.

8686. For a violation of any rights created by this act, the person, firm, corporation or voluntary association aggrieved, shall have all common law remedies and actions for damages, and shall be entitled to an injunction to prevent further use of any trademark, label, brand, stamp or wrapper by this act secured to the injured person, firm, corporation, or voluntary association; and, if an injunction is made final and perpetual, the injured firm, corporation or voluntary association shall recover reasonable attorney's fees.

8687. Any owner of a trademark, label, brand, stamp or wrapper, who has complied with the provisions of this act, shall have the right to grant to others the authority to use such trademark, label, brand, stamp or wrapper; but such authority to so use must be in writing, signed by the owner of such trademark, label, brand, stamp or wrapper, with two witnesses to such signature, and no one but the owner shall have the right to use such trademark, label, brand, stamp or wrapper, unless such written authority has been given.

8688. If it becomes necessary for any voluntary association to assert any right to any trademark, label,

brand, stamp or wrapper, it shall be sufficient to use the name of president or chief officer of such association either in action at law, suit in equity, or indictment for the violation of the provisions of this act.

8689. This act shall not be construed to lessen, impair or abridge any rights or remedies that have heretofore existed in favor of any one owning or rightfully claiming a trademark, label, brand, stamp or wrapper.

8690. That any person or persons, who shall knowingly or wilfully cast or engrave, or manufacture, or have in his, her or their possession, or buy, sell or offer for sale, or deal in any die or dies, plate or plates, brand or brands, engraving or engravings on wood, stone, metal or other substances, molds or any false representations, likeness, copy or colorable imitation of any die, plate, brand or mold of any private trademark, label, brand, stamp, wrapper, engraving on paper or other substance, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for not less than one year, or more than two years, or be fined in a sum not less than one thousand dollars, or more than two thousand dollars.

8691. That any person or persons (who shall) knowingly and wilfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale or deal in any representation, likeness, similitude, copy or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trade mark, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for a period of years not more than two nor less than one, or be fined in any sum not less than one thousand dollars nor more than two thousand dollars.

8692. It shall be unlawful for any person, firm, corporation or voluntary association doing business in this state to have in his or its possession, or to sell, or offer

for sale or trade, any goods, wares, merchandise or other article upon which he or it knows is placed or affixed a false, forged or spurious trademark, label, brand, stamp, or wrapper in likeness or imitation of some trademark, label, brand, stamp, or wrapper registered as provided for in this act; and any such person, firm, corporation or voluntary association so having in his or its possession or selling, or offering for sale or trade, any goods, wares or merchandise upon which he or it knows is placed or affixed a false, forged or spurious trademark, label, brand, stamp or wrapper in likeness or imitation of some trademark, label, brand, stamp or wrapper registered as aforesaid shall, upon conviction thereof, be punished by fine in a sum of not less than fifty dollars (\$50.00) nor more than two hundred dollars (\$200.00), or imprisoned in the county jail six months, or both.

Sections 8678-8680c relate to the protection of manufacturers, bottlers, and sellers of mineral water, cider, ale, beer, ginger pop, soda water, distilled water, ginger ale, seltzer water, fermented liquors, and other beverages in the unauthorized use of their bottles or syphons.

Sections 8693-8703, inclusive, relate to the labels, names and stamps of labor unions and associations.

Under § 8680b. an indictment which failed to charge the defendant filled or caused to be filled any bottle or siphon with any liquid mentioned in the Act, was held to be fatally defective.

State v. Wright, 159 Ind. 394, 65 N. E. Rep. 190.

When, under the Act of 1891, page 317, the "Cigar-maker's International Union of America," a national labor union, registered their label, the benefit of the Act being by its terms limited to, "any firm, person, corporation, or voluntary association that is a citizen of the State," it was held that the label could not be protected by a criminal prosecution, notwithstanding the fact that members of the association were citizens of the State.

State v. Hagen, 6 Ind. App. 167, 33 N. E. Rep. 223.

The sufficiency of an indictment under § 8680b. is discussed in *State vs. Barnett*, 159 Ind. 432, 65 N. E. Rep. 515.

FORM FOR APPLICATION FOR REGISTRATION.

Certificate accompanying a _____
(Insert Label, Trademark, Stamp, or Form of Advertisement, as the case may be.)

filed in accordance with _____
An Act to protect manufacturers from the use of counterfeit labels, stamps and trademarks.

Name or names of the person or association _____
(Follow regulations at a.)

Residence, location or place of business _____

Class of merchandise and the particular description of goods comprised in such class to which the _____

(Insert Label, Trademark, Stamp, or Form of Advertisement, as the case may be.)

has been or is intended to be appropriated _____
(Follow regulations at b.)

Length of time, if any, during which the _____
(Insert Label, Trademark, Stamp, or Form of Advertisement, as the case may be.)

has been in use. Since _____
(Give Month, Day of Month and Year when adopted, or give date since when in use.)

REGULATIONS.

a. If a corporation, state under the laws of what State incorporated.

If one or more persons are doing business under a proprietary or company name, state the name of such person or persons and add the words "doing business under the name and style of," then give the proprietary or company name under which the business is conducted.

b. State, *first*, as near as possible in one or two words, the general class of merchandise to which the label, trademark, stamp or form of advertisement has been or is intended to be appropriated;

Second, as near as possible in one or two words, the particular description or designation in such general class of merchandise. Do not describe the composition, or name the parts which comprise the formula of which the merchandise is composed;

Third, by using the following words: "The essential feature of the (label, trademark, stamp or form of advertisement) is," giving what is considered to be the essential feature or features thereof. If an illustration or pictorial representation is used for a trademark, it is very desirable that a word or words shall also form a part of the "essential features" of such trademark;

Fourth, by using the following words, that: "The style and size of type and the color of ink and paper may be varied at pleasure."

*I, ———, do hereby declare, in accordance with the provisions ——— has a right to the use of the — — (Insert Label, Trademark, Stamp or Form of Advertisement, as the case may be.) referred to in the foregoing certificate, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and

I further declare that the fac-similes, copies or counterparts filed with the foregoing certificate are true and correct.

In witness whereof, I have hereunto signed my name this ——— day of ———, in the year one thousand ———.

[STAMP.]

Sign here ——— ———.

COUNTY OF ——— }
STATE OF ———, } ss:

———, 19—.

Then personally appeared the above-named ——— and made oath that the foregoing declaration by him subscribed is true.

Before me, ———.

*If a person, insert name; if an officer of an association, union or corporation, insert name, title of office, and name of the association, union or corporation.

†Affix ten-cent revenue stamp here and cancel by writing initials and date thereon.

IOWA.

CODE 1897, CH. 13, TIT. 24.

SEC. 5049. FALSELY USING LABEL OF LABOR UNION. Every person, or association or union of working men or others, that has adopted or shall adopt for their protection any label, trademark or form of advertisement may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac-similes thereof with the secretary of state. Said secretary shall thereupon deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all actions and prosecutions under the following six sections be

sufficient proof of the adoption of such label, trademark or form of advertisement, and the right of said person, association or union to adopt the same.

SEC. 5050. INJUNCTION. Every person, association or union adopting a label, trademark or form of advertisement, as specified in the preceding section, may proceed by action to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof; and all courts having jurisdiction of such actions shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant therein such damages resulting from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court to be destroyed. Such actions may be prosecuted for the benefit of any association or union by any officer or member thereof.

SEC. 5051. IMITATION OF SUCH LABEL. It shall be unlawful for any person or corporation to imitate any label, trademark or form of advertisement adopted as provided in the second preceding section, or to knowingly use any counterfeit or imitation thereof, or to use or display such genuine label, trademark or form of advertisement, or the name or seal of such person, union or association, or of any officer thereof, unless authorized so to do, or in any manner not authorized by him or it. Any person violating any provision of this section shall be imprisoned in the county jail not more than thirty days, or be fined not less than twenty-five nor more than one hundred dollars.

RULES GOVERNING REGISTRATION

OF

LABELS, TRADEMARKS OR FORMS OF ADVERTISING

A label, trademark, or form of advertising, may be registered in either or several of the above forms, but if in more than one form, a separate registration must be had for each of the forms for which registration is desired. Duplicate fac-similes or counterparts for each form must be furnished and a fee of \$1.00 paid for each registration certificate issued.

Applicant must designate in enclosed blank application the form in which registration is desired, whether as a label, trademark, or form of advertising.

No certificate will be issued covering more than one of above forms.

If application is made by a corporation, union, or association, the application should be signed by the proper officer thereof, with official title, giving the full name of the firm, corporation, union or association.

If by a firm the firm name should be given, signed by a member of the firm, or all the members of such firm.

Remit \$1.00 in payment for each certificate.

All remittances should be made by draft, express or money orders.

Please do not send personal checks.

APPLICATION FOR REGISTRATION.

OF A

by — of — filed in the office of the Secretary of State, of the State of Iowa, in accordance with sections 5049, 5050, 5051, Code of 1897.

The said — has been or is intended to be appropriated for use in connection with —.

The style and size of type and the color of ink and paper may be varied at pleasure.

If used as a label, or trademark, it is usually applied by painting

or stenciling, by labels, or by forming on the material of which the product is made.

If, as a form of advertising, it is used in advertisements, in newspapers, circulars, on letter-heads, on invoices, and other printed matter.

The said ——— has been in use since ——— and consists of the arbitrarily selected word, mark, symbol or character herewith illustrated.

The essential features of the ——— consists of ———.

IN WITNESS WHEREOF, I have hereunto signed my name this ——— day of ——— A. D. 190—.

Name ———.

By ———.

STATE OF ———, } ss:
COUNTY OF ——— }

Subscribed and sworn to before me this ——— day of ———, A. D. 190—.

_____,
Notary Public.

KANSAS.

GENERAL STATUTES 1901.

§ 7850. If any person or persons shall wilfully change, alter, deface, destroy, counterfeit, cut out or dispose of any trademark, brand, impression or device used by a person, company or corporation within this state, to designate a particular description of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle, package, or the contents thereof, he or they shall forfeit and pay to the owner or owners thereof, for each offense, not exceeding the sum of twenty-five dollars, to be recovered in any court proper to try the same, or before a justice of the peace having jurisdiction of the same.

§ 7851. If any person shall change, shift and place any brand, mark or device, used or intended to be used for the purpose aforesaid, to or upon any piece of goods, wares, merchandise, cask, barrel, half-barrel, keg, bottle or package, or shall intermix, take

out, change or shift any article, liquid, or commodity whatever, into a branded cask, barrel, half-barrel, keg, bottle or package, and thereby avail him or themselves of another person or persons' brand, mark, or device, he or they shall forfeit for every such offense the sum of twenty-five dollars, to be recovered as aforesaid.

Sections 7852-7857, inclusive, protects labor unions in the use of their labels and trademarks.

KENTUCKY.

No general trademark law. General Statutes, 1899.

§ 4779. Every union or association of workingmen or women adopting a label, mark, name, brand or device intending to designate the products of the labor of members of such union or association of workingmen or women shall, in order to obtain the benefits of this act, file duplicate copies of such label, mark, name, brand or device in the office of the Secretary of State, who shall, under his hand and seal, deliver to the party filing or registering the same, a certified copy and a certificate of the filing thereof.

It has been held by the Court of Appeals of Kentucky that union labels will be protected against infringement in the absence of a statute.

Hetterman v. Powers, 102 Ky. 133, 43 S. W. Rep. 180.

§§ 1279 and 1279a relate to the protection of packages of manufactures and bottlers of soda water, etc.

The following form has been prescribed for application for registration under Section 4749:

BE IT REMEMBERED, That the ——— has adopted the following label, mark, name, brand or device, which is intended to designate the products of the labor of members of said ——— towit:
and hereby files duplicate copies thereof in the office of the Secretary of State, pursuant to the provisions of Section 4749, Chapter 130, Kentucky Statutes, title "Union and Labor Associations."

Witness the signatures of the President, Secretary and Treasurer, and the corporate seal of the said ———, this ——— day of ——— 1902.

LOUISIANA.

Act No. 49 of 1898.)

AN ACT to protect labels, trademarks, terms, designs, devices or forms of advertisement, and to provide a penalty for violation thereof.

Section 1. Be it enacted by the General Assembly of the State of Louisiana: Whenever any person, or any association or union of workmen, has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

Sec. 2. Be it further enacted, etc., Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other products of labor contained

in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

Sec. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac-similes thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or it intended to be appropriated, stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same

as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, union or association.

Sec. 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damage sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

Sec. 5. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such

wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 6. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

Sec. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

Sec. 8. This act shall take effect and be in force from and after its passage.

Approved July 8, 1898.

FORM FOR APPLICATION FOR REGISTRATION.

To all Whom it May Concern:

BE IT KNOWN, That ———, a corporation organized under the laws of the State of ———, domiciled in the City of ———, County of ———, and doing business in said city and county, has adopted for its use a trademark for ——— of which three copies, counterparts or fac-similes, are herewith filed for record in the office of the Secretary of State, to-wit:

This application is filed on behalf of the ——— aforesaid. The class of merchandise, and description of goods to which said trade-

mark has been appropriated and is intended to be appropriated is ———, the said ——— has the sole right to the use of the same. No other person, firm, association, union or corporation has the right to such use, either in the identical form herein above described, or in any such resemblance thereto as may be calculated to deceive, and the fac-similes or counterparts herewith filed are true and correct.

Thus done and signed at the City of ——— this ——— day of ———, 190—.

—————

AFFIDAVIT.

STATE OF ———, }
COUNTY OF ——— } ss:

————— being duly sworn, deposes and says that he is the President of the ———, the applicant named in the foregoing instrument, and that the facts alleged in said instrument are true.

Sworn to and subscribed before me, this ——— day of ———, 19—.

—————,
Notary Public.

MAINE.

EXTRACT FROM CHAPTER 39 REVISED STATUTES.

Section 37. Any person entitled to the exclusive use of any trademark, or who intends to adopt and use any trademark not previously adopted or used by another, may file for record in the office of the secretary of state a certificate setting forth his name, residence and place of business; the class of merchandise and the particular description of goods comprised in such class to which such trademark has been or is to be appropriated; a description thereof, and of the mode in which it is to be applied and used; the date when it was first used or adopted; that he has a right to the use of it; and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as is calculated to deceive. A fac-simile of such trademark shall be incorporated in or annexed to said certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record

book, if practicable. Such certificate shall be signed and sworn to by such person, or his agent.

Sec. 38. Whoever wilfully swears or affirms falsely to any such certificate, is guilty of perjury, and shall pay treble damages to every party injured thereby. If the secretary of state has reason to apprehend, on the filing of such certificate, that any statement therein contained is untrue, he may decline to record the same, unless the party filing it obtains a writ of *mandamus* to compel him. Such writ may be granted, but without costs to the secretary, by any proper court, on proof that all the statements in such certificate are true, but no final hearing on the application therefor, shall be had until such notice thereof as said court orders has been advertised in one of more newspapers published in the county where the party filing said certificate resides; and any persons who desire may appear and intervene as parties defendant, and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

Sec. 39. Every party entitled to make and file such certificate and affidavit, upon recording the same in said office, becomes entitled to the exclusive use of the trademark therein described, so long as he or his assigns continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right is assignable in writing; but all assignments thereof are good only against the assignor and his personal representatives, until lodged for record in said office.

Sec. 40. The secretary of state shall retain all such certificates on file, and cause the same and all assignments of trademark rights to be recorded at length in his office, and is entitled to a fee of three dollars for each certificate, and one dollar for each assignment so filed and recorded. Copies of the record of any such certificate, attested by him under the seal of the state,

are *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trademark therein described for the periods limited in the preceding section.

Sec. 41. Whoever reproduces, copies, counterfeits, or imitates any such recorded trademark, knowing the same to have been recorded, and affixes such reproduction, copy counterfeit or imitation to goods resembling or designed to resemble those to which such trademark is so appropriated shall pay to the owner of such trademark double damages besides such sum not exceeding five hundred dollars as the court before which the action is brought orders to be added to the damages found by the verdict or judgment.

Sec. 42. Whoever fraudulently and with intent to deceive affixes any trademark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle or package similar in descriptive properties to those to which such trademark is appropriated, or who fraudulently and with intent to deceive, places in any receptacle or package to which is lawfully affixed a recorded trademark, goods other than those which said trademark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trademark fraudulently affixed as above described, or any goods contained in any package or receptacle having a lawful trademark, but not being such goods as said trademark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

Sec. 43. This chapter does not abridge rights to any existing trademarks, whether the same are hereafter recorded or not, nor any remedies or rights of action otherwise or heretofore existing in favor of owners of trademarks.

LAWS 1893, CH. 276.

AN ACT to protect persons, associations and unions of workmen and others in their labels, trademarks, devices and forms of advertising.

Section 1. Whenever any person, or any association, or union of workmen has adopted and used, or shall hereafter adopt and use any label, trademark, device, or form of advertisement to indicate that goods to which such label, trademark, device or form of advertisement, shall be attached or affixed, or on which the same shall be printed, painted, stamped or impressed, were manufactured or produced, packed or put on sale by such person or by such association or union, or by a member or members thereof, which was not, before such adoption and use, lawfully adopted, owned and used by another as a label, trademark, device or form of advertisement, from whom no right or authority to use and adopt the same had been acquired by such person, or by such association or union, or by such member or members thereof, nor a counterfeit, imitation or semblance thereof, it shall be unlawful to counterfeit or imitate such label, trademark, device or form of advertisement, or use the same without the consent or authority of the person, association or union so having adopted and used it.

Sec. 2. Whoever knowingly, and with intent to mislead or deceive, counterfeits or imitates any such label, trademark, device or form of advertisement, or knowingly uses or sells any such counterfeit or imitation of any such label, trademark, device or form of advertisement, or knowingly sells or disposes of, or keeps, or has in his possession with intent that the same shall be sold, any goods to which any such counterfeit or imitation of such label, trademark, device or form of advertisement is attached or affixed, or on which the same is printed, painted, stamped or impressed, shall, for the first offense be punished by fine not exceeding one hun-

dred dollars, or by imprisonment for less than one year, and for the second and every subsequent offense, he shall be punished by fine not less than one hundred, nor more than five hundred dollars, or by imprisonment not less than sixty days, nor more than three years.

Sec. 3. Every such person, association or union that has heretofore adopted or shall hereafter adopt, a label, trademark, device or form of advertisement as aforesaid shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or facsimiles thereof, with the secretary of state, together with a statement, in writing, signed and sworn to by such person or by some person for and in behalf of such association or union, stating when and by whom so far as he knows and believes, said label, trademark, device or form of advertisement was adopted or used, in what manner and for what purpose the same is to be used and by what right he claims the same, and such other particulars as shall serve to identify the same, said secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of two dollars. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, device, or form of advertisement. No label, trademark, device or form of advertisement shall be recorded that so nearly resembles one already recorded as to be liable to be mistaken for such label, trademark, device or form of advertisement and when in the judgment of the secretary of state, such resemblance exists he shall refuse to record such label, trademark, device or form of advertisement.

Sec. 4. Every such person, association or union that has adopted and uses a label, trademark, device or form of advertisement, as aforesaid, and which has been recorded in the office of the secretary of state as hereinbefore provided, may proceed by suit to enjoin the

manufacture, use, display or sale of any such counterfeits or imitations, or of any goods to which such counterfeits or imitations shall be affixed or attached, or on which the same shall be printed, painted or impressed, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages resulting from such wrongful manufacture, use, display or sale as may by said court be deemed reasonable, and shall require the defendants to pay such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case, be delivered to an officer of the court, or to the complainant, to be destroyed.

Sec. 5. Every person who shall wilfully use or display the genuine label, trademark, device, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second offense, shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 6. Any person or persons who shall in any way wilfully use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not more than six months, or by a fine not exceeding one hundred dollars, or both; and upon conviction for a second of-

fense shall be punished by imprisonment not less than thirty days nor more than one year, or by a fine not less than fifty nor more than three hundred dollars, or both.

Sec. 7. In all cases where the association or union mentioned in this act is not incorporated, suits and proceedings under this act may be commenced and prosecuted by an officer or member of such association or union, for and in behalf of and for the benefit of such association or union.

Approved March 28, 1893.

Maine also has an act for the protection of the bottles used in the manufacture and sale of mineral water, soda water, and similar packages; §§ 35-36, c. 39, Revised Statutes of 1883, as amended with an additional section in Chapter 125, General Laws 1891.

FORM OF APPLICATION FOR REGISTRATION.

Sworn Statement accompanying a ———, filed in accordance with the laws of the State of ———:

I, ———, do hereby certify that the ———, counterparts or fac-similes of which are filed herewith, is filed on behalf of ———, doing business in ———, in the State of ———. That the particular class of merchandise and the particular description of the goods to which it has been or is intended to be appropriated is ———.

That the essential feature of the said ——— consists of ———.

That said ——— has been in use by the above named ———, since ———.

That the said ——— has the right to the use of the same, and that no other person, firm, association or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed herewith are true and correct.

(Signature) ——— ———.

STATE OF ———, }
COUNTY OF ——— } ss:

On this ——— day of ——— A. D. 190—, ——— personally appeared the above named ——— and made oath that the foregoing statement by him subscribed is true.

Before me,

MARYLAND.

AN ACT to protect associations and unions of workingmen and persons in their labels, trademarks and forms of advertising and to punish offenders for a violation of the same.

SECTION 1. *Be it enacted by the General Assembly of Maryland,* That whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection any label, trademark or form of advertisement announcing and denoting that goods to which such label, trademark or form of advertisement shall or may be attached, were manufactured by such person or by a member or members of such association or union, it shall not be lawful for any person or corporation to counterfeit or imitate such label, trademark or form of advertisement, every person violating this section shall be deemed guilty of a misdemeanor and shall upon conviction by any court having criminal jurisdiction be punished by imprisonment in the city or county jail for not less than three months nor more than one year or by a fine of not less than one hundred dollars nor more than five hundred dollars, or both, in the discretion of the court.

SEC. 2. *And be it enacted,* That every person, corporation or association who shall use any counterfeit or imitation of any label, trademark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, (he) shall be guilty of a misdemeanor and shall on conviction by any court having criminal jurisdiction be punished by imprisonment in the city or county jail for a term of not less than one month nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both, in the discretion of the court, and the burden of proving that the defendant did not know the true character of the said label, trademark

or form of advertisement, and that he used the same in good faith shall be on the defendant.

SEC. 3. *And be it enacted*, That every such person, association or union that has heretofore adopted, or shall hereafter adopt, a label, trademark or form of advertisement as aforesaid, may file the same for record, in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with the Secretary of State and said Secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same for which he shall receive a fee of one dollar, such certificate of record shall be in all suits and prosecutions under this act sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said person, association or union to adopt the same, no label shall be recorded, that probably would be mistaken for a label already of record, of which question the said Secretary shall be the judge.

SEC. 4. *And be it enacted*, That every such person, association or union adopting a label, trademark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit such damage resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, according to the evidence in the case, and shall require the defendants to pay such persons, associations or unions, the profits derived from such wrongful manufacture, use, display or sale, and in addition to court costs, such reasonable attorney's fees as the court may allow, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant

in such case be delivered to an officer of the court, or to the complainant to be destroyed.

SEC. 5. *And be it enacted*, That every person who shall use or display the genuine label, trademark of form of advertisement, of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor and shall, on conviction be punished by imprisonment in the city or county jail not less than one month nor more than one year, or by a fine of not less than fifty dollars or more than two hundred dollars, or both, in the discretion of the court.

SEC. 6. *And be it enacted*, That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable on conviction by imprisonment in the city or county jail for a term of not less than three months or more than one year, or by a fine of not less than fifty dollars nor more than three hundred dollars, or both, in the discretion of the court.

SEC. 7. *And be it enacted*, That all the acts and parts of acts inconsistent with this act are hereby repealed.

SEC. 8. *And be it enacted*, That this act shall take effect from the date of its passage.

Approved April 4th, 1892.

Maryland also has an act for the protection of the bottles, jugs, kegs, etc., of manufacturers and dealers in mineral water and other beverages; §§ 201-206, Article 27, General Laws, amended by Acts of 1892, Chapter 262.

As to the requisites of a bill in equity founded on registration under the Act of 1892, see *Smith-Dixon Co. v. Stevens*, 59 Atl. Rep. 401.

FORM AND REQUIREMENTS FOR REGISTRATION.

State of _____, }
 City of _____, } _____ 190—.

I hereby certify that _____, whose business or trade is _____, have adopted a trademark or label, and hereby make application to the Secretary of State of the State of Maryland, for the registration of the same, in compliance with the provisions of Chapter 357 of the laws of Maryland of 1892.

Witness, the hand of the President (or other proper officer) and the seal of the corporation, this _____ day of _____, 190—.

[CORPORATE SEAL.]

_____,
President (or other proper officer.)

STATE OF _____, }
 COUNTY OF _____ } ss:

Personally appeared before me, the undersigned, a Notary Public of the State of _____, residing at _____, in said State and County _____, who has signed the foregoing certificate, and made oath in due form of law that the matters and things therein set forth are true, and that he is the proper officer to sign the same.

Sworn to and subscribed before me, this _____ day of _____, 190—.

_____,
Notary Public.

[NOTARIAL SEAL.]

Note.—This form is prepared for the registration of a trademark when the applicant is a company or corporation. The same blank may be used by a person, firm, or association by striking out that portion of the form which relates only to incorporated companies or corporations. The law requires that two copies or fac-similes of the trademark or label to be filed with the application.

MASSACHUSETTS.

CHAPTER 72, REVISED LAWS.

Definitions.

Section 1. The following words shall, in addition to their ordinary meaning, have the meaning herein given:

The word "name" or "names" in sections two, three, six, ten, twelve, fourteen, fifteen, sixteen, eighteen, nineteen and twenty-one of this chapter includes "letters," "marks," "devices" and "figures."

The word "person" or "persons" in sections two, seven, nine, fourteen to twenty, inclusive, and twenty-three, includes "firm," "association," "union," and "corporation."

The word "boots" in section four includes "half boots," "shoes," "pumps," "sandals," "slippers" and "overshoes."

The word "label" or "labels" in sections six to twelve, inclusive, includes "trademark," "stamp" or "form of advertisement."

The word "beverage" or "beverages" in sections fifteen to eighteen, inclusive, includes also "milk," "cream," "soda water," "mineral" or "aerated waters," "ale," "beer," "ginger ale" or "similar beverages."

The word "vessel" or "vessels" in sections fifteen to eighteen, inclusive, includes "cans," "bottles," "siphons," "fountains" and "boxes."

The word "can" or "cans" in sections nineteen to twenty-three, inclusive, includes "jugs," "bottles" and "jars."

Labels and Trademarks.

Section 2. When a person uses any peculiar name upon or connected with an article manufactured or sold

by him to designate it as an article of a peculiar kind or quality, or as manufactured by him, no other person shall without his consent use the same or any similar name for the purpose of falsely representing an article to have been manufactured by or to be of the same kind or quality as those manufactured or sold by the person rightfully using such name.

Sec. 3. Whoever violates the provisions of the preceding section, and whoever knowingly sells or exposes for sale an article having a name upon or connected with it in violation of the provisions of the preceding section, shall be liable in an action of tort to any party aggrieved thereby for all damages actually incurred.

Sec. 4. Every manufacturer of leather or boots shall have the exclusive right of stamping the articles manufactured by him with his name and the name of the place of manufacture; and such stamping shall be considered as a warranty that the article stamped is merchantable, made of good materials and well manufactured; and such article shall not be considered merchantable unless so stamped.

Sec. 5. A person who carries on business in this commonwealth shall not assume or continue to use in his business the name of a person formerly connected with him in partnership or the name of any other person, either alone or in connection with his own or with any other name or designation, without the consent in writing of such person or of his legal representatives.

Sec. 6. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the use of names or labels in violation of the provisions of this chapter.

Sec. 7. Any person may adopt a label, not previously owned or adopted by any other person, and file such label for record, by depositing two copies or fac-similes thereof in the office of the secretary of the commonwealth, one of which copies or fac-similes shall be at-

tached by the secretary of the commonwealth to the certificate of record hereinafter referred to. The applicant shall file with the label a certificate specifying the name of the person so filing such label, his residence, situation or place of business, the kind of merchandise to which such label has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. If such label has not been and is not intended to be used in connection with merchandise, the particular purpose or use for which it has been or is intended shall be stated in the certificate. Such certificate shall be accompanied by a written declaration, verified under oath by the person, or by a member of the firm or by an officer of the association, union or corporation, by which it is filed, that the party so filing such label has a right to use the same, and that no other person has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the copies or fac-similes filed therewith are true. The secretary of the commonwealth shall issue to the person depositing such label a certificate of record, under the seal of the commonwealth, and the secretary shall cause the certificate to be recorded in his office. Such certificate of record or a certified copy of its record in the office of the secretary of the commonwealth, shall in all suits and prosecutions under the provisions of this section and of sections eight to fourteen, inclusive, be sufficient proof of the recording of such label and of the existence of the person named in the certificate. The fee for filing the certificate and declaration and issuing the certificate of record shall be two dollars. No label shall be recorded which could reasonably be mistaken for a label already on record.

Sec. 8. The secretary of the commonwealth is authorized to make regulations, and prescribe forms for the filing of labels, under the provisions of the preceding section.

Sec. 9. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the manufacture, use or sale of counterfeits or imitations of a label, recorded as provided in section seven, shall award damages resulting from such wrongful manufacture, use or sale and shall require the defendant to pay the owner of such label the profits derived from such wrongful manufacture, use or sale; and may also order that all such counterfeits or imitations in his possession or control be delivered to an officer of the court, or to the complainant to be destroyed. If the complainant is not incorporated, suits under the provisions of sections seven, eight and ten to fourteen, inclusive, may be commenced and prosecuted by an officer thereof, on behalf of and for the use of the complainant. Every member of a complainant firm, association or union shall be liable for costs in any such proceeding.

Sec. 10. Whoever knowingly makes or uses any counterfeit or imitation of any lawful name or label or causes the same to be made or used, or sells, offers for sale, deals in or has in his possession with intent to use, sell, offer for sale or deal in the same, or affixes, impresses or uses such counterfeit or imitation upon any goods, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Sec. 11. Whoever, with intent to defraud, knowingly casts, engraves or manufactures, or has in his possession, or buys, sells, offers for sale, or deals in, a die, plate, brand, mould, or engraving on wood, stone, metal or other substance, of a label recorded pursuant to the statutes of this commonwealth, or a printing press, or types or other tools, machines or materials provided or prepared for making a counterfeit or imitation of such label, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Sec. 12. Whoever knowingly sells or exposes for sale goods upon which any lawful name or label or any counterfeit or imitation thereof is unlawfully affixed, impressed, or used shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

Sec. 13. Whoever, with intent to defraud, knowingly aids or abets in the violation of any of the provisions of the seven preceding sections shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than six months, or by both such fine and imprisonment.

Sec. 14. In any suit or prosecution under the provisions of the five preceding sections, the defendant may show that he was the owner of such name or label prior to its being filed under the provisions of section seven, and that it has been wrongfully filed by some other person.

Note.—In a prosecution under this act, the recital in the certificate of adoption that the mark had been in use “since about the year 1888,” was held sufficient. *Commonwealth v. Rozen*, 176 Mass., 129, 57 N. E. Rep., 223.

§§ 15-23 relate to the protection of vessels used in the sale of beverages, and milk cans. Held to be a proper police regulation in *Commonwealth v. Anselvich*, 186 Mass. 376, 71 N. E. Rep. 790.

AN ACT to provide for registration of the insignia of societies, associations and labor unions, and to prohibit the unauthorized use thereof.

Be it enacted, etc., as follows:

Section 1. The insignia, ribbons, badges, rosettes, buttons and emblems of any society, association or labor union may be registered in the office of the secretary of the commonwealth in the manner and subject to the provisions, so far as they are applicable, set forth in section

seven of chapter seventy-two of the Revised Laws in regard to labels; and the secretary is hereby authorized to make regulations and prescribe forms for such registration.

Sec. 2. Whoever, not being a member of a society, association or labor union, for the purpose of representing that he is a member thereof, wilfully wears or uses the insignia, ribbon, badge, rosette, button or emblem thereof, if the same has been registered in the office of the secretary of the commonwealth, shall be punished by a fine of not more than twenty dollars, or by imprisonment for not more than thirty days, or by both such fine and imprisonment.

Sec. 3. Chapter four hundred and thirty of the acts of the year nineteen hundred and two and chapter two hundred and seventy-five of the acts of the year nineteen hundred and three are hereby repealed.

Approved May 13, 1904.

§ 4 of Chapter 462, Statutes 1895, is a penal section for using counterfeit trademarks upon cigars. Under this section when the defendants were shown to have a place of business within the state, a conviction was sustained in the absence of any proof as to where the defendants intended to sell the cigars bearing the counterfeit mark.

Commonwealth v. Rozen, 176 Mass. 129, 57 N. E. Rep. 223.

Pub. Stat. Chap. 76, § 1 providing that trademarks cannot be used without the consent of the owner, does not apply to a mark that is the name of a machine upon which there has been a patent, after the expiration of the patent.

Dover Stamping Co. v. Fellows, 163 Mass. 191, 40 N. E. Rep. 105.

§ 6, Chapter 76, Pub. Stat., forbidding any person to "assume or continue to use" in his business the name of a person formerly connected with him in partnership,

or the name of any other person "without written consent," does not apply to a person advertising himself as "formerly with" or "successor to" another.

Martin v. Bowker, 163 Mass. 461, 40 N. E. Rep. 766.

In a bill in equity brought by a labor union, under § 3, Chap. 462, Stat. 1895, it has been held immaterial that the defendant's use of the spurious label antedated the passage of the act.

Tracy v. Banker, 170 Mass. 266, 49 N. E. Rep. 308.

INSTRUCTIONS AND FORM FOR THE REGISTRATION OF TRADEMARKS.

COMMONWEALTH OF MASSACHUSETTS.

OFFICE OF THE SECRETARY.

The accompanying blank form of application is to be used for the registration of a label, trademark, stamp or form of advertisement in this office under the laws of this Commonwealth.

The regulations printed in small type upon said application are to be carefully followed and observed.

Two fac-similes of the label, trademark, stamp or form of advertisement, either in the press-printed form as used or hand-printed in India ink upon bond or other substantial paper (not card board), and the statute fee of two dollars for registration are to accompany the application.

Do not gum or fasten the fac-similes in any way to the application.

WM. M. OLIN,

Secretary of the Commonwealth.

COMMONWEALTH OF MASSACHUSETTS.

(Regulations printed below in small type must be strictly adhered to.)

Certificate accompanying a ———

(Insert the Designation, Insignia, Ribbon, Badge, Rosette, Button or Emblem as the case may be.)

filed for record in accordance with section 7 of chapter 72 of the Revised Laws, relative to the adoption and registration of Labels, and chapter 335 of the Acts of 1904, an Act to provide for registration of the Insignia of Societies, Associations and Labor Unions, and to prohibit the unauthorized use thereof.

Name of the Society, Association or Labor Union,———,

(If the Society, Association or Labor Union is a Voluntary Associa-

tion, state the fact. If a Corporation, state the fact, and name the State under the laws of which it is incorporated.)

Location, _____.

(Give city, or town and State.)

The particular purpose or use for which the _____

(Insert the Designation, Insignia, Ribbon, Badge, Rosette, Button or Emblem as the case may be.)

has been or is intended to be appropriated, _____.

(Give, in as few words as possible, the particular purpose or use for which the Insignia, Ribbon, Badge, Rosette, Button or Emblem has been or is intended to be utilized.)

The essential feature of the _____

(Insert the Designation, Insignia, Ribbon, Badge, Rosette, Button or Emblem, as the case may be.)

consists of _____

(Give only what is considered to be the essential feature or features of the Insignia, Ribbon, Badge, Rosette, Button or Emblem.)

The style and size of type or lettering, and color of ink and commodity _____

(Use the word *may* or the words *will not* as the case may be.)
be varied at pleasure.

Length of time, if any, during which the _____

(Insert the Designation, Insignia, Ribbon, Badge, Rosette, Button or Emblem, as the case may be.)

has been in use. Since _____

(Give Month, Day of Month and Year when adopted, or give date since when in use.)

*I, _____, do hereby declare in accordance with the provision of section 7 of chapter 72 of the Revised Laws, that _____ ha— a right to use the _____

(Insert the Designation, Insignia, Ribbon, Badge, Rosette, Button or Emblem, as the case may be.)

referred to in the foregoing certificate, and that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive and

I FURTHER DECLARE that the copies or fac-similes filed with the foregoing certificate are true.

In witness whereof I have hereto signed my name this _____ day of _____ in the year nineteen hundred and ____.

[Sign here.] _____

COMMONWEALTH OF MASSACHUSETTS.

—SS:

— 190—.

Then personally appeared the above-named — and made oath that the foregoing declaration by him subscribed is true.

Before me,

—, *Justice of the Peace.*

* This declaration is to be signed and sworn to by an officer of the Society, Association or Labor Union; insert name of officer, title of office, and name of the Society, Association or Labor Union. Outside of Massachusetts, oath is to be administered by a Commissioner for Massachusetts or Notary Public.

FORM OF FAC-SIMILES.

This application for registration is to be accompanied by two fac-similes, copies or counterparts of the Insignia, Ribbon, Badge, Rosette, Button or Emblem, in the printed or other durable form, in which such are used, or hand printed in India ink upon substantial paper (not cardboard).

Do not gum or fasten the fac-similes in any way to this application.

MICHIGAN.

§§ 11681-86, C. L. 1897.

AN ACT to provide for the protection of associations and unions of workingmen and artisans, or other persons in their Labels, Trade-marks, and Forms of Advertisement, and to punish the counterfeiting and fraudulent use of such labels, trademarks, and forms of advertising.

(11681) Section 1. That whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or

by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such labels, trademark, term, design, device or form of advertisement.

(11682) Sec. 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association; or who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be deemed

guilty of a misdemeanor, and shall be punished as hereinafter provided. In suits or proceedings for damage, or for equitable relief by or on behalf of any such person, association or union, on account of the violation of any provision of this act, it shall not be necessary to prove that such violation was knowingly or wilfully committed.

(11683) Sec. 3. Any person, whether a member of a firm or corporation, or otherwise, who shall violate any of the provisions of section one of this act, or who shall knowingly or wilfully violate any provision of section two of this act, shall be deemed to have committed a misdemeanor thereby, and on conviction thereof shall be punished by a fine of not less than ten nor more than one hundred dollars, or by imprisonment in the county jail for a period not exceeding ninety days, or by both such fine and imprisonment, in the discretion of the court.

(11684) Sec. 4. In action at law or proceedings in equity brought on behalf of any such association or union which is not incorporated, the same may be brought in the name of any member of such association or union, who has been duly authorized so to do by such association or union, but for the use and benefit of all of the members of such association or union: provided, that before commencing such action or proceeding the member so authorized shall file with the justice or clerk of such court a certificate of the president and secretary of such association or union, showing that such authority has been granted. Any criminal proceeding brought for a violation of any provision of this act, may be prosecuted by the authorized attorney of such association or union, in the court where originally commenced, but in such case the fees and compensation of such attorney shall be borne and paid exclusively by such association or union: provided, that nothing herein shall be deemed to prevent the prosecuting attorney from conducting any such prosecution, or the said authorized at-

torney of such association or union from deputizing a duly qualified attorney at law to appear in his stead.

(11685) Sec. 5. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section one of this act, shall file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac-similes thereof, with said secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months, or by both such fine and imprisonment. Said

secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be *prima facie* proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

(11686) Sec. 6. In no case shall the certificate from the secretary of state, obtained in conformity with the fifth section of this act, be assignable by the party to whom the same is issued.

§§ 5576-5680 page 1781, Vol. 2 C. L. 1897 relate to the protection of packages of manufacturers, bottlers, and vendors of soda water and other beverages.

FORM OF APPLICATION FOR REGISTRATION.

Sworn Statement accompanying a ———

(Insert the word Label, Trademark, Term, Design, Device or Form of Advertisement, as the case may be.)

filed in accordance with Act. No. 206 of the Public Acts of 1895, of Michigan.

* I, ———, do hereby declare that the ———

(Insert the word Label, Trademark, Term, Design, Device or Form of Advertisement, as the case may be.)

counterparts or fac-similes of which are filed herewith is filed on behalf of ——— that the particular class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated is ——— that the said ——— has the right to the use of the same and no other person, firm, association, union or corporation has the right to such use, either in the identical form, or in any such

near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed herewith are true and correct.

(Sign here.)

STATE OF _____ }
COUNTY OF _____ } ss:

On this _____ day of _____, A. D. _____, before me personally appeared the above named _____ and made oath that the foregoing statement by him subscribed is true.

* If a person, insert name; if a member of a company or firm, insert name and add the words "a member of the firm or co-partnership doing business under the name and style of," then give the company name, and add "composed of" giving names of the members; if an officer of an association, corporation, or union, insert name, title of office and name of the association, corporation or union.

MINNESOTA.

CHAPTER 122, GENERAL LAWS 1895.

TRADEMARKS.

AN ACT to amend an Act entitled an Act Relating to Labels, Trade-marks and Advertisements, and to Provide for Their Protection and the Punishment for Counterfeiting the Same or for Using Counterfeits of the Same. Approved April Seventeenth (17th.) being Chapter Twenty-four (24) of General Laws of Minnesota of 1893).

Be it enacted by the Legislature of the State of Minnesota:

Section 1. That section 1 of an act relating to labels, trademarks and advertisements, and to provide for their protection and the punishment for counterfeiting the same, or for using counterfeits of the same (being chapter twenty-four (24) of the General Laws of Minnesota of one thousand eight hundred ninety-three (1893), be,

and the same is hereby amended to read as follows, namely:

“Sec. 1. PROTECTION. Whenever any person, or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.”

Sec. 2. That section two (2) of the act above named be, and is hereby amended, to read as follows, namely:

“Sec. 2. PENALTY FOR COUNTERFEITING OR DEALING IN COUNTERFEITS. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement, or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor to which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods,

wares, merchandise, or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; shall be punished by a fine of not more than one hundred (\$100) dollars or by imprisonment for not more than three months."

Sec. 3. That section three (3) of said act be and the same is hereby amended so as to read as follows, namely:

"Sec. 3. REGISTRY. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use a label, trademark, term, design, device, or form of advertisement, as provided in section one (1) of this act, may file the same for record in the office of the secretary of state by leaving two copies, counterparts or fac-similes thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated; stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design or form of advertisement in the office of the secretary of state under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writ-

ing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred (100) dollars or by imprisonment not exceeding three (3) months. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one (1) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof to the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of state shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trade mark, term, design, device of form of advertisement theretofore filed by or in behalf of any other person, union or association."

Sec. 4. That section four (4) of said act be and is hereby amended to read as follows:

"Sec. 4. PROHIBITING INFRINGEMENTS. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union, all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all

such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed."

Sec. 5. That section five (5) of said act be and the same is hereby amended to read as follows:

"Sec. 5. PENALTY FOR APPROPRIATING. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three (3) months or by a fine of not more than one hundred (100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union."

Sec. 6. That section six (6) of this act may be and is hereby amended to read as follows:

"Sec. 6. PENALTY FOR UNAUTHORIZED USE. Any person who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three (3) months, or for a fine of not more than one hundred (100) dollars."

Sec. 7. This act shall take effect and be in force from and after its passage.

Approved February 23rd, 1895.

GEN. ST. 1894.

Section 6908. Any person or persons who shall knowingly and wilfully forge or counterfeit, procure to be forged or counterfeited, any representation, likeness,

similitude, copy or imitation of the private stamps, brands, wrapper, label or trademark, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to and upon the goods, wares, merchandise or preparation of said mechanic, manufacturer, druggist, merchant or tradesman, with intent to pass off any work, goods, manufacture, compound or preparation, to which such forged or counterfeited representation, likeness, similitude, copy, or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, compound or preparation of such mechanic, manufacturer, druggist, merchant or tradesman, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period [of] not less than six months, nor more than twelve months, or fined not more than five thousand dollars.

Sec. 6909. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, have in his or their possession any die or dies, plate or plates, brand or brands, engraving or engravings or printed labels, stamps, imprints, wrapper, or trademarks, or any representation, likeness, similitude, copy or imitation of the private stamps, imprint, brand, wrapper, label, or trademark usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to or upon articles made, manufactured, prepared or compounded by him or them, for the purpose of making impressions or selling the same when made, or using the same upon any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, manufactures, preparations or compounds of any other person or persons, body corporate or politic, or who shall wrongfully and fraudulently sell or use the genuine stamp, brand, imprint, wrapper, label or trademark, with intent to pass off any goods, wares, merchandise, mixtures, compounds

or other articles not the manufacture of the person or persons, body corporate or politic, to whom such stamp, brand, imprint, wrappers, label or trademark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six months, nor more than twelve months, or be fined not more than five thousand dollars.

Sec. 6910. Any person who shall vend or keep for sale any goods, wares, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels or trademarks shall be placed or affixed, and intended to represent the said goods, wares, merchandise, mixture or preparation as the genuine goods, wares, merchandise, mixture or preparation of any other person or persons, knowing the same to be counterfeit, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by a fine not exceeding five hundred dollars in each case so offending, and shall also be liable in a civil action to the person or persons whose goods, wares, merchandise, mixture or preparation is counterfeited or imitated, or whose stamps, brands, imprints, wrappers, labels, or trademarks are forged, counterfeited, placed or affixed, for all damages such person or persons may or shall sustain by reason of any of the acts in this section mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or performing any of the acts above mentioned.

Sec. 6911. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, knowingly affix or cause to be affixed to or upon any bottle, case, box or package containing any goods, manufacture, mixture, preparation or compound, any stamp, brand, label, wrapper, imprint or trademark, which shall designate such goods, manufacture, mixture, preparation or compound, either wholly or

in part, the same to the eye or in sound to the ear, as the word or words, or some of the words, used by any other person or persons for designating any goods, manufacture, mixture, preparation or compound manufactured or prepared by or for such other person or persons, or who shall knowingly sell or expose, or offer for sale, any such bottle, case, box or package, with any such stamp, brand, label, wrapper, imprint or mark affixed to or upon it, shall, provided such person or persons so affixing or causing to be affixed any such stamp, brand, label, wrapper, imprint or mark, or to selling or exposing, or offering for sale, any such bottle, case, box or package, shall not have been the first to employ or use such words, to designate, wholly or in part, any goods, manufacture, mixture, preparations or compound, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six nor more than twelve months, or be fined not more than five thousand dollars, and shall also be liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

Sec. 6912. Any person or persons who, with intent to defraud, or to enable another to defraud, any person, shall manufacture or knowingly sell, or cause to be manufactured or sold, any article or articles, marked, stamped or branded, or incased or inclosed in any box, bottle or wrapper having thereon any engraving or engravings, or printed labels, stamps, imprints, marks, or trademarks, which article or articles are not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving or engravings, printed labels, stamps, imprints, marks or trademarks, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and for such offense shall forfeit and pay a fine of two hundred dollars, to be recovered, with

costs, in a civil action to be prosecuted by the county attorney, of any county in the state, in the name of the county in which said action shall be commenced, and the one-half of such recovery shall be paid to the informer, and the residue shall be applied to the support of the poor in the county where such recovery is had.

Sec. 6913. A "trademark" is a mark used to indicate the maker, owner or seller of any goods, wares, merchandise, mixture, preparation or compound, and includes, among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label, or other mark lawfully adopted by him and usually affixed to any goods, merchandise mixture, preparation or compound to denote the same was imported, manufactured, produced, sold, compounded bottled, packed or otherwise prepared by him.

Sec. 6914. A trademark is deemed to be affixed to any goods, wares, merchandise, mixture, preparation or compound when it is placed in any manner in or upon either—

(1) The article itself; or

(2) A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing, in, by, or with which the goods are packed, inclosed or otherwise prepared for sale or disposition.

Sec. 6915. An imitation of a trademark, stamp, brand, wrapper, or label is that which so far resembles the genuine trademark, stamp, brand, wrapper or label as to be likely to induce the belief that it is genuine, either by the use of words or letters similar in appearance or in sound, or by any sign, device, or the names whatsoever.

Sec. 6916. No testimony or evidence given by any person in any civil action to which such person may be a party, or by any other witness in such action, or on

any reference or proceeding which may be had in such action, nor any evidence or testimony derived from the books or papers of such party or witness, produced by him as witness, or otherwise, in such action, or on any reference or other proceedings which may be had therein, can or shall be used in any criminal prosecution against such party or witness, under any of the provisions of this act; nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this act.

Minnesota also has an act entitled "An act to protect the owners of receptacles used in the sale of soda waters, mineral or aerated water, porter, ale, cider, ginger ale, small beer, large beer, Weiss beer, beer, white beer, malt extracts, other beverages, milk, cream, ice cream and butter," approved April 19, 1905.

The statutory penalty for the infringement of a trademark can only be recovered where the fraudulent intent of the defendant is shown.

Watkins v. Landon, 52 Minn., 389, 54 N. W. Rep. 193.

MISSISSIPPI.

ANN. CODE 1892.

Section 1306. Every person who shall knowingly and wilfully forge or counterfeit, or cause or procure to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrappers, or labels usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares, or merchandise whatsoever, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by a fine not exceeding five hundred dollars, or imprisonment in the

county jail not less than three months nor more than one year.

Sec. 1307. Every person who shall have in his possession any die, plate, engraving, or printed label, stamp, or wrapper, or any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label usually affixed by any mechanic or manufacturer to and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares or merchandise, with intent to use or sell the said die, plate, or engraving, or printed stamp, label, or wrapper, for the purpose of aiding or assisting in any way whatever in vending any goods, wares, or merchandise in imitation of, or intended to resemble and be sold for the goods, wares, or merchandise of such mechanic or manufacturer, shall be guilty of a misdemeanor, and, upon conviction, be punished by fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

Sec. 1308. Every person who shall vend any goods, wares, or merchandise, having thereon any forged or counterfeit stamp or label, imitating, resembling, or purporting to be the stamp or label of any mechanic or manufacturer, knowing the same to be forged or counterfeited, and resembling or purporting to be imitations of the stamps or labels of such mechanic or manufacturer, without disclosing the fact to the purchaser thereof, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by imprisonment in the county jail not exceeding three months, or by a fine not less than fifty nor more than five hundred dollars, or both.

MISSOURI.

CHAPTER 169, REVISED STATUTES, 1899.

SECTION 10365. Any person may adopt a trademark—to be registered.

SEC. 10366. Penalty for counterfeiting trademarks.

SEC. 10367. Penalty for using false die, brand, etc.

SEC. 10368. Penalty for keeping or selling goods with false brands.

SEC. 10369. Penalty for affixing false labels, etc., with intent to defraud.

SEC. 10370. What courts have jurisdiction.

SEC. 10371. Articles bearing false trademarks to be destroyed.

SEC. 10372. What evidence can not be used in criminal prosecution.

SECTION 10365. ANY PERSON MAY ADOPT A TRADEMARK—TO BE REGISTERED.—If any mechanic, manufacturer, association or union of workingmen, or other person, shall wish to adopt any particular name, term, design or device as his or their trademark, to designate, make known or distinguish any article of goods, wares or merchandise by him or them manufactured or prepared, he or they may write out a description of such name term, design or device, describing the same accurately, and sign and acknowledge the same before some officer competent to take the acknowledgment of deeds, and file the same, together with a fac-simile of the name, term, design or device for registration in the office of the secretary of state, by leaving two copies, counterparts or fac-similes thereof, with the secretary of state; said secretary shall deliver to such mechanic, manufacturer, association or union of workingmen or other person so filing the same, a duly attested certificate of the filing of the same, for which he shall receive a fee of one dollar; such certificate shall in all suits and prosecutions under this chapter, be sufficient proof of the adoption of such label trademark or form of advertisement, and of the right of such mechanic, manufacturer, association or

union of workingmen or other person to adopt the same. No label, trademark or form of advertisement shall be registered that in any way resembles, or would probably be mistaken for a label or trademark already registered. (R. S. 1889, § 8569, amended, Laws 1893, p. 260; amended, Laws 1903, p. 275.)

SEC. 10366. PENALTY FOR COUNTERFEITING TRADE-MARKS.—Any person or persons, association or union of workingmen, who shall knowingly and wilfully make, forge or counterfeit any representation, likeness, similitude, copy or imitation of the private label, stamp, brand, wrapper, engraving, mould or trademark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, person or body corporate, association or union of workingmen, or body politic to, upon or used in connection with the goods, wares, merchandise, compound or preparation of such manufacturer, mechanic, merchant, tradesman, druggist, person, association or union of workingmen, or body corporate or politic, with intent to pass off any goods, wares, merchandise, compound or preparation, to which said forged or counterfeit representation, likeness, similitude, copy or imitation is affixed, or in connection with which the same may be used or intended to be so affixed or used, as the work, goods, wares, implements, merchandise, compound or preparation of such manufacturer, mechanic, merchant, druggist, tradesman, person, association or union of workingmen, or body corporate or politic, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period of not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment. (R. S. 1889, § 8570, amended Laws 1893, p. 260.)

SEC. 10367. PENALTY FOR USING FALSE DIE, BRAND, ETC.—Any person or persons, association or union of work-

ingmen, who shall, with intent to defraud any person or persons, or body corporate or politic, have in his, her or their possession any die or dies, plate or plates, brand or brands, engraving or engravings, printed labels, stamps, imprints, moulds, wrappers or trademarks, or any representation, likeness, similitude, copy or imitation of the private label, brand, stamp or wrapper, engraving, mould or trademark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, association or union of workingmen, person or body corporate or politic, to, upon or used in connection with articles made, manufactured, prepared or compounded by him, her or them, for the purpose of making impressions, or selling the same when made, or using the same upon or in connection with any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, wares, implements, merchandise, compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, or who shall in fact sell or use the same, or for the purpose of secreting the same from the rightful owner or owners, or who shall wrongfully or fraudulently use the genuine label, brand, stamp, wrapper, imprint, engraving, mould or trademark, with intent to pass off any goods, wares, implements, merchandise, compound or preparation, or other article not the manufacture of the person, persons, association or union of workingmen, or body corporate or politic, to whom such label, brand, stamp, wrapper, engraving, imprint, mould or trademark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such

fine and imprisonment. (R. S. 1889, § 8571, amended, Laws 1893, p. 260.)

SEC. 10368. PENALTY FOR KEEPING OR SELLING GOODS WITH FALSE BRANDS.—Any person, persons, association or union of workingmen, or body corporate or politic, who shall vend or keep for sale any goods, wares, merchandise, compounds or preparations upon which or in connection with which any forged, imitation or counterfeit label, brand, stamp, wrapper, imprint, engraving, bottle or trademark shall be placed, affixed or used, and intended to represent the said goods, wares, implements, merchandise, compounds or preparations as the genuine goods, wares, implements, merchandise compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, knowing the same to be imitation or counterfeit, shall be deemed guilty of a misdemeanor, and, upon conviction thereof, shall be punished by a fine of not less than one hundred dollars nor more than five thousand dollars, or by imprisonment in the county jail not less than one month nor more than twelve months, or both, and shall also be liable to a civil action to the person or persons, association or union of workingmen, or body corporate or politic, whose goods, wares, implements, merchandise, compounds or preparations is imitated or counterfeited, or whose label, stamp, wrapper, engraving, imprint, bottle, or trademark is imitated; forged or counterfeited, placed, affixed or used, for all damages such person or persons, association or union of workingmen, or body corporate or politic, may or shall sustain, both by virtue of the loss of profits and the damage done to the reputation of the said genuine article, goods, wares, implements, merchandise, compound or preparation, by reason of any of the acts in any section of this chapter mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or perform-

ing any of the acts herein mentioned. (R. S. 1889, § 8572, amended, Laws 1893, p. 260.)

SEC. 10369. PENALTY FOR AFFIXING FALSE LABELS, ETC., WITH INTENT TO DEFRAUD.—Any person or persons who shall, with intent to defraud any person or persons, association or union of workingmen, or body corporate or politic, knowingly affix or cause to be affixed to or upon any case, box, web, package or bottle containing any goods, wares, merchandise, compound or preparation, any label, brand, stamp, wrapper, engraving, imprint or mark which shall designate such goods, wares, merchandise, compound or preparation, either wholly or in part by a word or words, or by general design, which shall be wholly or in part the same to the eye, or in sound to the ear, as the word or words or the general design used by any person or persons, association or union of workingmen, or body corporate or politic, for designing any goods, wares, merchandise, compound or preparation, manufactured or prepared by or for some other person or persons, association or union of workingmen, or body corporate or politic, or who shall knowingly sell or expose or offer for sale any such case, box, web, package, or bottle, with any such label, brand, stamp, wrapper, engraving, imprint or mark affixed to or upon it, shall, provided such person or persons affixing or causing to be affixed any such label, brand, stamp, wrapper, engraving, imprint or mark or so selling or offering for sale any such case, box, web, package or bottle, shall not have been the first to employ or use such word or words or general design to designate, wholly or in part, any goods, wares, merchandise, compound or preparation, and upon conviction thereof be deemed guilty of a misdemeanor, and shall be liable to the party aggrieved in the penal sum of five hundred dollars, and for a further sum equal to the amount which the aggrieved party might have received for the same amount of genuine goods, wares, merchandise, com-

pounds or preparations, and shall be guilty of a misdemeanor, and on conviction may be punished by imprisonment in the county jail for a period of not less than one month nor more than twelve months or fined not less than one hundred dollars, nor more than five thousand dollars, or both such fine and imprisonment. (R. S. 1889, § 8573, amended, Laws 1893, p. 260.)

SEC. 10370. WHAT COURTS HAVE JURISDICTION.—All courts of this state having jurisdiction of criminal cases shall have jurisdiction of proceedings for violation of this chapter. All suits brought under this chapter shall be brought by the person or persons injured or defrauded by such parties; and if brought by any association or union of workingmen, the suit may be brought in the name of the president and secretary, to the use and benefit of association or corporation, and may thus sue and be sued. (R. S. 1889, § 8574, amended, Laws 1893, p. 260.)

SEC. 10371. ARTICLES BEARING FALSE TRADEMARKS TO BE DESTROYED.—It shall be the duty of any officer within the jurisdiction of the court having authority, to whom there shall be delivered any warrant for the arrest of any person alleged to have committed any offense created by this chapter, to seize any and all goods, wares, merchandise, compounds, preparations, labels, brands, implements, stamps, wrappers, imprints, engravings, plates, bottles, dies or moulds, mentioned or referred to in the complaint, or affidavit or information, upon which said warrant issued, and upon final conviction of the offender, the court shall direct such of same as may be counterfeit to be destroyed, and they shall be so destroyed accordingly: *Provided, however,* That if said property consists of wares and merchandise, which, in the judgment of the court, are independent of any trademark, of genuine and intrinsic value, and capable of being applied to a useful and beneficial purpose, then and in such case all counterfeit words, marks, wrappers,

labels, emblems, stamps, brands, bottles, imprints and signs used in connection therewith shall be first erased, obliterated and destroyed, and said property shall be sold within ten days next succeeding the decision of the court thereon, in such manner as the court shall direct, and the proceeds of said sale, less the expense thereof, be applied to the benefit of the school fund of the county in which said seizure was effected. (R. S. 1889, § 8575, amended, Laws 1893, p. 260.)

SEC. 10372. WHAT EVIDENCE SHALL NOT BE USED IN CRIMINAL PROSECUTIONS.—No testimony or evidence given by any person in any civil action to which said person may be a party, or by any other witness in such action, or in any reference or proceeding which may be had in such action, nor any testimony or evidence derived from the books or papers of such party or witness, or otherwise, in such action, or in any reference or other proceeding which may be had therein, can or shall be asked in any criminal prosecution against such party or witness, under any of the provisions of this chapter, nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this chapter. (R. S. 1889, § 8576, amended, Laws 1893, p. 260.)

§§ 2270-2274, Revised Statutes 1899, provide for the protection of boxes and other receptacles, used by manufacturers of bottles, bottlers, manufacturers of and dealers in mineral waters, soda waters, and other beverages, the description of the names, marks, or designations to be recorded with the recorder of deeds of the county or city. § 2274 contains provisions for search warrants in such cases.

Under § 10369 an information which sets out and contains a copy of the defendant's label, and of the label which the defendant's label is alleged to imitate, and which alleges that the defendant's label imitates the

other "in part" but does not state what part of the one is an imitation of the other, is fatally defective.

State v. Thierauf, 167 Mo. 429, 67 S. W. Rep. 292.

An information in a prosecution for selling cigars in boxes bearing a counterfeit union label, in which a genuine union label was pasted, was approved in *State v. Niesmann*, 101 Mo. App. 507, 74 S. W. Rep. 638.

An act of 1893, for the protection of union labels has been held not to be in violation of Article 4, § 53 of the Constitution of Missouri; and that to sustain a conviction, guilty knowledge by the defendant must be shown.

State v. Bishop, 128 Mo. 373, 31 S. W. Rep. 9.

The early act against counterfeiting trademarks (Wag. St. p. 1330) was held to be designed for the protection of trademarks, regardless of the citizenship of their owners. It might, therefore, be invoked in a prosecution based upon a trademark owned by a citizen of another country.

State v. Gibbs, 56 Mo. 133.

FORMS OF APPLICATION FOR REGISTRATION.

FORM FOR CORPORATION.

Know all men by these presents:

That the ———, a corporation duly organized and existing under the laws of the State of ———, and having its office in the City of ——— said State, desiring to avail itself of the provisions of chapter 169, Revised Statutes of 1899, and more particularly of section 10,365 thereof, as amended in 1903, has adopted for its use a trademark to designate, make known or distinguish a certain article of goods, ware or merchandise by it manufactured or prepared, of which the following is a description:

the essential feature ——— of which ——— the ———, as applied to ———; and that the fac-similes presented herewith are true and correct copies thereof.

In testimony whereof, the said corporation has caused this instrument to be signed by its ——— and the seal of said corporation to be hereto attached, at the City of ———, State of ———, this ——— day of ———, 190—.

[SEAL.]

_____,
(President or other duly authorized officer.)

STATE OF ———, }
COUNTY OF ——— } ss:

On this ——— day ———, 190—, before me appeared ———, to me personally known, who, being by me duly sworn did say that he is the ——— of the said ———, a corporation, and that the seal affixed to the foregoing instrument is the corporate seal of said corporation, and that said instrument was signed and sealed in behalf of said corporation by authority of its board of directors, and said ——— acknowledged said instrument to be the free act and deed of said corporation, for the purpose therein stated.

In testimony whereof, I have hereunto set my hand and affixed my seal at my office in the City of ——— the day and year last above written.

My commission expires ———.

Notary Public.

FORM FOR INDIVIDUALS OR PARTNERSHIPS.

Know all men by these presents:

That I, ———, residing in the City of ———, State of ———, have adopted for my use a trademark to designate, make known or distinguish a certain article of goods, wares or merchandise by me manufacturer or prepared, of which the following is a description: the essential feature ——— of which ——— the ———, as applied to ———; and that the fac-similes presented herewith are true and correct copies thereof.

In testimony whereof, I have hereunto set my hand at the City of ———, State of ———, this ——— day of ———, 190—.

STATE OF ———, }
COUNTY OF ——— } ss:

On this ——— day of ———, 190—, before me personally appeared ———, to me known to be the person described in and who executed the foregoing instrument, and acknowledged that he executed the same as his free act and deed.

In testimony whereof, I have hereunto set my hand and affixed my seal at my office in the City of ——— the day and year last above written. My commission expires ———.

Notary Public.

Note.—The application for registration must be executed in duplicate. In other words, two originals.

MONTANA.

POLITICAL CODE.

Section 3161. Any person may record any trademark or name, by filing with the Secretary of State his claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by an officer authorized to take acknowledgments of conveyances, setting forth that he or the firm or corporation of which he is a member, is the exclusive owner, or agent of the owner of such trademark or name.

Sec. 3162. The Secretary of State must keep for public examination a record of all trademarks or names filed in his office, with the date when filed and the name of the claimant, and must not record any two like trademarks or names. He must at the time of filing and recording a trademark or name, collect from the claimant a fee of three dollars.

Approved Feb. 25, 1899.

PENAL CODE.

§ 642. Every person who shall use any counterfeit or imitate any label, trademark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor.

(§ 642. Act approved March 6, 1895.)

§ 643. Every such person, association or union that heretofore adopted, or shall hereafter adopt, a label, trademark or form of advertisement as aforesaid may file the same for record in the office of the Secretary of State, by leaving two copies, counterparts or fac-similes thereof with the Secretary of State; said secretary shall deliver to such person, association or union filing the

same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded, that, probably, would be mistaken for a label already of record.

(§ 643. Act approved March 6, 1895.)

NEBRASKA.

COMPILED STATUTES 1901.

Section 6810. If any person shall falsely make, alter, forge, counterfeit, print or photograph * * * any private stamp, brand, wrapper, label, or trademark, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman to or upon the goods, wares, merchandise, preparation or mixture of such mechanic, manufacturer, druggist, merchant, or tradesman; * * * with intent to damage or defraud any person or persons, body politic or corporate, or any military body organized under the laws of this state; or shall utter or publish as true and genuine, or cause to be uttered and published as genuine and true, or shall have in his possession with intent to utter and publish as true and genuine, any of the above named false, altered, forged, counterfeited, falsely printed, or photographed matter above specified and described, knowing the same to be false, altered, forged, counterfeited, falsely printed, or photographed, with intent to prejudice, damage or defraud any person or persons, body politic or corporate. Every person so offending shall be imprisoned in the penitentiary for any space of time not exceeding twenty years

nor less than one year, and pay fine not exceeding five hundred dollars.

Sec. 6811. If any person shall have in his possession any die or dies, plate or plates, brand or brands, engraving, imprint, printed labels, wrappers, or any other instrument, thing or means whatever with intent therewith or thereby to falsely make, forge, or counterfeit any matter specified in the last preceding section, or to cause or enable the same to be done; or shall have in his possession any such falsely made, forged, or counterfeited matter whether the same be completed or only partly executed, for the purpose of bartering, selling, or disposing thereof, knowing the same to be falsely made, forged or counterfeited, with intent thereby to prejudice, damage or defraud any person or persons, body politic or corporate, every person so offending shall be imprisoned in the penitentiary not less than six months nor more than ten years, and pay a fine not exceeding one thousand dollars.

Sec. 6814. Any person who shall vend or keep for sale any goods, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels, or trademarks be placed or affixed, and intended to represent the said goods, merchandise, mixture or preparation, as the true and genuine goods, merchandise, mixture or preparation of any person or persons, knowing the same to be counterfeit, shall be punished by a fine not exceeding one hundred dollars.

§§ 6922, 6926, are directed to the protection of casks, barrels, kegs, bottles and boxes, used in the handling of soda water, mineral water and other beverages.

§§ 3549, 3553, relate to the protection of the labels of trade unions and their registration with the Secretary of State.

NEVADA.

COMPILED LAWS, 1900.

AN ACT concerning trademarks and names. Approved March 8, 1865, 268.

5040. SECTION 1. UNLAWFUL TO IMITATE.—When a person who has complied with the provisions of section two of this act, uses any particular name, letters, marks, device, figures or other trademark or name, cut, stamped, cast or engraved upon, or in any manner attached to or connected with any article, or with the covering or wrapping thereof, manufactured or sold by him, to designate it as an article of a peculiar kind, character, or quality, or as an article manufactured or sold by him, or if such trademark or name be so connected with any bottle, box, cask, or other thing used for holding such article, it shall be unlawful for any other person, without his consent to use said trademark or name, or any similar trademark or name, for the purpose of representing any article to have been manufactured or sold by the person rightfully using such trademark or name, or to be of the same kind, character, or quality as that manufactured or sold by the person rightfully using such trademark or name.

5041. SEC. 2. CLAIM FILED.—Any person wishing to secure the exclusive use of any such trademark or name under the provisions of this act, shall file his claim to the same, and a copy or description of such trademark or name, with the Secretary of State.

5042. SEC. 3. FEE FOR FILING.—The Secretary of State shall keep a record of all trademarks or names filed in his office with the date when filed and name of claimant, for public examination. A fee of five dollars shall be paid to the Secretary of State at the time of filing

each copy and description of any trademark or name, by the party claiming the use and benefit of the same. It is hereby made the duty of the Secretary of State to pay all fees accruing under this section into the State Library Fund. (As amended, Statutes 1893, page 80, reducing charge of filing and recording trademarks and names from \$20 to \$5.)

5043. SEC. 4. Any person violating the provisions of the first section of this act shall be guilty of a misdemeanor, and on conviction thereof shall be punished by a fine of not less than twenty-five dollars, nor more than five hundred dollars or by imprisonment in the county jail for not less than five days, nor more than thirty days, or by both such fine and imprisonment; and he shall be further liable to any party aggrieved by such violation for all damages actually incurred, to be recovered as a debt in any court of competent jurisdiction.

5044. SEC. 5. It shall be unlawful for any person to counterfeit any trademark or name, or to have or use a counterfeit trademark or name, or sell any article bearing or having in any way connected with it a counterfeit trademark or name, which has been filed according to section two of this act, knowing it to be such, or having good and sufficient reason to know it to be such. Every alteration or imitation of any trademark or name which has been filed according to section two of this act which shall be made, applied, or used, or which shall cause any trademark or name, with such alterations or imitations, to resemble any genuine trademark or name, so as to be calculated or likely to deceive, shall be deemed to be a counterfeit trademark or name within the meaning of this act and every act of making, applying, or otherwise using any such alteration or imitation as aforesaid, done by any person, such person shall be deemed to be guilty of counterfeiting a trademark or name, or knowingly using a counterfeit trademark or name, within the meaning of this act. Every person violating the provisions of this

section shall be guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section four of this act.

5045. SEC. 6. Every person who shall have or use any cask, bottle, vessel, case, cover, label, or other thing, bearing or having in any way connected with it the trademark or name of another, which has been filed according to section two of this act, for the purpose of disposing of any article with intent to deceive or defraud, other than that which said cask, bottle, vessel, case, cover, label, or other thing originally contained, or was connected with by the owner of said trademark or name, shall be guilty of a misdemeanor, and on conviction thereof shall be punished as provided in section four of this act.

5046. SEC. 7. Every person who shall knowingly, aid, or abet, or counsel in, or procure the commission of any offense which is by this act made a misdemeanor, shall be deemed and held to be guilty of a misdemeanor, and shall be subject to the penalties provided in section four of this act.

5047. SEC. 8. This act shall not be so construed as to permit any person to file, without authority from the owner, any trademark or name owned, or previously used by another person, nor in any way to interfere with, hinder, prevent, or restrain the importation or sale, by any person, of genuine articles of merchandise having, or belonging thereto, genuine trademarks or names manufactured or sold in other states or countries.

5048. SEC. 9. Any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, shall be considered its original owner, and the ownership may be transferred in the same manner as personal property, and shall be entitled to the same protection by suits at law as other personal property.

5049. SEC. 10. Every person filing with the secretary of state as provided in section two of this act, his claim to any trademark or name, shall have attached to the copy and description thereof his affidavit, duly certified to by any officer authorized by the laws of this state to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member) is the exclusive owner or agent of the accompanying trademark or name.

5050. SEC. 11. Any court of competent jurisdiction may restrain, by injunction, any use of trademarks or names in violation of any section of this act.

5051. SEC. 12. No person otherwise competent as a witness, shall be disqualified or excused from testifying as a witness, either before a grand jury or a petit jury or otherwise, concerning any offense mentioned in this act, on the ground that his testimony may criminate himself, but such testimony shall be reduced to writing, and no indictment or prosecution shall afterward be brought against him for said offenses, concerning which he has testified as a witness.

5052. SEC. 13. Any witness called to give testimony on behalf of the state, before any grand jury, or before any court of justice shall be required to give such testimony, which shall be reduced to writing, and such witness shall not be liable to suffer any punishment or forfeiture for any offense against the provisions of this act so disclosed.

NEW HAMPSHIRE.

LAWS 1895, CH. 42.

AN ACT to protect associations and unions of workingmen and persons in their labels, trademarks and forms of advertising, and the owners of literary, dramatic and musical compositions, and works of art in their property.

Be it enacted by the Senate and House of Representatives in General Court convened:

SECTION 1. Whenever any person, association, or union of workingmen have adopted, or shall hereafter adopt, for their protection, any label, trademark, or form of advertisement announcing that goods to which such label, trademark, or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark, or form of advertisement. And whenever any person, firm, association, or corporation is the owner of any literary, dramatic or musical composition and the right of the author pertaining thereto, and such composition has not been copyrighted, printed or published, or of any map, chart, engraving, cut, print, photograph, or negative thereof, statue, statuary, model, or design, which has not been copyrighted or offered for sale, it shall be unlawful for any other person, firm, association, or corporation to publish, produce, print, or sell or offer to sell the same without first obtaining the consent of the owner thereof.

SEC. 2. Every person who shall use any counterfeit or imitation of any label, trademark, or form of advertisement of any such person, union, or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished as provided in section 7 of this act.

SEC. 3. Every such person, association or union that has heretofore adopted or shall hereafter adopt, a label, trademark, or form of advertisement, as aforesaid, may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac-similes thereof with the secretary of state; and the secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall, in all suits and prosecutions under this act, be *prima facie* proof of the adoption of such label, trademark, or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

SEC. 4. Every such person, association or union adopting a label, trademark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and such person, association, or union shall be entitled to such damages resulting from such wrongful manufacture, use, display or sale, as may be deemed just and reasonable, and the supreme court shall also order that all counterfeits or imitations in the possession or under the control of the defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

SEC. 5. Every person who shall use or display the genuine label, trademark, or form of advertisement of any such person, association, or union in any manner not authorized by such person, association, or union, shall be deemed guilty of a misdemeanor, and shall be punished as provided in section 7 of this act. In all cases where such association or union is not incorporated, suits under this act may be commenced and prose-

cuted by any officer or member of such association or union in behalf of and for the use of such association or union.

SEC. 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable as provided in the succeeding section.

SEC. 7. Any violations of any of the provisions of this act shall be punished by imprisonment in the county jail for a term of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

FORM OF APPLICATION FOR REGISTRATION.

To the Honorable, the Secretary of State:

Sworn application accompanying —

BE IT KNOWN, That — has heretofore adopted and used a certain — and herewith files the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary, and by filing therewith this sworn application:

(1) The name of the person so filing such — is —.

(2) The class of merchandise upon which the same has been used is — and a particular description of the goods comprised in such class is —.

(3) Said — has been used by applicant since —.

(4) Said — and consists of — the essential feature of which —

STATE OF —, }
COUNTY OF — } ss:

I, —, being first duly sworn, depose and say that I am —, the applicant herein, and make this affidavit and verification in — behalf. That I have read the above and foregoing application and know the contents thereof, and that the facts set out therein are true; that said — so filing said — has the right to the use of the same and that no other person, firm, association, union, corporation, or organization has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to de-

ceive, and that the two copies, counterparts or fac-similes, filed herewith are true and correct.

Subscribed and sworn to before me this _____ day of _____, 190—.

Fees \$ _____ enclosed.

NEW JERSEY.

LAWS 1898. CHAPTER 50.

AN ACT to provide for the registration of labels, trademarks, terms and designs, and protect and secure the rights, property and interests therein of the persons, associations, organizations and corporations adopting and filing the same.

Be it enacted by the Senate and General Assembly of the State of New Jersey:

1. It shall be lawful for any person, association, organization or corporation to adopt for their protection and file for registry, or cause to be filed for registry, as herein provided any label, trademark, term or design that has been used or is intended to be used for the purpose of designating, making known or distinguishing any goods, wares, merchandise or products of labor that have been or may be wholly or partly made, manufactured, produced, prepared, packed or put on sale by any person, association, organization or corporation, or to or upon which any work or labor has been applied or expended by any person or by any member or members of any association, organization or corporation that has adopted and filed for registry, or that may adopt and file for registry, any such label, trademark term, or design as aforesaid, or announcing or indicating that the same have been made in whole or in part by any such person, association, organization or corporation or by any member or members thereof.

2. Whenever any person, association, organization or corporation shall adopt and file for registry, or cause to

be adopted and filed for registry, any label, trademark, term, or design pursuant to the provisions of this act, the property, privileges, rights, remedies and interests in and to any such label, trademark, term or design, and in and to the use of the same, provided or given by this act to, or otherwise conferred upon or enjoyed by, the person, association, organization or corporation filing the same, or causing the same to be filed for registry, shall be fully and completely secured, preserved and protected as the property of those entitled to the same, before any such label, trademark, term or design has been actually applied to any goods, wares, merchandise or product of labor and put upon the market for sale or otherwise, and before any use or appropriation of any such label, trademark, term or design has been made in connection with any such goods, wares, merchandise or product of labor, as well as after the same has been used or applied to designate, make known or distinguish any such goods, wares, merchandise or product of labor and they have been put upon the market.

3. Any person, association, organization or corporation that has heretofore adopted and used, or shall hereafter adopt and use, any label, trademark, term or design as herein provided, may file the same for registry in the office of the secretary of state by leaving two copies, facsimiles or counterparts thereof, with the said secretary, and filing therewith a statement in the form of an affidavit, subscribed and sworn to by any such person, or by any officer, agent or attorney of any such association, organization or corporation, specifying the person, association, organization or corporation by whom, or on whose behalf, any such label, trademark, term or design is filed, and the class or character of the goods, wares, merchandise or product of labor to which the same has been, or is intended to be, appropriated or applied, and that the person, association, organization or corporation so filing the same, or on

whose behalf the same is so filed, has the right to the use of said label, trademark, term or design, and that no other person, firm, association, organization or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, without the permission or authority of the person, association, organization or corporation filing the same, or causing the same to be filed, and that the copies, fac-similes or counterparts filed therewith are true and correct copies, fac-similes or counterparts of the genuine label, trademark, term or design of the person, association, organization or corporation filing the same or causing the same to be filed; and there shall be paid for such filing and registry a fee of one dollar to the secretary of state for the use of the state.

4. The secretary of state, upon the filing of any such label, trademark, term, or design that is not in conflict with the next section hereof, shall register the same, and shall deliver to the person, association, organization or corporation filing the same, or causing the same to be filed, as many certified copies thereof, with his certificate of such registry, as any such person, association, organization or corporation may request, and for every such copy and certificate there shall be paid to the secretary of state, for the use of the state, a fee of one dollar; and any such certified copy and certificate shall be admissible in evidence and competent and sufficient proof of the adoption, filing and registry of any such label, trademark, term or design by any such person, association, organization or corporation, in any action or judicial proceeding in any of the courts of this state, and of due compliance with the provisions of this act; *Provided, however,* that such certificate shall not be assignable or transferable by the person, association, organization or corporation to whom the same is issued by the secretary of state.

5. It shall not be lawful for the secretary of state to register, or permit to be registered, for any person, association, organization or corporation any label, trademark, term or design that is in the identical form of any other label, trademark, term or design theretofore filed by or on behalf of any other person, association, organization or corporation, or that bears any such near resemblance thereto as may be calculated to deceive, or that would be liable to be mistaken therefor; and any person, association, organization or corporation who shall file or procure the filing and registry of any label, trademark, term or design in the office of the secretary of state, under the provisions of this act, by making any false or fraudulent representations or declarations, with fraudulent intent, shall be liable to pay any damages sustained in consequence of any such registry, to be recovered by or on behalf of the party injured thereby, in any court of law of this state having jurisdiction in civil causes.

6. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, term or design, or cause the same to be done, as herein provided, and the same shall have been registered pursuant to this act, it shall be unlawful, and a violation of this act, for any other person, association, organization or corporation to manufacture, use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trademark, term or design; or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor to which or on which any counterfeit or imitation of any such label, trademark, term or design is attached, affixed, printed, painted, stamped, impressed or displayed; or to sell or dispose of, or offer to sell or dispose of, or have in possession with intent that the same shall be sold or dis-

posed of, any goods, wares, merchandise or product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed.

7. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, term or design as herein provided, it shall be unlawful, and a violation of this act, for any other person or persons, association, organization or corporation, to make any use, sale, offer for sale or display of the genuine label, trademark, term or design of any such person, association, organization or corporation, filing the same; or to have any such genuine label, trademark, term or design in possession with intent that the same shall be used, sold, offered for sale or displayed, or that the same shall be applied, attached or displayed in any manner whatever to or on any goods, wares or merchandise; or to sell, offer to sell, or dispose of or have in possession with intent that the same shall be sold or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trademark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; or to make any use whatever of any such genuine label, trademark, term or design, without first obtaining in every such case, the license, consent or authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be adopted, filed and registered; and any such license, consent or authority may be revoked and terminated at any time upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof.

8. It shall be lawful for any person, association, organization or corporation that has adopted and filed, or caused to be filed and recorded or registered in the office of the secretary of state, at any time before the passage of this act, any label, trademark, term or design, to refile the same for registration by the secretary of state pursuant to the provisions of this act, upon payment of the fees herein provided for filing and registering any label, trademark, term or design, and for copies and certificates thereof, and any person, association, organization or corporation so refiling any such label, trademark, term or design shall have and be entitled to all the rights, remedies, privileges and protection given by this act to any person, association, organization or corporation originally filing any label, trademark, term or design under the provisions of this act and subject to the same liabilities.

9. The court of chancery shall have jurisdiction in all cases arising or commenced therein under this act for the violation of any of the provisions thereof; and any person, association, organization or corporation filing, or causing to be filed, for registry, any label, trademark, term or design pursuant to the provisions of this act, shall have the right to an action in the said court against any person or persons, association, organization or corporations, for the violation of any of the provisions of this act; and upon the filing of any bill of complaint therefor, the law and practice regulating proceedings in that court shall be applicable thereto; and the said court is hereby empowered and required to enjoin the manufacture, counterfeiting, imitation, display, use, sale, offer of sale, circulating or uttering of any counterfeit or imitation of any such label, trademark, term or design of any such person, association, organization or corporation; and the sale or disposal of any goods, wares, merchandise or product of labor to which, or on which, any such counterfeit or imitation label, trademark, term or

design is attached, affixed, printed, painted, stamped, impressed or displayed; or any goods, wares, merchandise or product of labor contained in any box, case, can or package to or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed; and further to enjoin the manufacture, use, sale, offer of sale, or display, of any genuine label, trademark, term or design of any such person, association, organization or corporation filing the same as aforesaid; or having in possession any such genuine label, trademark, term or design with intent that the same shall be used, sold, offered for sale or displayed, or the same applied, attached or displayed in any manner whatever to or on any goods, wares, merchandise or product of labor; or the selling or offer to sell or dispose of, or having in possession with intent that the same shall be sold, offered for sale or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trademark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; and from making any other, or any, use whatever of any such genuine label, trademark, term or design, without having first obtained, in any and every such case, the consent and authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be filed and registered, as herein provided; and the said court of chancery is hereby empowered to make such other orders and direct such other proceedings as the court may deem necessary and proper for the due protection of the rights of complainants, effecting the purposes of this act, the prevention of any violation of any of the provisions of the same; and secure and protect any and all persons, associations, organizations or corporations in all the rights, privileges, property and interests to which they or any of them are or may be entitled in

any such label, trademark, term or design under any of the provisions of this act or otherwise; and it shall be the duty of the said court of chancery to award to the complainant or complainants in any such action any and all damages resulting from any such wrongful use of any such label, trademark, term or design by any defendant or defendants, or for any violation of any of the provisions of this act; and to require any such defendant or defendants to pay to such complainants any and all such damages, together with all costs and expenses incurred by any such complainant in any such action or proceeding; and the said court shall also order and decree that the defendants pay to the complainant or complainants any and all profits obtained, received or derived from any such wrongful use or any violation of the provisions of this act; or both profits and any such damages, and that any and all such counterfeits or imitations of any such labels, trademarks, terms or designs in the possession or under the control of the defendant or defendants in any such action shall be delivered up to an officer of the court, or to the complainant, to be destroyed, and that any such genuine labels, trademarks, terms or designs in the possession or under the control of any such defendant or defendants shall be delivered up to the complainant.

10. That, in addition to any other rights, remedies or penalties provided by this act, and as concurrent therewith, any person or persons, association, organization or corporation that shall violate any of the provisions of this act shall be liable to a penalty of not less than two hundred and not more than five hundred dollars, to be recovered in an action of debt in any court of law of this state having jurisdiction in civil causes, by any such person, association, organization or corporation that has adopted and filed, or caused the same to be done as aforesaid, any such label, trademark, term or design; which action may be commenced by summons as in ordi-

nary cases, and shall be proceeded with therein as ordinary cases in said court; and in case any execution shall be issued upon any judgment obtained against the defendant or defendants in any such action and the same be returned unsatisfied, the court, on application and two days' notice to the defendant, may award an execution to take the body of the defendant or defendants as in other cases where a *capias* may issue out of the circuit or supreme courts of this state; and thereafter the rights, remedies and liabilities of the parties, and the proceedings in the case shall be the same, or as nearly as may be, as in other actions in said courts where an execution to take the body of the defendant or defendants has been issued; and it shall be the duty of the court in which any such action may be brought to make all proper and necessary orders to restrain and prevent any defendant or defendants from continuing the committing of any violation of any of the provisions of this act.

11. In any suit or proceeding in equity, or in any action at law, brought by or on behalf of any such association or organization that is not incorporated, for any violation of any of the provisions of this act, the same may be brought in the recognized name of any such association or organization, or in the proper name of the president or the secretary or the treasurer of any such association or organization who has been or may be given authority to bring any action or actions for or in behalf of any such association or organization, and if for any reason such authority is not given before the commencement of any such suit or action, the same may be given thereafter at any time before the trial of the same; and any such suit in equity or action at law may be brought as aforesaid in the recognized name of any branch or local or sub-association, affiliated or connected with any national or international association or organization, or in the name of the president,

or the secretary, or the treasurer thereof; and such authority to bring the same may be given by any board of directors, executive board, or executive committee, of any such association or organization, elected, chosen, or appointed by any such association or organization; and any such person or persons bringing any such action or proceeding in any court of law or equity in this state shall have the right to receive any and all moneys, property or other valuable thing recovered by or adjudged to the complainant or plaintiff in any such suit or action, for the use and benefit of the association or organization entitled to the same; and whenever any such suit or action shall be brought by or on behalf of any such branch or local or sub-association or organization as herein provided instead of by or on behalf of any such national or international association or organization, such branch or local or sub-association bringing the same shall be entitled to the same rights, privileges, remedies and advantages, in the prosecution of such suit or action, as any other party or parties authorized by this act to bring such suit or action would have been entitled to if any such suit or action had been brought by them, or in their behalf, as herein provided.

12. This act shall be construed by all courts at all times, in all suits, actions and proceedings, in the most liberal manner for effecting the objects and purposes thereof and protecting the claims, rights, interests, use and property of every person, association, organization or corporation in and to any label, trademark, term or design, filed and registered pursuant to the provisions of this act.

13. All acts and parts of acts contrary to, or inconsistent with the provisions of this act, be and the same are hereby repealed.

14. This act shall be deemed and taken to be a public act, and shall take effect immediately.

Passed March 15th, 1898.

In an action to recover penalties under § 6 of this act it is not necessary to show guilty knowledge by the defendant. *Cigar Makers' International Union of America v. Goldberg*, 57 Atl. Rep. 141.

The act is constitutional. *Ibid.*

§ 10 of this Act imposing a penalty of not less than two hundred dollars, and not more than five hundred dollars, permits the plaintiff in an action for its recovery to elect and fix the amount for which the suit shall be brought within these limits.

State v. Schmidt, 48 Atl. Rep. 588.

The Acts passed in 1889, 1892 and 1895, for the protection of the labels, trademarks and forms of advertising of associations or unions of workingmen, were held not to be unconstitutional, and not in violation of Article 4, § 7, paragraph 11 of the Constitution of New Jersey, forbidding the passage of private, local or special laws, granting to any association, corporation, or individual, any special privilege, immunity, or franchise whatever.

Schmalz v. Wooley, 57 N. J. Eq. 303, 41 Atl. Rep. 939.

An Act of February 21, 1854, supplemented March 25, 1863, relating to the protection of packages of manufacturers of mineral waters, and other beverages, and prescribing a penalty for the unauthorized use thereof, did not apply to junk dealers who had registered bottles on their premises.

Bowden v. Randolph Tp., 41 N. J. Law, 462.

In the Act of March 11, 1891, for the protection of manufacturers and bottlers of mineral waters and the like, several offenses are specified. It has been held, that in a complaint under this Act, no statement of demand is required; and that a complaint is defective which charges, in the alternative, the commission of one or another of several of the specified offenses.

Brant v. Froelich, 49 N. J. Law, 336, 8 Atl. Rep. 283.

NEW MEXICO.

AN ACT providing for the registration of tradenames, trademarks, and labels.

Be it enacted by the Legislative Assembly of the Territory of New Mexico:

Section 1. Any person or persons, firm, corporation or association who manufacture or deal in articles of a commercial nature and wish to retain the exclusive right to the use of a tradename, trademark or label shall make a description of the same in writing, accompanied by a *fac-simile* of such tradename, trademark or label, which description and application must set forth the class or classes of merchandise to be covered by such tradename, trademark or label, together with a statement that the applicant claims by priority of adoption and employment of the same exclusive right to the use thereof. Such instrument shall be signed by at least one of the persons or by the officials of the Company making application for registration, the whole duly acknowledged, and filed in the office of the Secretary of the Territory. For the filing of each application and issuing certificate thereof, the Secretary shall collect a fee of \$5.00. The Secretary shall keep a record of each tradename, trademark or label, and it shall be unlawful for any other person, firm, corporation or association to adopt a tradename, trademark or label identical with or similar to one previously registered. A copy of such description of any tradename, trademark or label, certified under the Great Seal of the Territory of New Mexico, shall be *prima facie* evidence of the facts therein stated.

Sec. 2. The proprietor of each tradename, trademark or label shall cause the same to be plainly marked, printed, stamped or branded upon each article or original package covered by the same.

Sec. 3. It shall be unlawful for any person or persons, firm, corporation or association to use or refill any barrel, sack, package or bottle bearing any registered tradename, trademark, or label with any article for purposes of deceit.

Sec. 4. It shall be unlawful for any person or persons, firm, corporation or association to make, forge or counterfeit any tradename, trademark or label previously registered in accordance with this act; have in his or their possession, except with written permission of the owner thereof, any die, stamp, stencil or model of such tradename, trademark or label; vend or keep for sale any drugs, goods, wares or merchandise intended to represent the drugs, goods, wares or merchandise covered by such tradename, trademark or label, or affix any general design identical with or similar to such tradename, trademark or label when not the first to employ or use the same.

Sec. 5. Any person or persons, firm, corporation or association violating the provisions of sections 3 or 4 of this act shall be deemed guilty of misdemeanor and shall be subject to a fine in a sum not less than \$50.00 nor more than \$200.00 for each offense, at the discretion of the court, together with damages as they may appear.

Sec. 6. The provisions of this act, in so far as they may be applicable, are hereby extended to any person or persons, firm, corporation or association, who may have registered a tradename, trademark or label in good faith prior to the passage of this act, and this act shall be in force and effect from and after its passage.

Chap. 24, Laws 1905. Approved March 2, 1905.

NEW YORK.

Chap. 376, Laws of 1896, contains the following section:

§ 28. Trademarks. Any person engaged in manufacturing, bottling, or selling any beverage, medicine, perfumery or mixture in this state, put up by him for sale in any vessel or receptacle, with his name or other private mark branded, stamped or marked thereupon, may file in the office of the secretary of state and in the office of the county clerk of the county where the same is manufactured, bottled, or put up for selling, a description of the name or other private mark so branded, stamped, or marked thereupon, and publish the same once a week, for at least three weeks successively, in a newspaper published in said county, except in New York and Kings, where such publication shall be for the same length of time daily in two newspapers therein, and he shall thereupon be deemed the proprietor of such name or mark and of every vessel or receptacle upon which it may be branded, stamped or placed. No person, other than such proprietor, shall fill for any purpose, any such vessel or receptacle so branded, stamped or marked or from which any such brand, stamp, mark, name or device has been removed, defaced or obliterated, nor remove, deface or obliterate the same, or place other brands, stamps, marks, names or devices upon any such vessel or receptacle without the written permission of such proprietor, or unless there has been a sale to such person of such vessel or receptacle, exclusive of the contents thereof, by such proprietor.

No person other than such proprietor, shall, without his permission, use, traffic in, purchase, sell, dispose of, convert, mutilate, destroy or wilfully or unreasonably refuse to return or deliver to such proprietor on de-

mand, any such vessel or receptacle so branded, stamped or marked belonging to such proprietor.

Any person violating any provision of this section shall forfeit to such proprietor one hundred dollars for each such violation.

Possession of any such vessel or receptacle without the consent of the proprietor of the trademark thereupon shall be presumptive evidence of such violation.

§ 29 of this Act imposes a penalty for using milk cans without the consent of the owner, when such cans are marked with the initials of the owner and makes possession of any such cans presumptive evidence of unlawful usage. In sustaining a judgment for the penalty imposed by the Act, the possession and use of the can by the defendant was held to be continuous violation of the statute, and that the cause of action was not barred by sub-division 3, § 383, Code of Civil Procedure.

Bell v. Gibson, 75 N. Y. Supp. 753.

The Act of May 27, 1896 (Chap. 933, Laws of 1896) is as follows:

§ 1. Any and all persons and corporations engaged in manufacturing, bottling or selling soda waters, mineral or aërated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages or medicines, medical preparations, perfumery, oils, compounds or mixtures, in bottles, siphons, tins or kegs, with his, her, its or their name or names, or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, siphons, tins or kegs, or the boxes used by him, her, it or them, may file in the office of the clerk of the county in which his, her, its or their principal place of business is situated, or if such person, persons, corporation or corporations shall manufacture or bottle out of this state, then in any county in this state, and also in the office of the secretary of state, a description of the name or names, marks or devices so

used by him, her, it or them, respectively, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed as aforesaid, except that in the city and county of New York and the city of Brooklyn, in the county of Kings, such publication shall be made twice in each week, for three weeks successively, in two daily newspapers published in the cities of New York and Brooklyn, respectively.

§ 2. It is hereby declared to be unlawful for any person or persons, corporation or corporations to fill with soda water, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or with medicine, medical preparations, perfumery, oils, compounds or mixtures, any bottle, box, siphon, tin or keg so marked or distinguished as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section one of this act, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the bottle, box, siphon, tin or keg so filled, trafficked in, used or handled as aforesaid. Any person or persons, or corporation or corporations offending against the provisions of this section shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment for not less than ten days nor more than one year, or by a fine of fifty cents for each and every such bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, and for each

subsequent offense by imprisonment for not less than twenty days nor more than one year, or by a fine of not less than one dollar, nor more than five dollars, for each and every bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried.

§ 3. The use by any person, other than the person or persons, corporation or corporations, whose device, name or mark shall be or shall have been upon the same without such written consent or purchase as aforesaid, of any such marked or distinguished bottle, box, siphon, tin or keg, a description of the name, mark or device, whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or any article of merchandise, medicines, medicinal preparations, perfumery, oils, compounds, mixtures or preparations, or for the furnishing of such or similar beverages to customers, or the buying, selling, using, disposing of or trafficking in any such bottles, boxes, siphons, tins or kegs by any person other than said persons or corporations having a name, mark or device thereon of such owner without such written consent, or the having by any junk dealer or dealers in second-hand articles, possession of any such bottles, boxes, siphons, tins or kegs, a description of the marks, names or devices, whereon shall have been so filed and published as aforesaid, without such written consent, shall and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such bottles, boxes, siphons, tins or kegs.

§ 4. Whenever any person, persons or corporation mentioned in section one of this act, or his, her, its or their agent shall make oath before any magistrate that he, she or it has reason to believe, and does believe,

that any of his, her, its or their bottles, boxes, siphons, tins or kegs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled, or had, by any person or corporation manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicine, medical preparations, perfumery, oils, compounds or mixtures, or that any junk dealer or dealer in second-hand articles, vender of bottles, or any other person or corporation has any such bottles, boxes, siphons, tins or kegs in his, her or its possession, or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such bottles, boxes, siphons, tins or kegs may be found, and shall then inquire into the circumstances of such possession, and if such magistrate finds that such person has been guilty of a violation of section two of this act, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof.

§ 5. The requiring, taking or accepting of any deposit, for any purpose, upon any bottle, box, siphon, tin or keg shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act.

§ 6. Any person or persons, corporation or corporations, that has or have heretofore filed in the offices mentioned in section one of this act a description of the name or names, mark or devices upon his, her, their or its property, therein mentioned, and has caused the same to be published according to the law existing at the time of such filing and publication shall not be required to again file and publish such description to be entitled to the benefits of this act.

The Act of May 3, 1904, is as follows:

Section 1. Any and all persons and corporations engaged in manufacturing, freezing, preserving or selling ice cream, confectionery, charlotte russe, cakes and jellies, with his, her, its or their name or names or other marks or devices, branded, stamped, engraved, stenciled, blown, impressed or otherwise produced upon the freezers, cans, blocks, moulds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs used by him, her, it or them, may file in the office of the clerk of the county in which his, her, its or their principal place of business is located, or, if such person, persons, corporation, or corporations, shall manufacture or sell out of this state, then in any county in this state, and also in the office of the secretary of state, a description of the name or names, marks or devices, so used by him, her, it or them, respectively, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed, as aforesaid, except that in the city and county of New York, and the city of Brooklyn, in the county of Kings, such publication shall be made twice in each week, for three weeks successively, in two daily newspapers published in the cities of New York and Brooklyn respectively.

§ 2. It is hereby declared to be unlawful for any person or persons, corporation or corporations, to make use of, for similar or other purposes, any such freezers, cans, blocks, moulds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs so marked or distinguished, as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section one of this act, or to deface, erase, obliterate, cover up or otherwise remove or conceal, any such name, mark or device thereon, or to sell, buy,

give, take or otherwise dispose of or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the said freezers, cans, blocks, moulds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs trafficked in, used or handled as aforesaid. Any person or persons, corporation or corporations offending against the provision of this section, shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment not less than ten days nor more than one year, or by a fine of three dollars for each and every such article named and described in section one, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than five dollars nor more than ten dollars for each and every such article named and described in section one, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried.

§ 3. The use by any person other than the person or persons, corporation or corporations, whose device, name or mark shall be or shall have been upon the same without such written consent or purchase as aforesaid, of any such article named and described in section one, a description of the name, mark or device whereon shall have been filed and published as herein provided, for similar or other purposes, or the buying, selling, using, disposing of, or trafficking in any such article named and described in section one, by any person other than said persons or corporations having a name, mark or device thereon of such owner, without such written consent, or the having by any junk dealer or dealers in sec-

ond-hand articles, possession of any such article, named and described in section one, a description of the marks, names or devices, whereon shall have been so filed and published as aforesaid, without such written consent, shall, and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such freezers, cans, blocks, moulds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs.

§ 4. Whenever any person, persons or corporation mentioned in section one of this act, or his, her, its or their agent, shall make oath before any magistrate, that he, she, or it, has reason to believe, and does believe, that any of his, her, its or their freezers, cans, blocks, moulds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used for similar or other purposes, or that any junk dealer or dealer in second-hand articles, or any other person or corporation, has any such article as named and described herein, in his, her or its possession, or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such articles as named and described herein may be found, and shall then inquire into the circumstances of such possession, and if such magistrate finds that such person has been guilty of a violation of section two of this act, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof.

§ 5. The requiring, taking or accepting of any deposit, for any purpose, upon any freezer, can, block, mould, tray, brick, pan, tank, pail, tub, keg, refrigerator, box, spoon, cutlery, glass, china, chair, table or sign,

shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act.

§ 6. Any person or persons, corporation or corporations, that has or have heretofore filed in the offices mentioned in section one of this act, a description of the name or names, mark or devices upon his, her, their or its property, therein mentioned, and has caused the same to be published according to the law existing at the time of such filing and publication, shall not be required to again file and publish such description to be entitled to the benefits of this act.

Ch. 415, Laws of 1897, contains the following sections:

§ 15. **Labels, brands, etc., used by labor organizations.** A union or association of employes may adopt a device in the form of a label, brand, mark, name or other character for the purpose of designating the products of the labor of the members thereof. Duplicate copies of such device shall be filed in the office of the Secretary of State, who shall, under his hand and seal, deliver to the union or association filing or registering the same a certified copy and a certificate of the filing thereof, for which he shall be entitled to a fee of one dollar.

§ 16. **Illegal use of labels, et cetera, a misdemeanor; injunction proceedings.**—A person who, (1) shall in any way use or display the label, brand, mark, name or character, adopted by any such union or association as provided in the preceding section, without the consent or authority of such union or association; or (2) shall counterfeit or imitate any such label, brand, mark, name or other character, or knowingly sells or disposes or keeps or has in his possession with intent to sell or dispose of, or keeps or has in his possession with intent to sell, or dispose of any goods, wares, merchandise or other products of labor contained in any box, case, can, or package, to which, or on which any such counterfeit or imitation is attached, affixed, printed, painted,

stamped or impressed, is guilty of a misdemeanor, and shall be punished by a fine of not less than one hundred dollars, nor more than five hundred dollars, or by imprisonment for not less than three months nor more than one year, or by both such fine and imprisonment.

The Penal Code contains the following provisions (Penal Code, 1901):

§ 364. A person who, knowingly, in a case where provision for the punishment for the offense is not otherwise specially made by statute:

1. Falsely makes or counterfeits a trademark; or,
2. Affixes to any article of merchandise, a false or counterfeit trademark, knowing the same to be false and counterfeit, or the genuine trademark, or an imitation of the trademark of another, without the latter's consent; or,
3. Sells, or keeps, or offers for sale, an article of merchandise, to which is affixed a false or counterfeit trademark, or the genuine trademark, or an imitation of the trademark of another, without the latter's consent; or,
4. Has in his possession a counterfeit trademark, knowing it to be counterfeit, or a die, plate, brand, or other thing for the purpose of falsely making or counterfeiting a trademark; or,
5. Makes or sells, or offers to sell or dispose of, or has in his possession with intent to sell or dispose of, an article of merchandise with such a trademark as to appear to indicate the quantity, quality, character, place of manufacture or production, or persons manufacturing or producing the article, but not indicating it truly; or,
6. Who knowingly sells, offers or exposes for sale, any goods which are represented in any manner, by word or deed, to be the manufacture or product of any person, firm or corporation, other than himself, unless such goods are contained in the original packages and under the labels, marks or names placed thereon by the

manufacturer who is entitled to use such marks, names, brands or trademarks; or,

7. Who shall sell, or expose for sale, any goods in bulk, to which no label or trademark shall be attached, and shall by representation, name or mark written or printed thereon, represent that such goods are the production or manufacture of a person who is not the manufacturer; is guilty of a misdemeanor.

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§ 365. The expression "article of merchandise," as used in this title, signifies any goods, wares, work of art, commodity, compound, mixture or other preparation or thing, which may be lawfully kept or offered for sale.

§ 366. A "trademark" is a mark used to indicate the maker, owner or seller of an article of merchandise, and includes among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label or other mark, lawfully adopted by him, and usually affixed to an article of merchandise to denote that the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him; and also a signature or mark used or commonly placed by a painter, sculptor or other artist, upon a painting, drawing, engraving, statue or other work of art, to indicate that the same was designed or executed by him.

§ 367. A trademark is deemed to be affixed to an article of merchandise when it is placed in any manner in, or upon, either

1. The article itself; or,

2. A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label or other thing, in, by or with which the goods are packed, enclosed or otherwise prepared for sale or disposition.

§ 368. An "imitation of a trademark" is that which so far resembles a genuine trademark as to be likely to induce the belief that it is genuine, whether by the use of words or letters similar in appearance or in sound, or by any sign, device or other means whatsoever.

§ 369. **Refilling or selling stamped mineral water bottles, platters, et cetera.**—Any person engaged in making, bottling, packing, selling or disposing of milk, ale, beer, cider, mineral water or other beverage or in making, selling, or disposing of articles of pastry, may register his title as owner of a trademark by filing with the secretary of state and the clerk of the county where the principal place of business of such person is situated, a description of the marks and devices used by him in his business, and in case same has not been heretofore published according to the laws existing at the time of publication, causing the same to be published in a newspaper of the county, three weeks daily, if in the city of New York or Brooklyn, and weekly if in any other part of the state; but no trademark shall be filed which is not and cannot become a lawful trademark, or which is merely the name of a person, firm or corporation unaccompanied by a mark sufficient to distinguish it from the same name when used by another person. After such registration, the use without the consent of the owner of the trademark so described or the filling of any bottle, siphon, barrel, platter, vessel, or thing for the purpose of sale, or for the sale, therein, of any article of the same general nature and quality which said bottle, siphon, barrel, platter, vessel or other thing before contained, without the obliteration or defacement of the trademark upon it, when such trademark can be obliterated or defaced without substantial injury to the bottle, siphon, barrel, platter, vessel or other thing so as to prevent its wrongful use, shall be deemed a misdemeanor.

Section 370. **Keeping such bottles, platters, et cetera, with intent to refill or sell them.**—Any person engaged

in the business of buying and selling bottles, siphons, barrels, platters, or other vessels or things, who shall with intent to defraud the registered owner of the trademark, knowingly sell or offer for sale any bottle, siphon, barrel, platter, vessel, or other thing, to any person, who he has reason to believe wrongfully intends to use the trademark upon it, or to fill such bottle, siphon, barrel, platter, vessel or other thing in violation of section three hundred and sixty-nine, shall be deemed guilty of a misdemeanor.

Section 371. Search for bottles, platters, et cetera.—Whenever a registered owner of a trademark, or his agent, makes oath before a magistrate that he has reason to believe and does believe, stating the grounds of his belief, that a bottle, siphon, barrel, platter, vessel or other thing to which is affixed a trademark belonging to him is being used or filled, or has been sold or offered for sale, by any person whomsoever, in violation of the preceding section, then the magistrate may issue a search warrant to discover the thing and cause the person having it in possession to be brought before him and may thereupon inquire into the circumstances, and if on examination, he finds that such person has been guilty of the offense charged, he may hold the offender to bail to await the action of the grand jury, and the offender shall also be liable to an action on the case for damages, for such wrongful use of such trademark at the suit of the owner thereof, and the party aggrieved, shall also have his remedy according to the course of equity to enjoin the wrongful use of his trademark, and to recover compensation therefor, in any court having jurisdiction over the person guilty of such wrongful use.

Section 438. False labels.—A person who, with intent to defraud, either

1. Puts upon an article of merchandise, or upon a cask, bottle, stopper, vessel, case, cover, wrapper, package, band, ticket, label or other thing, containing or cov-

ering such an article, or with which such an article is intended to be sold, or is sold, any false description or other indication of or respecting the kind, number, quantity, weight or measure of such article, or any part thereof, or the place or country where it was manufactured or produced or the quality or grade of any such article, if the quality or grade thereof is required by law to be marked, branded, or otherwise indicated on or with such article; or

2. Sells or offers for sale an article, which to his knowledge is falsely described or indicated upon any such package, or vessel containing the same, or label thereupon, or any of the particulars specified; or

3. Sells or exposes for sale any goods in bulk to which no name or trademark shall be attached, and orally or otherwise represents that such goods are the manufacture or production of some other than the actual manufacturer or producer, in a case where the punishment for such offense is not specially provided for otherwise by statute; is guilty of a misdemeanor.

§ 438a. **Using false marks as to manufacture.**—A person who, with intent to defraud or to enable another to defraud any person, manufacturers or knowingly sells or causes to be manufactured or sold, any article, marked, stamped or branded, or encased or enclosed in any box, bottle or wrapper, having thereupon any engraving or printed label, stamp, imprint, mark or trademark, which article is not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving, printed label, stamp, imprint, mark or trademark, is guilty of a misdemeanor.

As to search warrants under § 369, Penal Code 1893, see *People v. Hogan*, 29 N. Y. St. 110. For further rulings under that section see *Mullins v. People*, 23 How. Pr. 289, 24 N. Y. 399. *People v. Cannon*, 139 N. Y. 32, 34 N. E. Rep. 759.

Chapter 219, Laws 1893, relates to the protection of labels of unions or associations of workingmen, and provides a penalty for selling cigars bearing a counterfeit label. In an action for the recovery of this penalty, it was held that knowledge, or intent to injure or defraud were not ingredients in the offense prohibited, and that allegations of the knowledge, or intent to injure or defraud should be treated as surplusage.

Bulena v. Newman, 31 N. Y. Supp. 449. See also *Perkins v. Heert*, 158 N. Y. 306, 53 N. E. Rep. 18.

A conviction under § 364, penal code, was sustained where the defendant printed a label containing a trademark at the solicitation of the agent of the owner of the trademark.

People v. Gluckman, 70 N. Y. Supp. 173.

In sustaining a conviction under the same section, it was held to be immaterial that the prosecutor knew that he was purchasing counterfeit goods.

People v. Hilfman, 70 N. Y. Supp. 621.

In sustaining another conviction under this section, the court of appeals similarly held that it was no defense that the Act relied on for conviction was done at the instance of the prosecutor.

People v. Krivitzky, 168 N. Y. 182, 61 N. E. Rep. 175.

Where the plaintiffs had filed a certificate pursuant to § 363, penal code, setting forth their intention to do business under the name "American Watchman Clock Co.", and subsequently prepared to incorporate under that name, and the defendant having knowledge of the facts, and to forestall the plaintiff's proposed incorporation, thereupon incorporated under the same name, injunction was granted upon the ground of unfair competition.

Pettes v. American Watchman's Clock Co., 85 N. Y. Supp. 900.

That one who is convicted of counterfeiting or imitat-

ing a stamp, wrapper, or label is also liable to civil damages, See *Brown v. Mercer*, 37 N. Y. Super. Ct. 265.

Laws of 1887, Chap. 377, § 2, as amended by laws of 1888, Chap. 181, made it unlawful to use boxes, bottles, and other packages having the owner's name, or other marks or devices, "branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, etc."

It was held that the use of bottles bearing lithographic labels containing the name of another was not a violation of this act.

People v. Elfenbein, 20 N. Y. Supp. 364.

A section of the same act making it a misdemeanor to re-fill registered stamped bottles of the manufacturers of soda water, and the like, was held to apply only to dealing in empty bottles after the original contents had been removed.

People v. Cannon, 139 N. Y. 32, 34 N. E. Rep. 759.

Under the laws of 1862, Chap. 306, § 4, and laws of 1863, Chap. 209, § 2, relating to the use of false stamps, labels, or trademarks, and providing a penalty therefor, it was held essential to a recovery of the penalty that the fraudulent intent of the defendant be shown.

Low v. Hall, 47 N. Y. 104.

Under the Union Label Act, Laws 1893, Chap. 219, certain evidence is reviewed and held not sufficient to sustain a judgment for plaintiff in *Higgins v. Dakin*, 33 N. Y. Supp. 890, 86 Hun, 461.

Laws of 1887, Chap. 377, amended by laws of 1888, Chap. 181, relating to the registration of marks used on bottles, it is required that the certificate filed with the County Clerk, describing the names, marks and devices used on the bottles be certified. Consequently, such a description is admissible in evidence, though defectively acknowledged.

People v. Bartholf, 66 Hun, 626, 20 N. Y. Supp. 782.

Directions for Registration Applications.

The Secretary of State has published the following directions, concerning applications for registration under the foregoing statutes:

Under either of these provisions a statement in writing should be made by the person, firm, organization or corporation showing the adoption of the name, mark, label, brand or device, to which should be appended an affidavit verifying the same.

This should be filed in the Secretary of State's office and (except under Chapter 415, Laws of 1897) in the office of the proper County Clerk, followed with the publication in a newspaper where required by either of the foregoing laws.

The fee of this office for filing a statement under either of the preceding laws is one dollar.

This office has no blank forms.

NORTH CAROLINA.

AN ACT to provide for registration of labels, trademarks and designs.

The General Assembly of North Carolina do enact:

SECTION 1. It shall be lawful for any person or corporation to adopt for their protection and file for registry, or cause to be filed for registry, as herein provided, any label, trademark, term or design that has been used or is intended to be used for the purpose of designating, making known or distinguishing any goods, wares, merchandise or products of labor that have been or may be wholly or partly made, manufactured, produced, prepared, packed or put on sale by any person or corporation, or to or upon which any work or labor has been applied or expended by any person, or by any member or members of any corporation that has adopted and

filed for registry, or that may adopt and file for registry, any such label, trademark, term or design as aforesaid, or announcing or indicating that the same have been made in whole or in part by any such person or corporation, or by any member thereof.

SEC. 2. Whenever any person or corporation shall adopt and file for registry, or cause to be adopted and filed for registry, any label, trademark, term or design pursuant to the provisions of this act, the property, privileges, rights, remedies and interests in and to any such label, trademark, term or design, and in and to the use of same, provided or given by this act to, or otherwise conferred upon or enjoyed by, the person or corporation filing the same, or causing the same to be filed, for the registry, shall be fully and completely secured, preserved and protected as the property of those entitled to the same before any such label, trademark, term or design has been actually applied to any goods, wares, merchandise, or product of labor, and put upon the market for sale or otherwise, and before any use or appropriation of any such label, trademark, term or design has been made in connection with any such goods, wares, merchandise or product of labor, as well as after the same has been used or applied to designate, make known or distinguish any such goods, wares, merchandise, or product of labor and they have been put upon the market.

SEC. 3. Any person, or corporation that has heretofore adopted and used, or shall hereafter adopt and use any label, trademark, term or design as herein provided, may file the same for registry in the office of the Secretary of State, or by leaving two copies, *fac similes* or counterparts thereof, with the said Secretary, and filing therewith a statement in the form of an affidavit, subscribed and sworn to by any such person, or by any officer, agent or attorney of any such corporation, specifying the person or corporation by whom, or on whose

behalf, any such label, trademark, term or design is filed, and the class or character of the goods, wares, merchandise or products of labor to which the same has been, or is intended to be appropriated or applied, and that the person or corporation so filing the same, or on whose behalf the same is so filed, has the right to the use of said label, trademark, term or design, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, without the permission or authority of the person or corporation filing the same, or causing the same to be filed, and that the copies, facsimiles or counterparts filed herewith, are true and correct copies, fac similes or counterparts of the genuine label, trademark, term or design of the person or corporation filing the same, or causing the same to be filed; and there be paid for such registry a fee of one dollar to the Secretary of State for the use of the State, and the same recording fees required by the general corporations act, Public Laws 1901, chapter 2.

SEC. 4. The Secretary of State upon the filing of any such label, trademark, term or design, that is not in conflict with the next section hereof, shall register the same, and shall deliver to the person or corporation filing the same, or causing the same to be filed, as many certified copies thereof, with his certificate of such registry, as any such person or corporation may request, and for every such copy and certificate there shall be paid to the Secretary of State, for the use of the State, a fee of one dollar; and any such certified copy and certificate shall be admissible in evidence and competent and sufficient proof of the adoption, filing and registry of any such label, trademark, term or design, by any such person or corporation, in any action or judicial proceeding in any of the Courts of this State, and of due compliance with the provisions of this Act: Provided, however, that such certificate shall not be assignable or

transferable by the person or corporation to whom the same is issued by the Secretary of State.

SEC. 5. It shall not be lawful for the Secretary of State to register, or permit to be registered, for any person or corporation any label, trademark, term or design, that is in the identical form of any other label, trademark, term or design theretofore filed by or on behalf of any other person, or corporation, or that bears any such near resemblance thereto as may be calculated to deceive, or that would be liable to be mistaken therefor; and any person or corporation who shall file or procure the filing and registry of any label, trademark, term or design in the office of the Secretary of State, under the provisions of this Act, by making any false or fraudulent representations or declarations, with fraudulent intent, shall be liable to pay any damages sustained in consequence of any such registry, to be recovered by or in behalf of the party injured thereby.

SEC. 6. Whenever any person or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, term or design, or cause the same to be done, as herein provided, and the same shall have been registered pursuant to this act, it shall be unlawful for any other person or corporation to manufacture, use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term or design, or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor to which or on which any counterfeit or imitation of any such label, trademark, term or design is attached, affixed, printed, stamped, impressed or displayed, or to sell or dispose of, or offer to sell or dispose of, or have in possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or product of labor contained in any box, case, can or package to which or on which any such

counterfeit or imitation is attached, affixed printed, stamped, impressed or displayed.

SEC. 7. Whenever any person or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, term or design, as herein provided, it shall be unlawful for any other person or corporation to make any use, sale, offer for sale or display of the genuine label, trademark, term or design of any such person or corporation filing the same, or to have any such genuine label, trademark, term or design in possession with intent that the same shall be used, sold, offered for sale, or displayed, or that the same shall be applied, attached or displayed in any manner whatever to or on any goods, wares or merchandise, or to sell, offer to sell, or dispose of, or have in possession with intent that the same shall be sold or disposed of any goods, wares or merchandise in any box, case, can or package, to or which any such genuine label, trademark, term or design of any such person or corporation is attached, affixed, or displayed, or to make any use whatever of any such genuine label, trademark, term or design, without first obtaining in every such case the license, consent or authority of the person or corporation adopting, filing and registering the same, or causing the same to be adopted, filed and registered; and any such license, consent or authority may be revoked and terminated at any time upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof.

SEC. 8. The Superior Court shall have jurisdiction in all cases arising or commenced therein under this act for the violations of any of the provisions thereof, and any person or corporation filing, or causing to be filed, for registry, any label, trademark, term or design pursuant to the provisions of this act, shall have the right to an

action in the said court against any person or corporations for the violation of any of the provisions of this act; and the said Court is hereby empowered and required to enjoin the manufacture, counterfeiting, imitation, display, use, sale, offer of sale, circulating or uttering of any counterfeit or imitation of any such label, trademark, term or design of any such person, association, organization or corporation; and the sale or disposal of any goods, wares, merchandise or product of labor, to which or on which any such counterfeit or imitation, label, trademark, term or design is attached, affixed, printed, painted, stamped or displayed, or any goods, wares, merchandise, or product of labor contained in any box, case, can or package, to or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed; and further to enjoin the manufacture, use, sale, offer of sale, or display, or (of) any genuine label, trademark, term or design of any such person, or corporation filing the same as aforesaid, or having in possession any such genuine label, trademark, term or design with intent that the same shall be used, sold, offered for sale or display, or the same applied, attached or displayed, in any manner whatever to or on any goods, wares, merchandise, or product of labor; or the selling or offer to sell or dispose of, or having in possession with the intent that the same shall be sold, offered for sale or disposed of, any goods, wares, merchandise in any box, case or package, to or on which any such genuine label, trademark, term or design of any such person or corporation is attached, affixed, or displayed, and from making any other, or any use whatever of any such genuine label, trademark, term or design, without having first obtained in any and every such case, the consent and authority of the person or corporation adopting, filing and registering the same, or causing the same to be filed and registered, as herein provided; and the said Superior Court

is hereby empowered to make such other orders and direct such other proceedings as the Court may deem necessary and proper for the due protection of the rights of complainants, affecting the purposes of this act, the prevention of any violation of any of the provisions of the same, and secure and protect any and all persons or corporations in all the rights, privileges, property, and interest to which they or any of them are or may be entitled in any such label, trademark, term or design, under any of the provisions of this act, or otherwise; and it shall be the duty of the said Superior Court to award to the complainant or complainants, in any such action, any and all damages resulting from any such wrongful use of any such label, trademark, term or design by any defendant or defendants, or for any violation of any of the provisions of this act, and to require any such defendant or defendants to pay to such complainants any and all such damages, together with all costs incurred by any such complaint in any such action, or proceeding; and the said Court shall also order and decree that the defendants pay to the complainant any and all profits obtained, received or derived from any such wrongful use or any violation of the provisions of this act, or both profits and damages, and that any such counterfeits, or imitations of any such labels, trademarks, terms or designs in the possession or under the control of the defendant or defendants, in any such action, shall be delivered up to an officer of the Court, or to the complainant, to be destroyed, and that any such genuine labels, trademarks, terms or designs, in the possession or under the control of any such defendant or defendant, shall be delivered up to the complainant.

SEC. 9. That, in addition to any other rights, remedies or penalties provided by this act, and as concurrent therewith, any person or corporation that shall violate any of the provisions of this act shall be liable to a penalty of two hundred dollars, to be recovered by any

such person or corporation that has adopted and filed, or caused the same to be done as aforesaid, any such label, trademark, term or design.

SEC. 10. This act shall be in force from and after April 1st, 1903.

In the General Assembly read three times, and ratified this 9th day of March, A. D. 1903.

FORM OF APPLICATION FOR REGISTRATION.

To the Secretary of State of the State of North Carolina:

SIR:—In compliance with the requirements of an act of the General Assembly of the State of North Carolina, entitled "An Act to provide for the registration of labels, trademarks and designs," ratified March 9th, 1903, the undersigned _____ resident or doing business in the United States, having heretofore adopted or used, or desiring to adopt or use a _____ for the purposes provided in said act, and desiring to file the same for record in the office of the Secretary of State of the State of North Carolina, hereby certify:

1st. The name of the person or persons, copartnership or corporation, so filing, is _____

2d. His or its residence, location or place of business is _____

3d. The class of merchandise, and the particular description of goods comprised therein _____

The trademark consists of _____

Two copies of fac-similes of said mark are tendered herewith.

4th. The class to which it has been or is intended to be appropriated _____

5th. The length of time, if any, during which it has been in use— _____

STATE OF _____ } ss:
COUNTY OF _____ }

Personally appeared before me, this _____ day of _____, A. D. 190—

who being duly sworn, according to law, depose and say that the statements contained in the foregoing instruments are true; that the _____ so filing such _____ has a right to use the same, and that no other person or persons, firm or corporation, has the right to such use, either in the identical form or in any such near resemblance thereto, as may be calculated to deceive, and that the fac-similes, copies or counterparts* filed herewith are true and correct.

Sworn and subscribed before me, the day and year aforesaid.

*NOTE.—Two copies, counterparts or fac-similes of the trademark, etc., must be filed with this application.

Filed, _____ 190—

Secretary of State.

NORTH DAKOTA.

REV. CODES 1899.

§ 3485. One who produces or deals in a particular thing or conducts a particular business, may appropriate to his exclusive use as a trademark any form, symbol or name which has not been so appropriated by another to designate the origin or ownership thereof; but he cannot exclusively appropriate any designation or part of a designation which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced or the business is carried on.

§ 3486. The good will of a business is the expectation of continued public patronage, but it does not include a right to use the name of any person from whom it is acquired.

§ 3487. The good will of a business is property, transferable like any other.

§ 3979. One who sells or agrees to sell any article to which there is affixed or attached a trademark, thereby warrants that mark to be genuine and lawfully used.

§ 3980. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof or the place where it was in whole or in part produced, manufactured or prepared thereby warrants the truth thereof.

§ 7256. Every person who willfully forges, counterfeits or procures to be forged or counterfeited any trademark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trademark is affixed or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

§ 7257. Every person who, with intent to defraud, has

in his possession any die, plate or brand, or any imitation of the trademark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such trademark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other person, and every person who so uses or sells the same, or who fraudulently uses the genuine trademark of another with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trademark properly belongs, as genuine and original, is guilty of a misdemeanor.

§ 7258. Every person who either:

1. Uses or causes to be used any brand, mark, name, print, designation or description, the same as or similar to any recorded to any other persons, or on the place recorded to another; or,

2. Uses or causes to be used any second hand sacks, box, barrel, can, package or other article on which has been placed any brand, mark, name, print, designation or description, the property of another, for the purposes of deception or profit, is guilty of a misdemeanor, and upon conviction thereof is punishable by fine of not less than one hundred and not exceeding one thousand dollars.

§ 7259. Every person who sells or keeps for sale any goods upon which any counterfeit trademark has been affixed, and intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

§ 7260. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye or to ear as the word of any of the

words or tokens used by any other person as his trademark, and every person who knowingly sells, or keeps, or offers for sale any such bottle, case, box, or other package with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to, or upon it, in case the person affixing or causing to be affixed such mark, or so selling or exposing or offering for sale such bottle, case, box, or other package, was not the first to employ or use such words as his trademark, is guilty of a misdemeanor, and in addition to the punishment prescribed therefor is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

§ 7261. The words "trademark," as used in the sections preceding, include every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

§ 7262. The word "goods," as used in the sections preceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

§ 7263. The offense of affixing a false trademark to goods is equally complete within the meaning of sections 7256, 7259 and 7260, whether such mark is affixed to the goods themselves or to any box, bale, barrel, bottle, case, cask, wrapper or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

§§ 7264, 7266 relate to protection of packages of manufacturers and bottlers of soda, mineral water, and other beverages.

OHIO.

No Registration Statute.

Bates' Ann. St., 1902.

Section 7069. Whoever vends, or keeps for sale, any goods, merchandise, mixture, or preparation upon which any forged or counterfeit stamp, brand, imprint, wrapper, label or trademark is placed or affixed, and intended to represent the said goods, merchandise, mixture or preparation, as the true and genuine goods, merchandise, mixture or preparation of any other person, knowing the same to be counterfeit, shall be fined not more than one hundred dollars.

SEC. 7096. Whoever willfully forges or counterfeits any representation, likeness, similitude, copy or imitation of the private brand, wrapper, label or trademark usually affixed by any person to or upon the goods, wares, merchandise, preparation or mixture of such person, or by any maker of wine from grapes grown within this state, to the bottles or casks used by him to contain the same, with intent to pass off any work, goods, manufacture, wine, compound, preparation, or mixture, to which such forged or counterfeit representation, likeness, similitude, copy or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, wine, compound, preparation or mixture of such person, shall be fined not more than five hundred dollars, or imprisoned not more than twelve months, or both.

SEC. 7098. Whoever has in his possession any die, plate, brand, engraving, printed label, stamp, imprint, wrapper, or trademark, or any representation, likeness, similitude, copy, or imitation thereof, usually affixed by any person to or upon articles made, manufactured, prepared, or compounded by him, for the purpose of making impressions, or selling the same when made, or us-

ing the same upon any other articles made, manufactured, prepared, or compounded, and passing the same off upon the community as the original goods, manufacture, preparation, or compound of any other person, or so in fact sells or uses the same, (or) wrongfully and fraudulently uses the genuine stamp, brand, imprint, wrapper, label, or trademark, with intent to pass off any goods, wares, merchandise, mixture, compound, or other article, not the manufacture of the person to whom such stamp, brand, imprint, wrapper, label, or trademark properly belongs, as genuine and original, shall be fined not more than five hundred dollars, or imprisoned not more than twelve months, or both.

§§ 4364-42 to 4364-44, Laws of Ohio, 1902, relate to the protection of packages used by manufacturers, bottlers and vendors of soda water, mineral water, and other beverages, or other articles of merchandise, medicines, compounds, or preparations.

§§ 4364-55 to 4364-61 relate to timber marks.

§§ 4364-49 to 4364-53c relate to the marks of labor unions.

§§ 7069-1 and 7069-2 relate to the false marking of silverware.

OKLAHOMA.

LAWS 1897, CH. 40.

AN ACT to provide a label law for the territory of Oklahoma.

SECTION 1. Whenever any person or any association or union of workmen has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared,

packed or put on sale by such person or association or union of workmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

SEC. 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed printed or painted, stamped or impressed, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than a hundred dollars, or by imprisonment for not more than three months.

SEC. 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form

of advertisement, as provided in section one of this act, may file the same for record in the office of the secretary of the territory of Oklahoma by leaving two copies, counterparts or *fac similes* thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac similes* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar.

Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said secretary of the territory shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement.

SEC. 4. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design or form

of advertisement in the office of the secretary of the territory, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not to exceed three months.

SEC. 5. Every such person, association or union adopting or using a label, trademark, term, device, or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit, damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable and shall require the defendants to pay to such person, associations or union all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court or to the complainant, to be destroyed.

SEC. 6. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union, in any manner not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or

member of such association or union on behalf of, and for the use of, such association or union.

SEC. 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

SEC. 8. This act shall take effect and be in force from and after its passage and approval.

Approved March 11, 1897.

Chap. 49 of the Session Laws of 1895 relates to the protection of the packages of manufacturers and dealers in carbonated goods, soda waters and other beverages.

OREGON.

Bellinger and Cotton's Annotated Codes and Statutes, Ch. V.

TRADEMARKS.

SEC. 4609. *Exclusive Use of Trademark, How Secured.*—Any person, partnership, firm, or private corporation desiring to secure within this state the exclusive use of any name, mark, brand, designation, or description for any article of manufacture or trade, or for any mill, hotel, factory, machine shop or other place of business, shall deliver or cause to be delivered to the secretary of state a particular description or a *fac simile* of such mark, brand, name, designation, or description as he may desire to use.

SEC. 4610. *Secretary of State to Record Trademarks.*—If there be not already a claim filed with the Secretary of State for the same or a similar name, mark, brand, designation, or description, he shall immediately record

the one furnished in a book to be specially provided and kept by him for such purpose, which book shall be at all times subject to public inspection and examination. If there be already filed the same or a similar brand, mark, designation, or description, the secretary shall so inform the applicant, and shall not record the same.

SEC. 4611. *Penalty for Infringement.*—Any person, partnership, firm, or corporation that shall use or cause to be used any name, mark, brand, designation, or description the same as or similar to one so secured or recorded, for the purpose of deception or profit, shall forfeit to the use of the owner of the name, mark, brand, designation, or description so taken or imitated one-half of the property, goods, or articles of trade upon which the same may be used or placed, or the value thereof, to be recovered by the said owner in any court having jurisdiction of the subject-matter.

SEC. 4612. *Penalty for Second Infringement.*—Any person, partnership, firm, or private corporation that shall use any such mark, brand, name, designation, or description a second or greater number of times shall forfeit the whole of the property or article upon which the same is placed or used, or the value thereof, to be recovered in the manner provided in the preceding section.

SEC. 4613. *Penalty for Using Boxes, etc., with Another's Trademark.*—Any person, partnership, firm, or private corporation that shall use or cause to be used any second hand sack, box, barrel, can, package, or other article on which has been placed any name, mark, brand, designation, or description, the property of another, for the purpose of deception, shall be liable to the same forfeiture of the property inclosed therein as is provided in sections 4611 and 4612.

SEC. 4614. *Importing Goods with Another's Trademark Thereon.*—If any goods, wares, merchandise, or other articles shall be imported into this state on which

shall be used, for the purpose of deception, the same or any similar mark, name, brand, designation or description as may have been secured under the provisions of this chapter, said goods, wares, merchandise, or other articles shall be forfeited to the use of the party injured, as provided in sections 4611 and 4612.

SEC. 4615. *Fee for Recording Trademark.*—A fee of two dollars and a half shall be paid to the Secretary of State by the owner of said trademark as pay for recording.

SEC. 4616. *Right to Enjoin Infringement Continues.*—Nothing in this act shall be construed so as to affect the power of courts of equity to perpetually restrain by injunction the improper use of any mark, brand, name, description, or designation which may have been secured by the provisions of this chapter.

RULES OF THE DEPARTMENT OF STATE

REGULATING THE

REGISTRATION OF TRADEMARKS.

In order to secure, within the State of Oregon, the registration of a brand, label, mark, name, word, word-symbol, phrase or designation as a trademark, it is necessary to make out a formal application addressed to the Secretary of State setting forth that some individual firm, partnership, or corporation, doing business at a designated place, desires to secure within the state of Oregon the sole and exclusive use as a trademark of some particularly described brand, label, mark, name, word, word-symbol, phrase or designation, for use in some designated manner on some stated class of goods, wares, or merchandise, and that the individual firm, partnership, or corporation, making the application is the original user and originator of the same, and that

by reason of being the original user claims within the State of Oregon the right to the sole and exclusive use.

This application should be signed and attached to it, either as part of the application or as an exhibit, should be one *fac-simile* of the brand, label, mark, name, word, word-symbol, phrase or designation desired to be trademarked. Enclosed with the application should be an extra *fac-simile* printed, impressed or made upon thin durable paper for attaching in the book of records of trademarks. With each application should be enclosed the fee allowed by law of \$2.50.

After the application is received at the office of the Secretary of State an examination of all the records of all trademarks which have heretofore been filed, must be made to ascertain whether or not the design desired to be registered will conflict with anything already registered. If, after such search has been made, it is found not to conflict with anything previously registered, the application is immediately filed and from that time the sole and exclusive use is awarded to the applicant.

FORM OF APPLICATION FOR REGISTRATION.

Application to register—a(a)—— As a trademark in the State of Oregon, for (b) ——

——, 190—.

To F. I. Dunbar, Secretary of State.

(c) ——, (d) ——, desiring to secure within the State of Oregon the sole and exclusive use of a (a) —— for use upon (b)—— in accordance with the provisions of Chapter V, Title XXXVIII, Bellinger and Cotton's Annotated Codes and Statutes of Oregon, hereby presents this application for the registration of the (a) ——, described as follows: —— a fac simile of which is marked "Exhibit A," hereto attached. This (a) —— as shown in the exhibit is to be used upon (b) ——, (e) —— said above named ——

And by reason of being the originator and original user of the (a) —— herein described and shown in the exhibit hereto attached, the said —— hereby claims the right to the sole and exclusive use of the same within the State of Oregon for the uses and purposes herein stated.

- (a) Insert whether name, mark, brand, designation or description.
- (b) Insert name of article, or place of business;
- (c) Insert name of person, firm, or corporation;
- (d) Insert whether partnership, firm, or corporation;
- (e) Insert manufactured and sold, or place of business, as the case may be.

Inclosed with the application should be an extra *fac simile* printed, impressed, or made upon thin, durable paper for attaching in the book of Records of Trademarks.

PENNSYLVANIA.

Act of April 24, 1905.

No. 210.

AN ACT amending the third section of the act, entitled "An act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions, or forms of advertisement, and protect and secure the rights, property and interest therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violations of the act," approved the twentieth day of June, Anno Domini one thousand nine hundred and one; so as to further protect and secure the rights, property and interest of persons, corporations or copartnerships adopting and registering said labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions or form of advertisement.

SECTION 1. Be it enacted, &c., That the third section of the act, entitled "An act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions or forms of advertisement, and protect and secure the rights, property and interest therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violation of the act," approved the twentieth day of June, Anno Domini one thousand nine hundred and one, which reads as follows:

"SEC. 3. That whenever person or persons, copartnership or corporations, has heretofore adopted and filed

for record or registry, or shall hereafter adopt and file for registry, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, as herein provided, it shall be unlawful, and a violation of this act, for any other person, copartnership or corporation to make any use, sale, offer for sale, or display of the genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof as shall be calculated or liable to deceive, of any such person or persons, copartnership or corporations, filing the same; or to sell, offer to sell, or dispose of, any goods, wares or merchandise, in bulk, or in any box, case, can, bottle or package to or which any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed for record as aforesaid, or any such likeness or imitation thereof, is attached, affixed or displayed; or to make any wrongful use whatever of any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof; or to in any way use the name or seal of any such person or persons, copartnership or corporation, or any such likeness or imitation thereof, in and about the sale of goods or otherwise, without first obtaining in every such case the license, consent or authority of the person or persons copartnership or corporation, adopting, filing and registering the same; and it shall be unlawful for any other person or persons, firm, copartnership, or corporation to make any use of such label, trademark, tradenames, device, shopmark, designation, or form of advertisement, so filed, or any such likeness or imitation thereof, or utter or display the same orally or in any printed or written form in the conduct of his business or in any business transaction, attached to merchandise or products of labor, or detached from and independent of the same, on invoice, letter-heads, bills or advertisements, without

express consent, license and authority of the person or persons, copartnership or corporation, so filing the same; and any such license, consent or authority may be revoked and terminated at any time, upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof. He shall refuse to file or register any label, trademark, tradename, device, shopmark, designation, or form of advertisement, identical with, or so similar to as to be calculated or liable to deceive, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed or registered, unless it shall be proved to his satisfaction that the person or persons, copartnership or corporation, lastly applying for the registry of such label, trademark, tradenames, device, shopmark, designation, or form of advertisement, shall be entitled thereto, and the owner thereof by right of prior adoption; in which case the date of adoption shall determine the ownership, and shall be proved by affidavits of persons conversant with such dates. In the case the Secretary of the State becomes satisfied, after hearing the said affidavits, that the person or persons, copartnership or corporation, last applying for registry is entitled to priority of adoption to register such trademark, tradename, device, shopmark, designation, or form of advertisement, he shall revoke the first registry thereof, and re-register the same in the name of said applying person or persons, copartnership or corporations," be and the same is hereby amended so as to read as follows:

SEC. 3. That whenever person or persons, copartnership or corporations, has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, as herein provided, it shall be unlawful and a violation of

this act for any other person, copartnership, or corporation to make any use, sale, offer for sale, or display of the genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof as shall be calculated or liable to deceive, of any such person or persons, copartnership or corporations, filing the same; or to sell, offer to sell, or dispose of any goods, wares, or merchandise, in bulk, or in box, case, can, bottle or package to or which any genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed for record as aforesaid, or any such likeness or imitation thereof, is attached; affixed or displayed; or to make any wrongful use whatever of any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof; or to, in any way, use the name or seal of any such person or persons, copartnership or corporation, or any other likeness or imitation thereof, in and about the sale of goods, or otherwise, without first obtaining, in every such case, the license, consent or authority of the person or persons, copartnership or corporation, adopting, filing and registering the same; and it shall be unlawful for any other person or persons, firm, copartnership, or corporation to *remove any such label, trademark, tradename, device, shopmark, designation, or form of advertisement, so registered as aforesaid and attached to merchandise or products of labor, for the purpose of using such merchandise or products of labor as a pattern for the reproduction of the same: Provided however, That nothing herein contained shall be taken to prohibit the using of such merchandise or products of labor as a pattern for the reproduction of the same, in individual cases of emergency repair. And it shall be* unlawful for any other person or persons, firm, copartnership, or corporation to make any use of such label, trademark, tradename, device, shopmark, designation, or

form of advertisement, so filed, or any such likeness or imitation thereof, or utter or display the same orally or in any printed or written form in the conduct of his business or in any business transaction, attached to merchandise or products of labor, or detached from and independent of the same, on invoice, letter-heads, bills, or advertisements, without express consent, license and authority of the person or persons, copartnership or corporation, so filing the same; and any such license, consent or authority may be revoked and terminated at any time, upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof. He shall refuse to file or register any label, trademark, tradename, device, shopmark, designation, or form of advertisement, identical with, or so similar to as to be calculated or liable to deceive, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed or registered, unless it shall be proved to his satisfaction that the person or persons, copartnership or corporation, lastly applying for the registry of such label, trademark, tradename, device, shopmark, designation, or form of advertisement, shall be entitled thereto, and the owner thereof by right of prior adoption; in which case the date of adoption shall determine the ownership, and shall be proved by affidavits of persons conversant with such dates. In the case the Secretary of State becomes satisfied, after hearing the said affidavits, that the person or persons, copartnership or corporation, last applying for registry is entitled to priority of adoption to register such trademark, tradename, device, shopmark, designation, or form of advertisement, he shall revoke the first registry thereof, and re-register the same in the name of said applying person or persons, copartnership or corporations.

FORM OF APPLICATION FOR REGISTRATION

To the Secretary of the Commonwealth of Pennsylvania:

SIR:—In compliance with the requirements of an Act of the General Assembly of the Commonwealth of Pennsylvania entitled "An Act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions or forms of advertisement, and protect and secure the rights, property and interest therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violations of the act," approved the 20th day of June, A. D. 1901, the undersigned, _____ resident or doing business in the United States, having heretofore adopted or used, or desiring to adopt or use a _____ for the purposes provided in said act, and desiring to file the same for record in the office of the Secretary of State of the State of Pennsylvania, do hereby certify:

1st. The name of the person or persons, copartnership or corporation so filing, is _____

(If a corporation give name of State under which organized.)

2d. His or its residence, location or place of business _____

3d. The class of merchandise, and the particular description of goods comprised therein _____

The trademark consists of _____

4th. The class to which it has been or is intended to be appropriated _____

5th. The length of time, if any, during which it has been in use _____

STATE OF _____, }
COUNTY OF _____ } ss:

Signature of Applicant.

Personally appeared before me, this _____ day of _____, A. D. 190—, who being duly sworn, according to law, deposes and says that the statements contained in the foregoing instrument are true; that the _____ so filing such _____, has a right to use the same, and that no other person or persons, copartnership or corporation, has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-similes, copies or counterparts filed herewith are true and correct.

Sworn and subscribed before }
me, the day and year aforesaid. }

NOTE.—Two copies, counterparts or fac-similes of the trademark must be filed with this application. Fee for filing and certificate, two dollars.

RHODE ISLAND.

PUBLIC LAWS OF 1900-1, CH. 735.

AN ACT for the protection of labels and seals of labor organizations, associations, and societies in the state of Rhode Island and Providence Plantations.

SECTION 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor as having been made, manufactured, produced, prepared, packed, or put on sale by such person, or association or union of workingmen, or by a member, or members, of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement.

SEC. 2. Whoever knowingly counterfeits or imitates any such label, trademark, term, design, device, or form of advertisement which has been filed and recorded in the office of the Secretary of State as hereinafter provided; or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowingly sells or disposes of any goods, wares, merchandise, or other product of labor contained in any

box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed; or knowingly keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

SEC. 3. Every such person, association, or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, shall file the same for record in the office of the Secretary of State by leaving two copies, counterparts, or *fac-similes* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association, or union on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; the class of merchandise, and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *facsimile* or counterparts filed therewith are true and correct, before there shall be any liability to any suit or proceeding for any violation of this act. There shall be paid for such filing and recording a fee of one dollar. Said secretary of state shall cause a description of such label, trademark, term, design, device, or form of advertisement to be published once a

week for three successive weeks, at the expense of the applicant, in some newspaper published in the city of Providence. After such publication said secretary shall deliver to such person, association, or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association, or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device, or form of advertisement. Said secretary of state shall not record for any person, union, or association any label, trademark, term, design, device, or form of advertisement that would probably be mistaken for any label, trademark, term, design, device, or form of advertisement theretofore filed by or on behalf of any other person, union, or association.

Sec. 4. Any person who shall, for himself or on behalf of any other person, association, or union, procure the filing of any label, trademark, term, design, or form of advertisement in the office of the secretary of state under the provisions of this act by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months. In any suit or prosecution under the provisions of this act, the defendant may show that he or it was the owner of such label, trademark, term, design, device, or form of advertisement prior to its being filed under the provisions of this act, and that it had been filed wrong-

fully or without right by some other person, association or union.

Sec. 5. Every such person, association, or union adopting or using a label, trademark, term, design, device, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction may grant injunctions to restrain such manufacture, use, display, or sale, and may award the complainant in any such suit damages resulting from such manufacture, use, sale, or display, as may be by the said court deemed just and reasonable, and may require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display, or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union, on behalf of and for the use of such association or union.

Sec. 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by fine of not more than one hundred dollars.

Sec. 7. The provisions of this act shall not abridge any rights to any trademarks existing at the time of the passage of this act, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trademarks.

Sec. 8. The district courts of the several judicial districts shall have jurisdiction of all complaints for violation of this act.

Sec. 9. This act shall take effect and be in force from and after the first day of June, A. D. 1900, and all acts and parts of acts inconsistent herewith are hereby repealed.

Chapter 627, Pub. Laws 1898-1899 relates to the protection of bottles, barrels, kegs, casks, cans, etc., of manufacturers, bottlers, and vendors of soda water, mineral water, ale, beer, or other liquids that may be used as foods or beverages, or medicines, perfumery, oils, compounds, etc.

FORM OF APPLICATION FOR REGISTRATION.

Application accompanying a ——— (Insert Label, Trademark, Term, Design, Device, or Form of Advertisement as the case may be) filed in accordance with the provisions of Chapter 735 of the Public Laws, passed April 12, 1900, entitled "An Act for the Protection of Labels and Seals of Labor Organizations, Associations and Societies in the State of Rhode Island and Providence Plantations."

Name of Person, Association or Union ———

Class of merchandise and description of the goods to which the ——— (Insert Label, Trademark, Term, Device, or Form of Advertisement, as the case may be) has been or is intended to be appropriated,

I, ——— do hereby declare, in accordance with the provisions of said Chapter 735 of the Public Laws, that ——— ha— a right to the use of the same—— referred to in the foregoing application, that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac simile or counterparts filed therewith are true and correct.

IN WITNESS WHEREOF, I have hereunto signed my name this ——— day of ——— in the year nineteen hundred ———

(Sign here.)

STATE OF RHODE ISLAND, ETC.

_____ SC.

_____ 190—

Then personally appeared the above-named _____ and made oath that the foregoing declaration by him subscribed is true and correct.

Before me,

Notary Public.

SOUTH CAROLINA.

No Registration Law.

The Laws of 1902, No. 601, relate to the protection of bottles, siphons, casks, boxes, etc., of manufacturers, bottlers, and vendors of soda water, mineral waters, and other beverages.

SOUTH DAKOTA.

POLITICAL CODE, 1903.

§ 3190. It shall be lawful for associations and unions of workmen to adopt, for their protection, labels, trademarks, and advertisements, used by such unions or associations, announcing that goods manufactured by members of such associations or unions are so manufactured by such members.

§ 3191. Any and all persons using such union or association trademarks, labels or advertisements, whether exactly like such labels, trademarks or advertisements or not, if with the intention to, or likely to, deceive the public, shall be guilty of a misdemeanor and on conviction thereof shall be punished by imprisonment of not less than ten days nor more than thirty days, or a fine of not less than twenty-five dollars nor more than one hundred dollars, or both.

§ 3192. Every person who shall use any such counterfeited trademark, label or advertisements of such a union or association, after having been notified that the same is so counterfeited, shall be guilty of a misdemeanor and on conviction thereof shall be punished by imprisonment of not less than ten days nor more than thirty days, or by fine of not less than twenty-five dollars nor more than one hundred dollars, or both.

§ 3193. Every association of workmen or labor union adopting a label, trademark or advertisement of the kind specified in section 3190, shall record the same in the office of the secretary of state by leaving two copies of said labels or advertisements with said secretary of state, who shall, under his hand and seal, deliver to the association or union recording such label or advertisements a certificate of record for which he shall receive a fee of one dollar.

§ 3194. Every association or labor union adopting a label, trademark or advertisement of the kind specified in section 3190 may proceed by suit in any of the courts of the state to enjoin the manufacture, use, display or sale of counterfeits or imitations of such labels, trademarks, or advertisements, and that all courts having jurisdiction of the persons, and upon satisfactory proof of such wrongful use, shall grant an injunction for such wrongful use of such counterfeits, and shall award the complainant such damages resulting from such wrongful use as may be proved, and shall require the defendants to pay to the complainant the profits derived from such wrongful use, or both profits and damages; and the court shall also order all counterfeit labels and advertisements in the possession or under the control of the defendant in such cause to be delivered to an officer of the court or to the complainants, to be destroyed.

§ 3195. In like manner such unions or associations of workmen shall be authorized to proceed against all persons who shall wrongfully use or display the genuine

labels or advertisements of the respective associations or unions, not being authorized by such associations or unions to use or display the same, in any court having jurisdiction thereof.

CIVIL CODE, 1903.

§ 183. There may be ownership of all inanimate things which are capable of appropriation, or of manual delivery; of all domestic animals; of all obligations; of such products of labor or skill, as the composition of an author, the good will of a business, trademarks and signs, and of rights created or granted by statute.

§ 892. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trademark, any form, symbol or name which has not been so appropriated by another, to designate the origin or ownership thereof; but he cannot exclusively appropriate any designation, or part of a designation, which relates only to the name, quality or description of the thing or business, or the place where the thing is produced or the business is carried on.

§ 1331. One who sells or agrees to sell any article to which there is affixed or attached a trademark, thereby warrants that mark to be genuine and lawfully used.

PENAL CODE, 1903.

§ 421. Every person who wilfully forges, counterfeits or procures to be forged or counterfeited any trademark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trademark is affixed, or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

§ 422. Every person who, with intent to defraud, has in his possession any die, plate or brand, or any imita-

tion of the trademark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such trademark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other person, and every person who so uses or sells the same, or who fraudulently uses the genuine trademark of another with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trademark properly belongs, as genuine and original, is guilty of a misdemeanor.

§ 423. Every person who sells or keeps for sale any goods upon which any counterfeited trademark has been affixed, intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

§ 424. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye, or to the ear, as the word or any of the words or tokens used by any other person as his trademark, and any person who knowingly sells, or keeps or offers for sale, any such bottle, case, box or other package, with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to or upon it, in case the person affixing or causing to be affixed such mark, or so selling, or exposing, or offering for sale such bottle, case, box or other package, was not the first to employ or use such words as his trademark, is guilty of a misdemeanor, and in addition to the punishment prescribed therefor, is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

§ 425. The word "trademark," as used in the sec-

tions preceding, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

§ 426. The word "goods" as used in the sections preceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

§ 427. The offense of affixing a false trademark to goods is equally complete within the meaning of sections 421, 423 and 424, whether such mark is affixed to the goods themselves, or to any box, bale, barrel, bottle, case, cask, wrapper, or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

§ 428. Whenever any person engaged in manufacturing, bottling, selling in bottles, soda, mineral waters, porter, ale, cider or small beer, has filed and published, in the manner authorized by law, a description of a name, mark or label usually stamped by him in the bottles containing such beverage, every other person who, without the written consent of such manufacturer or dealer, refills with any beverage, whether genuine or otherwise, with the intent to sell the same, any bottles stamped with such name, mark or label, and every person who sells, disposes of, purchases or traffics in such bottles, is liable to a penalty of fifty cents for each and every bottle so filled, sold, bought, disposed of, or trafficked in, for the first offense, and five dollars for each and every bottle so filled, bought, disposed of, or trafficked in, for every subsequent offense.

§ 429. Every person who keeps any bottles such as are designated in the last section, without the written consent of the manufacturer so to do, with intent to refill

or use or sell them in violation of the last section, is liable to the penalty therein prescribed.

§ 430. Whenever any manufacturer or dealer designated by section 428, or his agent, shall make oath or affirmation before any magistrate that he has reason to believe and does believe, that any of his bottles stamped and registered as mentioned in said section are being unlawfully used by any person or persons selling or manufacturing mineral water or other beverages, or that any junk dealer or vendor of bottles, has any of such bottles secreted in any place, such magistrate shall thereupon issue a search warrant to discover and obtain the same under the provisions of the law upon search warrants, which are hereby declared to fully relate to the purposes of this chapter; and the magistrate may summarily bring or cause to be brought before him the person in whose possession the bottles are found, to examine into the circumstances of his possession, and if such magistrate on summary examination finds that such person has been guilty of a violation of section 428, such magistrate shall proceed to impose the fine therein prescribed, and, if the same be not paid, to commit such person to prison for a term not exceeding fifteen days.

TENNESSEE.

CHAPTER 21, ACT OF 1905.

AN ACT to regulate trademarks and to provide remedies and penalties for the violation of this Act.

Section 1. *Be it enacted by the general assembly of the State of Tennessee*, that within the meaning of this Act a trademark shall be construed to be any seal, label, term, design, device, or form of advertisement used for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, pro-

duced, prepared, packed, or put on sale by any person, firm, corporation, association, or union of workmen, or by any member or members of such association or union.

Sec. 2. *Be it further enacted*, That whenever any person, firm, or corporation or any association or union of workmen has heretofore adopted or used or shall hereafter adopt or use any trademark, it shall be unlawful to counterfeit or imitate the same; or to use, sell, or to offer for sale, or in any way utter or circulate any counterfeit or imitation of any such trademark provided such trademark has been filed and recorded in the office of the Secretary of State, as provided in Section 4 of this Act.

Sec. 3. *Be it further enacted*, That whoever knowingly counterfeits any such trademarks, or knowing said trademark to be counterfeit, sells, offers for sale, or in any way utters or circulate any counterfeit or imitation of such trademark, or knowing such trademark to be counterfeit, keeps, or has in his possession, with the intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowing said trademark so printed, painted, stamped, or impressed thereon, sells or disposes of such goods, wares, merchandise, or other product of labor contained in any box, case, can, or package, to which or on which any such counterfeit or imitation is attached, fixed, printed, painted, stamped or impressed, or knowing such trademark to be counterfeit, keeps or has in his possession with the intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor, in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred (\$100)

dollars, or by imprisonment for not more than three months; provided that any person, firm, or corporation buying, selling, or disposing of any goods, wares, merchandise bearing said counterfeit trademark, not knowing the same to be counterfeit, shall not be deemed guilty under the provision of this Act.

Sec. 4. *Be it further enacted*, That every person, firm, corporation, or association, or union of workmen that has heretofore adopted or used, or shall hereafter adopt or use, any trademark mentioned and provided in Section 1 of this Act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts; or *fac-similes* thereof with said Secretary, and by filing therewith a sworn application, specifying the name or names of the person, firm, corporation, association, or union, on whose behalf such trademark shall be filed, the class of merchandise and a description of the goods to which it has been, or is intended to be appropriated, stating that the party so filing, or on whose behalf such trademark shall have been filed, has the right to use the same, that no other person, firm, corporation, association or union has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *facsimile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of five dollars. Said Secretary shall deliver to such person, firm, corporation, association, or union so filing, or causing to be filed, any such trademark, so many duly attested certificates of the recording of the same as such person, firm, corporation, association, or union may apply for, for each of which certificates said Secretary shall receive a fee of one dollar. Any such certificates of record shall in all suits and prosecutions under this Act be *prima facie* evidence of the adoption of such trademarks. Said Secretary of State shall not record for any person, firm, or corporation, association,

or union any trademark heretofore filed by or on behalf of any other person, firm, corporation, association, or union.

Sec. 5. *Be it further enacted*, That any person, who shall for himself, on behalf of any other person, firm, corporation, association, or union, procure the filing of any trademark in the office of the Secretary of State, under the provisions of this Act, by knowingly making any false, or fraudulent representation or declaration verbally or in writing, or by any means known to be fraudulent, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

Sec. 6. *Be it further enacted*, That every such person, firm, corporation, association, or union, adopting or using a trademark, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit, the court having jurisdiction, such damages resulting from such fraudulent manufacture, use, display, or sale as may be by the court or jury deemed just and reasonable; and shall require the defendants to pay to such person, firm, corporation, association, or union all profits derived from such wrongful manufacture, use, display, or sale, and such court shall also order that all such counterfeit or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court or to the complainant, to be destroyed.

Sec. 7. *Be it further enacted*, That every person who shall use or display the genuine trademark for the purpose of fraud of any such person, firm, corporation, as-

sociation, or union, in any manner not being authorized so to do by such person, firm, corporation, association, or union, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not less than three months, or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this Act may be commenced and prosecuted by an officer or member of such association or union, in behalf of and for the use of such association or union.

Sec. 8. *Be it further enacted*, That none of the provisions of this Act shall affect or apply to persons, firms, or corporations who shall in good faith buy or come into possession of goods with a counterfeit trademark thereon, when such person, firm, or corporation did not know at the time he or they obtained possession of such goods that the same were stamped with a counterfeit trademark; provided such person, firm, or corporation does not knowingly misrepresent the facts regarding the trademark at the time he offers such goods for sale.

Sec. 9. *Be it further enacted*, That this Act shall take effect from and after its passage, the public welfare requiring it.

Passed January 31, 1905.

W. K. ABERNATHY,
Speaker of the House of Representatives.

J. I. Cox,
Speaker of the Senate.

Approved.

JAMES B. FRAZIER,
Governor.

A true copy. Attest: JNO W. MORTON, Secy. of State.

TEXAS.

GENERAL LAWS 1895, CH. 81.

AN ACT to protect persons, associations, private corporations and unions of workingmen, incorporated or unincorporated, in their labels, trademarks, designs, devices, imprints, and forms of advertising and names; and to prescribe penalties for violation of same, and to repeal all laws or parts of laws in conflict with this act.

Section 1. That whenever any person, association, private corporations or union of workingmen, incorporated or unincorporated, have adopted or shall hereafter adopt for their protection any label, trademark, design, device, imprint or form of advertisement, indicating that goods to which such label, trademark, design, device, imprint or form of advertisement shall be attached, were manufactured by such person, association, private corporations or union, or by a member or members of such association or union, it shall be unlawful for any person, inclusive of officers, agents, receiver or receivers of corporations, to counterfeit or imitate such label, trademark, design, device, imprint or form of advertisement or to use such counterfeit or imitation of such label, trademark, design, device, imprint or form of advertisement, knowing the same to be counterfeit or imitation, or to aid, assist, countenance or knowingly permit such counterfeit or imitation or the use of such counterfeit or imitation for his own use or benefit, or for the use or benefit of any corporation of which he may then be an officer, agent or receiver. Every person, whether in his individual capacity or as an officer, agent or receiver of a corporation, violating this section, shall, upon conviction, be punished by a fine of not less than twenty-five nor more than one hundred dollars. Each day's violation of this section shall be considered a separate offense.

Sec. 2. Every person, whether in his individual ca-

capacity or as the officer, agent or receiver of a corporation, who shall willfully and knowingly use or display the genuine label, trademark, design, device, imprint, or form of advertisement, or name of any such person, association or union, incorporated or unincorporated, not being authorized to use or display the same, or shall aid, assist, countenance or knowingly permit the use of same, not being authorized to use the same, shall, upon conviction, be punished by fine of not less than twenty-five nor more than one hundred dollars.

Sec. 3. Every person, association or union of workmen, incorporated or unincorporated, having adopted a label, trademark, design, device, imprint or form of advertisement, as aforesaid, may proceed by suit to enjoin the wrongful manufacture, use, display or sale of any such label, trademark, design, device, imprint or form of advertisement, and the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the plaintiff in such suit such damages resulting from such wrongful manufacture, use, display or sale as by him may have been sustained. Where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union in his own name, for himself and for the use and benefit of such association or union.

Sec. 4. Every person, association or union of workmen, incorporated or unincorporated, that has heretofore or shall hereafter adopt a label, trademark, design, device, imprint or form of advertisement, shall file the same in the office of the secretary of state by leaving two copies, counterparts or *fac similes* thereof, with the secretary of state, and said secretary shall deliver back to such person, association or union so filing the same one of said copies, counterparts or *fac similes*, along

with and attached to a duly attested certificate of the filing of same, for which he shall receive a fee of one dollar from such person, association or union. Such certificate of filing shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, design, device, imprint or form of advertisement, and of the right of such person, association or union to adopt the same. No label, trademark, design, device, imprint or form of advertisements shall be filed as aforesaid that would probably be mistaken for a label, trademark, design, device, imprint or form of advertisement already of record: provided, that no person or association shall be permitted to register as a label, trademark, design, device, imprint or form of advertisement, any emblem, design or resemblance thereto that has been adopted or used by any charitable, benevolent or religious society or association without their consent: and provided, further, that all persons, institutions or associations now using a label, trademark, design, device, imprint or form of advertisement shall have thirty days' time after this act takes effect in which to file such label, trademark, design, device, imprint or form of advertisement under the provisions of this act. before the same can be registered by others.

Sec. 5. All laws and parts of laws in conflict with the provisions of this act be and the same are hereby repealed.

Sec. 6. It being important that the benefits of this act be realized at once, because the parties to be benefited by this act have no adequate protection under existing laws, creates an emergency and an imperative public necessity that the constitutional rule requiring bills to be read on three several days be suspended, and that this act take effect and be in force from and after its passage, and it is so enacted.

Approved April 29, 1895.

Sayles' Civ. St. Articles 318a, 318b, p. 148 relate to

the protection of bottles, boxes, siphons, etc., of manufacturers and dealers in mineral water and other beverages, and manufacturers of medicines or other compounds.

UTAH.

REV. ST., 1898.

2720. **DEFINED.** The phrase "trademark" as used in this title includes every description of word, letter, device, emblem, stamp, imprint, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, tradesman, association, or union, whether incorporated or unincorporated, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, or by such association or union, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

2721. **RECORDED WITH SECRETARY OF STATE.** Any person, association, or union, may record any trademark or name by filing with the Secretary of State his or its claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he, or the firm, corporation, association, or union, of which he is a member, is the exclusive owner, or agent of the owner, of such trademark or name.

2722. **RECORD OPEN TO PUBLIC.** The Secretary of State must keep for public examination a record of all trademarks or names filed in his office, with the date when filed and name of claimant; and must at the time of filing collect from each claimant the authorized fee.

2723. **OWNERSHIP, TRANSFER, DAMAGES FOR INFRINGEMENT.** Any person who has first adopted and used a trademark or name, whether within or beyond the limits

of this State, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain, by injunction, and award damages for any use of trademarks or names in violation of this title.

4482. **FORGING OR COUNTERFEITING TRADEMARK.** Every person who wilfully forges or counterfeits, or procures to be forged or counterfeited, any trademark usually affixed by any person, or by any association or union of workmen, to his goods, which has been recorded in the office of the Secretary of State, with intent to pass off any goods to which such forged or counterfeited trademark is affixed, or intended to be affixed, as the goods of such person or such association or union of workmen, is guilty of a misdemeanor.

4483. **SELLING GOODS BEARING COUNTERFEITED TRADEMARK.** Every person who sells, or keeps for sale, any goods upon or to which any counterfeited trademark has been affixed, after such trademark has been recorded in the office of the Secretary of State, intending to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

4484. **FORGED TRADEMARK, ETC. DEFINED.** The phrases, "forged trademark" and "counterfeited trademark," or their equivalents, as used in this chapter, include every alteration or imitation of any trademark so resembling the original as to be likely to deceive.

4485. **"TRADEMARK" DEFINED.** The phrase "trademark" as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman, or by any association or union of workmen, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, or

by such association or union of workingmen, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

4486. REFILLING CASK, ETC., BEARING TRADEMARK. Every person who has or used any cask, bottle, vessel, case, cover, label, or other thing bearing or having in any way connected with it the duly filed trademark or name of another, for the purpose of disposing with intent to deceive or defraud, or any article other than that which such cask, bottle, vessel, case, cover, label, or other thing originally contained or was connected with by the owner of such trademark or name, is guilty of a misdemeanor.

Note: The fee for registering trademark is \$3.00.

VERMONT.

LAWS OF 1898.

Public Act No. 153.

AN ACT to provide for the registration of trademarks.

Section 1. Any person, partnership or corporation may adopt as and for his or their trademark or trade-name any particular name, term, design, device, label, stamp or form of advertisement, not previously owned or adopted by any other person, partnership or corporation, to designate or distinguish any goods, wares or merchandise by him or them manufactured or prepared, and may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or *fac similes* thereof, with the said secretary; and shall also file therewith an accurate description of such name, term, design or device, label, stamp or form of advertisement, verified under oath by the person or some officer of the partnership or corporation by whom it is filed.

There shall be paid for such filing the fee of two dollars.

Said secretary shall deliver to such person, partnership or corporation so filing the same, a duly attested certificate of the record of the same, for which he shall receive the fee of two dollars. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such trademark or tradename. No name, term, design, device, label, stamp or form of advertisement shall be recorded that in any way resembles or would be reasonably mistaken for a name, term, design, device, label, stamp or form of advertisement already on record.

Sec. 2. The secretary of state is authorized to make rules and regulations and prescribe forms for the filing of names, terms, designs, devices, labels, stamps and forms of advertisement under the provisions of this act.

Sec. 3. Every person who, without authority from the owner of a trademark or tradename adopted and recorded as aforesaid, shall knowingly and willfully make or sell any representation, likeness, similitude, copy, imitation or counterfeit of such trademark or tradename, and every person who, without authority from such owner, shall affix, impress or use such trademark or tradename upon any goods, wares or merchandise shall be punished by a fine not exceeding one thousand dollars or by imprisonment not exceeding one year, or by both said fine and imprisonment.

Sec. 4. Every person who shall knowingly and willfully sell or keep for sale any goods upon which or in connection with which shall be affixed any forgery, imitation or counterfeit of a trademark or tradename adopted and recorded as aforesaid, and intended to represent the said goods as the genuine goods of any other person, shall be punished by a fine not exceeding one thousand dollars or by imprisonment not exceeding one year, or by both such fine and imprisonment.

Sec. 5. Every person who shall, with intent to defraud any other person, partnership or corporation, knowingly affix or cause to be affixed to or upon any package or bottle containing any goods, wares or merchandise any name, term, design, device, label, stamp or form of advertisement, which shall designate such goods, wares or merchandise, either wholly or in part by a word or words, or by general design, which shall be wholly or in part the same either in appearance to the eye, or in sound to the ear, as the word or words or the general design of any trademark or tradename adopted and recorded, as provided in this act, or who shall knowingly sell, or expose for sale, any such package or bottle with any such imitating or counterfeit name, term, design, device, label, stamp or form of advertisement, may also be punished by imprisonment not exceeding one year, or by a fine of not more than five hundred dollars, or by both such fine and imprisonment.

Sec. 6. The owner of any trademark or tradename adopted and recorded as provided in section 1 of this act may proceed by suit to enjoin any and all other persons, partnerships or corporations from the manufacture, use or sale, without the authority of said owner, of all likenesses, similitudes, copies, imitations or counterfeits thereof, and also from selling or exposing for sale any and all goods, compounds, or preparations to or with which such unauthorized likeness, similitudes, copies, imitations or counterfeits shall be affixed or connected. And all courts having jurisdiction in equity may grant injunctions to restrain and enjoin such manufacture, use, sale and exposure for sale, and may award to the complainant in such suit such a sum of money as shall be just and reasonable compensation for the damage to the reputation of the complainant's genuine goods, compounds or preparations by reason of such wrongful manufacture, use, sale or exposure for sale; and may also require the defendant to pay to the complainant in such

suit a sum equal to the amount which the complainant would have received for the same quantity of genuine goods, compounds or preparations, and may also order that all such likenesses, similitudes, copies, imitations or counterfeits in the possession of or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Approved November 22, 1898.

FORM OF APPLICATION FOR REGISTRATION.

CERTIFICATE accompanying a—— (Insert Name, Term, Design, Device, Label, Stamp or Form of Advertisement, as the case may be.) adopted as a —— (Insert Trademark, or Tradename, as the case may be.) and filed in accordance with No. 158 of the Acts of 1898, entitled "An act to provide for the Registration of Trademarks."

Name or names of the Persons, Partnership or Corporation—— (Follow regulations below at A.) Residence, location or place of business, —— class of merchandise and the particular description of goods comprised in such class to which the —— (Insert Name, Term, Design, Device, Label Stamp, or Form of Advertisement, as the case may be,) has been or is intended to be appropriated —— (Follow regulations below at B.) (Here insert the trademark or trade-name adopted and send three extra copies, fac-similes or counterparts of the trademark or name.) Length of time, if any, during which the —— (Insert Name, Term, Design, Device, Label, Stamp, or Form of Advertisement, as the case may be.) has been in use. Since —— (Give Month, Day of Month and Year when adopted, or give date since when in use.

REGULATIONS.

A. If a corporation, state under the laws of what State incorporated.

If one or more persons are doing business under a partnership name, state the name of such person or persons and add the words "doing business under the name and style of," then give the partnership name under which the business is conducted.

B. State, first, as near as possible in one or two words, the general class of merchandise to which the name, term, design, device, label, stamp, or form of advertisement has been or is intended to be appropriated;

Second, as near as possible in one or two words, the particular de-

scription or designation is such general class of merchandise. Do not describe the composition, or name the parts which comprise the formula of which the merchandise is composed;

Third, by using the following words: "the essential feature of the (trademark, or tradename) is," giving what is considered to be the essential feature or features thereof. If an illustration or pictorial representation is used for a trademark, it is very desirable that a word or words shall also form a part of the "essential features" of such trademark;

Fourth, by using the following words, that: "The style and size of type and the color of ink and paper may be varied at pleasure."

*I, ——— do hereby declare, that ——— (Insert the name of the Person, Partnership, or Corporation adopting the Trademark or Tradename.) has a right to the use of the ——— (Insert Trademark, or Tradename, as the case may be.) referred to in the foregoing certificate, and that no other person, partnership or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and I further declare that the foregoing description and the fac-similes copies or counterparts filed with the foregoing certificate are true, correct and accurate.

IN WITNESS WHEREOF, I have hereunto signed my name this ——— day of ———, 190—

(Sign here.) —————

STATE OF VERMONT, } ss.

—————190—

Then personally appeared the above-named ——— and made oath that the foregoing declaration by him subscribed is true.

Before me,

_____.

(Here write official title.)

* If a person, insert name; if an officer of a partnership or corporation, insert name, title of office, and name of the partnership or corporation. Outside of Vermont, oath should be administered by a Commissioner for Vermont or Notary Public, with seal.

VIRGINIA.

Act of April 30, 1903.

AN ACT to protect persons, firms, corporations, associations, or unions of workingmen in the use of their labels, trademarks, terms, designs, devices, and forms of advertisements, and to provide for the registry thereof. Approved April 30, 1903.

1. *Be it enacted by the General Assembly of Virginia,* That whenever any person, firm, corporation, or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, produced, prepared, packed, or put on sale by such person, firm or corporation, or association, or union of workingmen, by a member or members of such association or union, and has filed the same for registry as herein-after provided, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

2. Whoever counterfeits or imitates any such registered label, trademark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such registered label, trademark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, keeps, or has in his possession, with the intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which, or on which, any

such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly and with intent to deceive, knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can, or package to which, or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or knowingly and with intent to deceive, keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can, or package to which, or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months. All such applications for registry shall be made on forms prescribed by the secretary of the Commonwealth, and any person applying to the secretary of the Commonwealth for a certificate of registry of any label, trademark, term, design, device or form of advertisement, shall furnish to the said secretary a copy fac-simile, or counterpart thereof.

3. Every such person, firm, corporation, association or union that has heretofore adopted or used, or shall hereafter adopt or use a label, trademark, term, design, device, or form of advertisement, as provided in section one of this act, may file the same for registry in the office of the Secretary of the Commonwealth by leaving six copies, counterparts, or fac-similes thereof, with the said secretary, and by filing herewith a sworn application, specifying (1) the name or names of the person, firm, corporation, association or union, on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; (2), the class of merchandise and the description of the goods to which it has been, or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trade-

mark, term, design, device, or form of advertisement shall be filed, has a right to use the same; (3), that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and (4), that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and registry to the secretary of the Commonwealth a fee of two dollars and fifty cents. Said secretary shall deliver to such person, firm, corporation, association, or union so filing, or causing to be filed, any such label, trademark, term, design, device, or form of advertisement, so many duly attested certificates of the registry of the same as such person, firm, corporation, association, or union may apply for, for each of which certificates said secretary shall receive a fee of two dollars and fifty cents. Any such certificate of registry shall in all suits and prosecutions under this act be sufficient proof of the adoption and registry of such label, trademark, term, design, device, or form of advertisement. Said secretary of the Commonwealth shall not record for any person, firm, corporation, union, or association any label, trademark, design, term, device, or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, firm, corporation, union or association.

4. Any person who shall for himself, or on behalf of any other person, firm, corporation, association, or union, procure the filing and registry of any label, trademark, term, design, or form of advertisement in the office of the secretary of the Commonwealth, under the provisions of this Act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby,

in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

5. Every such person, firm, corporation, association, or union, which has adopted and registered a label, trademark, term, design, device, or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display, or sale, as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, firm, corporation, association, or union, all profits derived from such wrongful manufacture, use, display, or sale; and such court shall also order that any such counterfeits or imitations in the possession, or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

6. Every person who shall use or display the genuine registered label, trademark, term, design, device, or form of advertisement, of any such person, firm, corporation, association or union in any manner, not being authorized so to do by such person, firm, corporation, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred dollars. In all cases where such association, or union, is not incorporated, suits under this act may be commenced and prosecuted by an officer, or member of association or union, on behalf of, and for the use of, such association or union.

7. Any person, or persons, who shall in any way use the name or seal of any such person, firm, corporation, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall

be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

8. This act shall take effect and be in force from and after its passage.

FORM OF APPLICATION FOR REGISTRATION.

To the Secretary of the Commonwealth of Virginia:

(Name and Address) in whose name and behalf this application for the registry in the State of Virginia, of the label, trademark, term, design, device or form of advertising hereinafter indicated is made, in order to secure to the applicant the exclusive use of the same for the purpose of designating, making known and distinguishing the articles hereinafter described, do declare, that:

The name of the applicant in whose name and behalf this registry is made, is as above set forth:

The applicant has heretofore adopted and used, and has the right to use, said label, trademark, design, device or form of advertising, for the purpose of designating, making known or distinguishing the articles hereinafter designated, and that no other person, firm, association, union or corporation, has the right to such use, either in the identical form, or in any such near resemblance thereto as may be calculated to deceive.

The class of articles, and the description thereof, to which such label, trademark, term, design, device or form of advertising is appropriated, are the following, to-wit: ——— (Insert fac-simile or counterpart of trademark or label.)

The fac-simile or counterpart herewith filed is true and correct.

Witness the following signature this, the ——— day of ——— 190—

STATE OF ——— of ——— ss.

I, ——— a notary public for the ——— of ———, in the State aforesaid, do hereby certify that (If officer of corporation or partner so state) this day personally appeared before me in my ——— and State aforesaid and made oath that the statements contained in the foregoing writing bearing date on the ——— day of ———, 190—, are true and that he is duly authorized to make this oath.

Given under my hand and official seal, this, the ——— day of ———, 190—

WASHINGTON.

Nichols, "Existing Corporation Laws of the State of Washington,"
1905, page 160.

1. COUNTERFEITING TRADEMARKS PROHIBITED. Whenever any person, or any association or union of workmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

2. PENALTY. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped

or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor, in any box, cases, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

3. FILING AND RECORDING. Every such person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section one of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, the class of merchandise, and a description of the goods to which it has been, or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid, for such filing and recording, a fee of five dollars. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of two dollars. Any

such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

4. FRAUDULENT FILING, ETC.—PENALTY. Any person who shall, for himself or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design or form of advertisement in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

5. ENJOIN USE, ETC. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in

such cause be delivered to an officer of the court, or to the complainant to be destroyed.

6. PENALTY FOR UNAUTHORIZED USE. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred (\$100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

7. PENALTY FOR USE OF NAME OR SEAL. Any person or persons who shall, in any way, use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

8. PENALTY FOR DEFACING OR REMOVING TRADEMARK, ETC. Any person using the trademark so adopted and filed by any such person, or any imitation of such trademark, or any counterfeit thereof; or who shall, in any manner mutilate, deface, destroy or remove such trademark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second hand package which has contained the same or been used therefor, with the intention of using such empty or second hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first used; and any person who shall use any such empty or second hand

package for the purpose aforesaid, without the consent in writing of the person whose trademark was first applied thereto or placed thereon shall, upon conviction thereof, be fined in any sum not less than one hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles, contained in any second hand package or packages shall be forfeited to the original user of such package or packages whose trademark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular article or package shall be held to be a separate offense.

9. "PERSON" DEFINED. The word "person" in this act shall be construed to include a person, co-partnership, corporation, association or union of workmen.

Where the mark in litigation has not been registered under § 3621, Ballinger's Annotated Codes, the sufficiency of a complaint for the infringement of the mark must be adjudged upon the principles of common law.

Woodcock v. Guy, 33 Wash., 234, 74 Pac. Rep. 358.

WEST VIRGINIA.

ACT of 1901.

AN ACT providing for the protection of union labels and trademarks.

1. Whenever any person, firm or corporation, or any association or union of workmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the use of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, firm, corporation or association or union of workmen, or by a member or members of such association

or union, and shall register the same as provided in section three of this act, it shall be unlawful to knowingly counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to knowingly use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

2. Whoever so knowingly counterfeits or imitates any such registered label, trademark, term, design, device or form of advertisement; or knowingly sells, or offers for sale, or in any way utters or circulates any counterfeit or imitation of any such registered label, trademark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped or impressed, shall be punished by a fine of not more than five hundred dollars or by imprisonment for not more than three months, or by both such fine and imprisonment.

3. Every such person, firm, corporation, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section one of this act, shall register the same by filing the same for record in the office of the secretary of state by leaving

two copies, counterparts or fac-similes thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement, shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to use the same; that no other person, firm, association union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-similes or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association, or union, so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, firm, corporation, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificates of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such labels, trademarks, terms, designs, devices or forms of advertisement. Said secretary of state shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement, that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, firm, corporation, union or association. But the said secretary shall file and record under this act any label, trademark, term, design, device or form of advertisement, which may have been previously filed by any person, firm, corporation or any association or union of

workingmen, provided the person, firm, corporation, association or union seeking to file and record under this act is the same person, firm, corporation, association or union that previously filed or recorded the same label, trademark, term, design, device or form of advertisement.

4. Any person who shall for himself, or on behalf of any other person, firm, corporation, association or union, procure the filing of any label, trademark, term, design or form of advertisement, in the office of the secretary of state under the provisions of this act, by making any known false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars or by imprisonment not exceeding three months, or by both such fine and imprisonment.

5. Every such person, firm, corporation, association or union adopting or using any such registered label, trademark, term, design, device or form of advertisement, as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and award the complainant in any such suit damages resulting from such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union, all profits derived from such wrongful manufacture, use, sale or display; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

6. Every person, firm, corporation or union, who shall knowingly use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, firm, corporation, association or union when registered as aforesaid, in any manner, not being authorized so to do by such person, firm, corporation, association or union, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than three hundred dollars. In all cases where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

7. Any person, firm, corporation, association, or union, who shall in any way knowingly use the name or seal of any such person, firm, corporation, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars.

8. Nothing contained in this act shall be construed as affecting or impairing any right or remedy at law or in equity now existing for the protection of any label, trademark, term, design, device or form of advertisement, whether or not the same is registered under the provisions hereof.

The Act of 1882 relates to timber trade.

Another Act of 1889 relates to the protection of persons and corporations engaged in manufacturing and selling mineral waters, malt liquors and other beverages.

WISCONSIN.

ACT of MAY 13, 1901.

CHAPTER 360.

AN ACT to provide for registration of trademarks and other marks of ownership and to prevent the unlawful use and disposal of articles marked therewith.

SECTION 1. *Filing of description with secretary of state; publication of; fees.*—Any and all persons or corporations who may be the owners of cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers with his, her, its or their names, brands, designs, trademarks, devices, or other marks of ownership stamped, impressed, labelled, blown in or otherwise marked thereon, may file with the secretary of state and also with the register of deeds of any county in which any such person or persons or corporations may have his, her, its or their principal place of business, a written statement or description verified by affidavit of such owner or his, her, or its agent, of the names, brands, designs, trademarks, devices or other marks of ownership so used by him, her, it or them, and of the said article or articles upon which the same are used, or if such principal place of business shall be without the state, then such written statement or description so verified may be filed with the register of deeds of any county of this state. Said statement shall be published once a week for three successive weeks in a newspaper printed in the English language and of general circulation in said county, a copy of which publication, proved in the same manner as proof of publication is now required to be made by law, when no special mode of proving the same is provided, shall also be filed with the secretary of state and with such register of deeds. All such written statements or descriptions and all such certificates of publication so filed with the register of

deeds shall be recorded at large by him in a book to be kept by him, and such book shall be subject at all reasonable hours to the inspection of all persons who may choose to inspect the same. The secretary of state and the register of deeds shall deliver to any person who may apply therefor copies of all such written statements or descriptions of names, brands, designs, trademarks, devices, or other marks of ownership and of all certificates of publication so filed with them, duly certified to by them in the usual manner, and such certified copies shall be admissible in evidence in all prosecutions under this act, and shall be *prima facie* evidence that the provisions of this section have been complied with, and of the title of the owner or owners named therein, to the property upon which the name, brand, design, trademark, device or other marks of ownership of such owner or owners may appear as described therein. The secretary of state and the register of deeds shall each receive a fee of one (1) dollar for each statement and certificate of publication filed and also a fee of one (1) dollar for each certified copy of such statement and certificate of publication, to be paid for by the person filing or applying for the same.

SEC. 2. *Sale of receptacle by other than owner prohibited.*—It is hereby declared to be unlawful for any person or persons or corporation without the written consent of the owner or owners thereof, to hereafter keep for sale any can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container so marked or distinguished as aforesaid, of which a description shall have been filed and published as provided in section 1 of this act, or to use or fill with any similar substance, commodity or product as originally contained therein for the sale of such substance, commodity or product, any such can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container or to receive, take, buy, sell, or dispose of or traffic in any such can, tub,

firkin, bottle, box, cask, barrel, keg, carton, tank, fountain, vessel or container, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, brand, design, trademark, device or other mark thereon, for the purpose of destroying or removing the evidence of the ownership of such article.

SEC. 3. *Use of receptacle by other than owner; as to junk dealers.*—The using by any person or persons or corporation other than the owner or owners thereof, or his, her, its or their agent, of any such can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container, for the sale therein of any substance, commodity or product, other than that originally therein contained, or the buying, selling, or trafficking in any such can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container, or the fact that any junk dealer or dealers in cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers, shall have in his or her possession any such can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container, so marked or stamped, and a description of which shall have been filed and published as provided in section 1 of this act, shall be, and it hereby is, declared to be, *prima facie* evidence that such using, buying, selling or trafficking in or possession of is unlawful within the meaning of this act.

SEC. 4. *Forfeiture for violation.*—Any person or persons or corporation or any officer or agent of any corporation acting for or in the name of such corporation who shall violate any of the provisions of this act, shall forfeit not less than five dollars (\$5.00) nor more than fifty dollars (\$50.00) for the first offense, and not less than fifty dollars (\$50.00) nor more than two hundred dollars (\$200.00) for each subsequent offense. All forfeitures collected under the provisions of this act shall be paid into the common school fund.

SEC. 5. *Rights of owner to injunction.*—Every such

person or corporation having complied with the provisions of this act as aforesaid, may proceed by suit to enjoin any other person or corporation from filing [filling] with any substance, commodity or product for the sale therein of such substance, commodity or product any can, tub, firkin, box, bottle, cask, barrel, keg, carton, tank, fountain, vessel or container, so marked or distinguished as aforesaid, or from buying, selling, using, or disposing of or trafficking in the same, or from defacing, erasing, obliterating, covering up or otherwise removing any such name, brand, design, trademark, device or other marks or ownership thereon, for the purpose of destroying or removing the evidence of the ownership of such article, and all courts having equity jurisdiction shall have power to grant injunctions according to the course and principles of courts of equity, to restrain such filing [filling] for sale or such buying, selling, giving away, using or disposing of, or trafficking in or such defacing, erasing, obliterating, covering up, or otherwise removing or the violation of any right acquired under the provisions of this act, and upon a decree being rendered in any such case against the defendant, the complainant shall be entitled to recover the damages the complainant may have sustained by reason of the said acts of the defendant and the court shall assess the same or cause the same to be assessed under its direction.

SEC. 6. This act shall take effect and be in force from and after its passage and publication.

WYOMING.

Revised Statutes, 1899.

Section 2526. Any person, association or union may adopt a label, trademark, stamp or form of advertisement not previously owned or adopted by any other person, association or union, and may file the same for record in the office of the secretary of state, by leaving two copies, counterparts or fac-similes thereof, with said secretary; and shall file therewith a certificate specifying the name or names of the person, association or union so filing such label, trademark, stamp or form of advertisement, his or its residence, location or place of business, the class of merchandise and the particular description of goods comprised in such class to which it has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. Such certificate shall be accompanied by a written declaration, verified under oath by the person or some officer of the association or union by whom it is filed, to the effect that the party so filing such label, trademark, stamp or form of advertisement has a right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-similes, copies or counterparts filed therewith are true and correct. There shall be paid for such filing the fee of five dollars. Said secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive the fee of five dollars. Such certificate of record, shall in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, stamp, trademark or form of advertisement. No label, trademark, stamp or form of

advertisement shall be recorded that would reasonably be mistaken for a label, trademark, stamp or form of advertisement already on record.

Sec. 2527. The secretary of state is authorized to make rules and regulations, and prescribe forms for the filing of labels, trademarks and forms of advertisement under the provisions of this act.

Sec. 2528. The owner of any such label, trademark, stamp or form of advertisement recorded as provided in section one of this act, may proceed by suit to enjoin the manufacture, use or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof to grant injunctions to restrain such manufacture, use or sale, and will award the complainant in such suit such damages resulting from such wrongful manufacture, use or sale as may by said court be deemed just and reasonable, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer of such association or union, on behalf of and for the use of such association or union, and every member of such association or union shall be liable for costs in any such proceedings.

Sec. 2529. Every person who, without authority from the owner of a label, trademark, stamp or form of advertisement recorded as aforesaid, shall make or use any counterfeit or imitation of such label, trademark, stamp or form of advertisement, knowing the same to be counterfeit or imitation, and every person who, without authority from such owner, shall affix, impress or use such label, trademark, stamp or form of advertisement upon

any goods shall be punished by a fine not exceeding two hundred dollars, or by imprisonment not exceeding one year, or by both such fine and imprisonment.

Sec. 2530. Every person who shall sell goods upon which such label, trademark, stamp or form of advertisement recorded as aforesaid, or any counterfeit or imitation thereof, shall be unlawfully impressed, affixed or used, shall be punished by a fine not exceeding two hundred dollars, or by imprisonment not exceeding one year, or by both such fine and imprisonment, unless such person shall show that at the time such goods came into his possession he did not know that the impression, affixing or use of such label, trademark, stamp or form of advertisement was unlawful.

Sec. 2531. In any suit or prosecution under the provisions of this act the defendant may show that he or it was the owner of such label, trademark or form of advertisement, prior to its being filed under the provisions of this act, and that it has been filed wrongfully or without right by some other person, association or union.

Sec. 2532. This act shall not be construed as to apply to brands, marks or tags on live stock.

APPENDIX I.

CANADIAN TRADEMARK AND DESIGN ACT.

Revised Statutes, 1886.

CHAPTER 63.

SHORT TITLE.

1. This act may be cited as "*The Trademark and Design Act.*" 42 V., c. 22, s. 40.

APPLICATION OF ACT.

2. Sections three to twenty-one of this act, both inclusive, apply only to trademarks, and sections twenty-two to thirty-eight, both inclusive, apply only to industrial designs. 42 V., c. 23, s. 37.

TRADEMARKS.

3. All marks, names, brands, labels, packages or other business devices, which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed or offered for sale by him—applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall for the purpose of this act, be considered and known as trademarks, and may be registered for the exclusive use of the person registering the same in the manner herein provided; and thereafter such person shall have the exclusive right to use the same to designate articles manufactured or sold by him:

2. Timber or lumber of any kind upon which labour has been expended by any person in his trade, business, occupation or calling, shall, for the purposes of this act, be deemed a manufacture, product or article. 42 V., c. 22, s. 8.

4. A trademark may be general or specific, according to the use to which it is applied or intended to be applied by the proprietor thereof:

(a.) A general trademark is one used in connection with the sale of various articles in which the proprietor deals in his trade, business, occupation or calling generally;

(b.) A specific trademark is one used in connection with the sale of a class of merchandise of a particular description. 42 V., c. 22, s. 9.

5. A register of trademarks shall be kept at the Department of Agriculture, in which any proprietor of a trademark may have the same registered, on complying with the provisions of this act. 42 V., c. 22, s. 1.

6. The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this act, as respects trademarks; and such rules, regulations and forms circulated in print, for the use of the public, shall be deemed to be correct for the purposes of this act; and all documents executed according to the same and accepted by the Minister, shall be deemed to be valid so far as relates to official proceedings under this act. 42 V., c. 22, s. 2.

7. The Minister of Agriculture may cause a seal to be made for the purposes of this act; and may cause to be sealed therewith trademarks and other instruments, and copies of such trademarks and other instruments, proceeding from his office in relation to trademarks. 42 V., c. 22, s. 3.

8. The proprietor of a trademark may have it registered on forwarding to the Minister of Agriculture, to-

gether with the fee hereinafter mentioned, a drawing and description in duplicate of such trademark, and a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof. 42 V., c. 22, s. 6.

9. Every proprietor of a trademark who applies for its registration shall state in his application whether the said trademark is intended to be used as a general trademark or as a specific trademark. 42 V., c. 22, s. 11.

10. Before any action is taken in relation to an application for registering a trademark, the following fees shall be paid to the Minister of Agriculture, that is to say:—

On every application to register a general trademark, including certificate ..	\$30 00
On every application to register a specific trademark, including certificate ..	25 00
On every application for the renewal of the registration of a specific trademark, including certificate ..	20 00
For copy of each certificate of registration, separate from the return of the duplicate ..	1 00
For the recording of an assignment.....	2 00
For office copies of documents, not above mentioned, for every hundred words or for a fraction thereof.....	0 50
For each copy of any drawing or emblematic trademark, the reasonable expenses of preparing the same,—	

And such fees shall be paid over by the Minister of Agriculture to the Minister of Finance and Receiver General:

2. If the Minister of Agriculture refuses to register the trademark for which application is made, the fee shall be returned to the applicant or his agent,—less the sum of five dollars, which shall be retained as compensation for office expenses. 42 V., c. 22, s. 12.

11. The Minister of Agriculture may refuse to register any trademark in the following cases:—

(a.) If he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trademark;

(b.) If the trademark proposed for registration is identical with or resembles a trademark already registered;

(c.) If it appears that the trademark is calculated to deceive or mislead the public;

(d.) If the trademark contains any immorality or scandalous figure;

(e.) If the so-called trademark does not contain the essentials necessary to constitute a trademark, properly speaking.

2. The Minister of Agriculture may, however, if he thinks fit, refer the matter to the Exchequer Court of Canada, and in that event such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted. 54-55 V., c. 35.

12. The Exchequer Court of Canada may on the information of the Attorney-General, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the registry of trademarks, or by an entry made therein without sufficient cause, make such order for making, expunging or varying the entry as the court thinks fit, or the court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the court thinks fit:

2. The said court may, in any proceeding, under this section, decide any question that may be necessary or expedient to decide for the rectification of such register:

3. The registered proprietor of any registered trademark may apply to the Exchequer Court of Canada for leave to add to or alter such mark in any particular, not being an essential particular, and the court may refuse or grant leave on such terms as it may think fit:

4. Notice of any intended application to the court under the last preceding sub-section of this section shall

be given to the Minister of Agriculture, and he shall be entitled to be heard on the application:

5. A certified copy of every order of the court for the making, expunging or varying of any entry in the register of trademarks, or for adding to or altering any registered trademark shall be transmitted to the Minister of Agriculture by the registrar of the court, and such register shall thereupon be rectified or altered in conformity with such order, or the purport thereof shall otherwise be duly entered in the register, as the case may be. 54-55 V., c. 35.

13. On compliance with the requirements of this act and of the rules hereinbefore provided for, the Minister of Agriculture shall register the trademark of the proprietor so applying, and shall return to the said proprietor one copy of the drawing and description with a certificate signed by the Minister or the deputy of the Minister of Agriculture to the effect that the said trademark has been duly registered in accordance with the provisions of this act; and the day, month and year of the entry of the trademark in the register shall also be set forth in such certificate; and every such certificate, purporting to be so signed, shall be received in all courts in Canada as *prima facie* evidence of the facts therein alleged without proof of the signature. 42 V., c. 22, s. 7.

14. A general trademark once registered and destined to be the sign in trade of the proprietor thereof shall endure without limitation:

2. A specific trademark, when registered, shall endure for the term of twenty-five years, but may be renewed before the expiration of the said term by the proprietor thereof, or by his legal representative, for another term of twenty-five years, and so on from time to time; but every such renewal shall be registered before the expiration of the current term of twenty-five years. 42 V., c. 22, s. 10.

15. Any person who has registered a trademark may

petition for the cancellation of the same, and the Minister of Agriculture may, on receiving such petition, cause the said trademark to be so cancelled; and the same shall, after such cancellation, be considered as if it had never been registered under the name of the said person. 42 V., c. 22, s. 13.

16. Every trademark registered in the office of the Minister of Agriculture, shall be assignable in law; and on the assignment being produced, and the fee hereinbefore prescribed being paid, the Minister shall cause the name of the assignee, with the date of the assignment and such other details as he sees fit, to be entered on the margin of the register of trademarks on the folio where such trademark is registered. 42 V., c. 22, s. 14.

17. Every person, other than the person who has registered the trademark, who marks any goods or any article of any description whatsoever, with any trademark registered under the provisions of this act, or with any part of such trademark, whether by applying such trademark or any part thereof to the article itself, or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietor of such trademark, or who knowingly sells or offers for sale any article marked with such trademark, or with any part thereof, with intent to deceive and to induce any person to believe that such article was manufactured, produced, compounded, packed or sold by the proprietor of such trademark, is guilty of a misdemeanor, and liable, for each offence, to a fine not exceeding one hundred dollars and not less than twenty dollars,—which fine shall be paid to the proprietor of such trademark, together with the costs incurred in enforcing and recovering the same:

2. Every complaint under this section shall be made by the proprietor of such trademark, or by some one acting on his behalf and thereunto duly authorized. 42 V., c. 22, s. 16.

18. An action or suit may be maintained by any proprietor of a trademark against any person who uses his registered trademark, or any fraudulent imitation thereof, or who sells any article bearing such trademark or any such imitation thereof, or contained in any package being or purporting to be his, contrary to the provisions of this act. 42 V., c. 22, s. 17.

19. No person shall institute any proceeding to prevent the infringement of any trademark, unless such trademark is registered in pursuance of this act. 42 V., c. 22, s. 4, *part*.

20. Any person may be allowed to inspect the register of trademarks; and the Minister of Agriculture may cause copies or representations of trademarks to be delivered, on the applicant for the same paying the fee or fees hereinbefore prescribed. 42 V., c. 22, s. 18.

21. Clerical errors which occur in the drawing up or copying of any instrument, under the preceding sections of this act, shall not be construed as invalidating the same, and when discovered they may be corrected under the authority of the Minister of Agriculture. 42 V., c. 22, s. 19.

INDUSTRIAL DESIGNS.

22. The Minister of Agriculture shall cause to be kept a book to be called "The Register of Industrial Designs," in which any proprietor of a design may have the same registered on depositing with the Minister a drawing and description in duplicate of such design, together with a declaration that the same was not in use, to his knowledge, by any other person than himself at the time of his adoption thereof; and the Minister, on receipt of the fee hereinafter provided, shall cause such design to be examined to ascertain whether it resembles any other design already registered; and if he finds that such design is not identical with, or does not so closely resemble any other design already registered as to be

confounded therewith, he shall register the same, and shall return to the proprietor thereof one copy of the drawing and description, with a certificate signed by the Minister or the deputy of the Minister of Agriculture, to the effect that such design has been duly registered in accordance with the provisions of this act; and such certificate shall also set forth the day, month and year of the entry thereof in the proper register; and every such certificate purporting to be so signed shall, without proof of the signature, be received in all courts in Canada as *prima facie* evidence of the facts therein alleged. 42 V., c. 22, s. 20.

23. The Minister of Agriculture may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this act, as respects industrial designs, and such rules, regulations and forms circulated in print for the use of the public, shall be deemed to be correct for the purposes of this act; and all documents executed according to the same, and accepted by the Minister, shall be deemed to be valid so far as relates to official proceedings under this act. 42 V., c. 22, s. 21.

24. Every design in order to be protected, shall be registered before publication; and after registration the name of the proprietor, who shall be a resident of Canada, shall appear upon the article to which his design applies, if the manufacture is a woven fabric, by being marked upon one end thereof, together with the letters "Rd."; and if the manufacture is any other substance, the letters "Rd.," with the year of the registration, shall be marked at the edge or upon any convenient part thereof:

2. The mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label containing the proper marks. 42 V., c. 22, s. 23.

25. The author of the design shall be considered the proprietor thereof, unless he has executed the design for

another person, for a good or valuable consideration—in which case such other person shall be considered the proprietor, and shall alone be entitled to register it; but his right to the property shall only be co-extensive with the right which he has acquired. 42 V., c. 22, s. 24.

26. Before any action is taken in relation to an application for registering an industrial design, the following fees shall be paid to the Minister of Agriculture, that is to say:—

On every application to register a design, including certificate....	\$5 00
On every application for an extension of time, including certificate, for each year of such extension.....	2 00
For a copy of each certificate of registration, separate from the return of the duplicate.....	1 00
For the recording of an assignment	2 00
For office copies of documents, not above mentioned, for every hundred words or for a fraction thereof.....	0 50
For each copy of any drawn copy of an industrial design, the reasonable expense of preparing the same:	

And such fees shall be paid over by the Minister of Agriculture to the Minister of Finance and Receiver General:

2. If the Minister of Agriculture refuses to register the industrial design in respect of which application is made, the fee shall be returned to the applicant or his agent, less the sum of two dollars,—which shall be retained as compensation for office expenses. 42 V., c. 22, s. 36.

27. The Minister of Agriculture may refuse to register such designs as do not appear to him to be within the provisions of this act, or any design which is contrary to public morality or order—subject to appeal to the Governor in Council. 42 V., c. 22, s. 34.

28. On the copy returned to the person registering, a certificate shall be given, signed by the Minister of Agriculture or the deputy of the Minister of Agriculture, showing that the design has been registered, the date of registration, the name of the registered proprietor, his

address, the number of such design, and the number or letter employed to denote or correspond to the registration,—which said certificate, in the absence of proof to the contrary, shall be sufficient proof of the design, of the name of the proprietor, of the registration, of the commencement and term of registry, of the person named as proprietor being proprietor, of the originality of the design, and of compliance with the provisions of this act: and generally the writing purporting to be so signed shall be received as *prima facie* evidence of the facts therein stated, without proof of the signature. 42 V., c. 22, s. 32.

29. The exclusive right acquired for an industrial design by the registration of the same as aforesaid shall be valid for the term of five years, but may be renewed at or before the expiration of the said term of five years, for a further period of five years or less, on payment of the fee hereinbefore prescribed, so as that the whole duration of the exclusive right shall not exceed ten years in all. 42 V., c. 22, s. 22.

30. Every design shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing, which shall be recorded in the office of the Minister of Agriculture, on payment of the fees hereinbefore provided; and every proprietor of a design may grant and convey an exclusive right, under any copyright, to make, use and vend, and to grant to others the right to make, use and vend such design, within and throughout Canada, or any part thereof, for the unexpired term of its duration, or any part thereof,—which exclusive grant and conveyance shall be called a license, and shall be recorded in the same manner and within the same delay as assignments. 42 V., c. 22, s. 25.

31. During the existence of the exclusive right (whether it is of the entire or partial use of such design), no person shall, without the license in writing of the registered proprietor, or of his assignee, as the case

may be, apply such design, or a fraudulent imitation thereof, to the ornamenting of any article of manufacture, or other article to which an industrial design may be applied or attached, for the purposes of sale, or shall publish, sell or expose for sale or use any such article as aforesaid, to which such design or fraudulent imitation thereof has been applied; and every one who violates the provisions of this section shall forfeit a sum not exceeding one hundred and twenty dollars, and not less than twenty dollars, to the proprietor of the design, which shall be recoverable, with costs, on summary conviction, by the registered proprietor or his assignee. 42 V., c. 22, s. 26.

32. Every person who places the word "registered," or the letters "Rd.," upon any article for which no design has been registered, or upon any article for the design of which the copyright has expired, or who advertises the same for sale as a registered article, or unlawfully sells, publishes or exposes for sale such article, knowing the same to have been fraudulently marked, or that the copyright therefor has expired, shall, for each offence, on summary conviction, be liable to a penalty not exceeding thirty dollars and not less than four dollars, which shall be recoverable, with costs, by any person who sues for the same; and a moiety of such penalty shall belong to the prosecutor, and the other moiety to Her Majesty, for the public uses of Canada. 42 V., c. 22, s. 27.

33. The Exchequer Court of Canada shall, in respect of the register of industrial designs, have jurisdiction in a like proceeding and manner as hereinbefore provided in respect of the register of trademarks, to make orders for the making, expunging or varying any entry in such register of industrial designs, or for adding to or altering any industrial design. 54-55 V., c. 35.

34. The Minister of Agriculture shall, after due service of such order and payment of the fee hereinbefore

provided, cause such alteration to be made in the register respecting industrial designs as is directed by the order made under the next preceding section. 42 V., c. 22, s. 30.

35. A suit may be maintained by the proprietor of any design for the damages he has sustained by the application or imitation of the design, for the purpose of sale, against any person so offending—if the offender was aware that the proprietor of the design had not given his consent to such application. 42 V., c. 22, s. 28.

36. All proceedings under the preceding sections of this act, respecting industrial designs, shall be brought within twelve months from the commission of the offence, and not afterwards; and none of the provisions of the said sections shall apply to protect any design which does not belong to a person resident within Canada, and which is not applied to a subject matter manufactured in Canada. 42 V., c. 22, s. 31.

37. Any person may be allowed to inspect the register of industrial designs; and the Minister of Agriculture may cause copies or representations of industrial designs to be delivered, on the applicant for the same paying the fee which is deemed sufficient for the purpose of having the same copied or represented. 42 V., c. 22, s. 33.

38. Clerical errors which occur in the drawing up or copying of any instrument respecting an industrial design, shall not be construed as invalidating the same, but, when discovered, they may be corrected under the authority of the Minister of Agriculture. 42 V., c. 22, s. 35.

RULES AND FORMS OF THE DEPARTMENT OF
AGRICULTURE RESPECTING "THE
TRADEMARK AND DESIGN ACT."

APPROVED BY THE GOVERNOR IN COUNCIL, ON THE 9TH OF
MAY, 1887.

GENERAL RULES.

I.

There is no necessity for any personal appearance at the Department of Agriculture, unless specially called for by order of the Minister or the Deputy, every transaction being carried on by writing.

II.

In every case the applicant or depositor of any paper is responsible for the merits of his allegations and of the validity of the instruments furnished by him or his agents.

III.

The correspondence is carried on with the applicant, or with the agent who has remitted or transmitted the papers to the office, but with one person only.

IV.

All papers are to be clearly and neatly written on *fools-cap* paper and every word of them is to be distinctly legible, in order that no difficulty should be met with in the taking cognizance of and in the registering and copying them.

V.

All communications to be addressed in the following words:—*To the Minister of Agriculture, (Trademark and Copyright Branch), Ottawa.*

VI.

As regards proceedings not specially provided for in the following forms, any form being conformable to the letter and spirit of the law will be accepted, and if not so conformable will be returned for correction.

VII.

A copy of the Act and the Rules with a particular section marked, sent to any person making an inquiry, is intended as a respectful answer by the office.

TRADEMARKS.

VIII.

An application for the registration of a *General Trademark* shall be made *in duplicate* after the following form:—

*To the Minister of Agriculture,
(Trademark and Copyright Branch),
Ottawa.*

I, (*name of person*) of the (*City, Town or other locality, as the case may be*), in (*name of County, Province or State, as the case may be*), hereby furnish a duplicate copy of a General Trademark, in accordance with Sections 4 and 9 of "The Trademark and Design Act," which I verily believe is mine, on account of having been the first to make use of the same (*or on account of having acquired it from, naming the person, whom I verily believe to be the original proprietor thereof*).

The said General Trademark consists (*here must be inserted a*

description of the Trademark, recital of the Motto or Mottoes, &c., &c., in order to explain the pattern furnished), and I hereby request the said General Trademark to be registered in accordance with the law.

I forward herewith the fee of \$30, in accordance with Section 10 of the said Act.

In testimony thereof, I have signed in the presence of the two undersigned witnesses, at the place and date hereunder mentioned.

(Place and date.)

(Signature of Proprietor.)

Signature of the two witnesses. }

IX.

An application for the registration of a *Specific Trademark* shall be made *in duplicate*, after the following form:—

To the Minister of Agriculture,

*(Trademark and Copyright Branch),
Ottawa.*

I, (*name of person*) of the (*City, Town or other locality, as the case may be*), in (*name of County, Province or State, as the case may be*), hereby furnish a duplicate copy of a *Specific Trademark*, to be applied to the sale of (*description of the class of Merchandise*), in accordance with Sections 4 and 9 of "The Trademark and Design Act," which I verily believe is mine, on account of having been the first to make use of the same (*or on account of having acquired it from, naming the person, whom I verily believe to be the original proprietor thereof*).

The said *Specific Trademark* consists (*here must be inserted a description of the Trademark, recital of the Motto or Mottoes, &c., &c., in order to explain the pattern furnished*), and I hereby request the said *Specific Trademark* to be registered in accordance with the law.

I forward herewith the fee of \$25, in accordance with Section 10 of the said Act.

In testimony thereof, I have signed, in the presence of the two undersigned witnesses, at the place and date hereunder mentioned.

(Place and date.)

(Signature of Proprietor.)

Signature of the two witnesses. }

INDUSTRIAL DESIGNS.

X.

An application for the registration of an Industrial Design shall be made *in duplicate*, after the following form:—

*To the Minister of Agriculture,
(Trademark and Copyright Branch),
Ottawa.*

I, (*name of the person*) being a resident of Canada, and now residing in the (*City, Town or other locality, as the case may be*), in the (*name of the Province, as the case may be*), hereby declare that I am the proprietor of the Industrial Design of which duplicate copies are herewith forwarded, and which consists (*here insert a description of the design, and an explanation of its use*), and I hereby request that the said Industrial Design be registered in accordance with the law.

I forward herewith the fee of \$5, in accordance with Section 26 of "The Trademark and Design Act."

In testimony thereof, I have signed, in the presence of the two undersigned witnesses, at the place and date hereunder mentioned.

(*Place and date.*)

(Signature of the Proprietor.)

Signature of the two witnesses. }

NOTICE.

The correspondence with the Department is carried through the Canadian Mail, free of postage.

The forwarding of any paper should always be accompanied by a letter, and a separate letter should be written in relation to each distinct subject.

It is particularly recommended that reference should be made to the law, before writing on any subject to the Department in order to avoid unnecessary explanations and useless loss of time and labor: *and it is also recommended, in every case, to have the papers and drawings prepared by a competent person, for the interest both of the applicant and of the public service.*

A sufficient margin should be left on every paper, and specially on specifications and assignments, for the insertion of references or certificates, and for the affixing of the seal thereto.

It must be remembered that the better the papers are executed, the sooner the work is despatched at the office, and the surer the regularity of the proceedings is guaranteed.

APPENDIX J.

FORMS OF BILLS AND ANSWERS.

DECLARATION.

(Warner v. Roehr, Fed. Case No. 17189A.)

In the Circuit Court of the United States in and for the
Northern District of Illinois.

HULBERT H. WARNER, trading and doing business under the name and style of H. H. WARNER & Co., vs. FRANK ROEHR.	} No. 18765. Case. Damages, \$25,000.
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H. H. W., a citizen of the state of New York, trading and doing business under the firm name and style of H. H. W. & Co., at the city of Rochester, in the county of Monroe, in said state of New York, plaintiff, by W. H. B. and J. F. L., his attorneys, complains of F. R., a citizen of the state of Illinois, and residing and doing business at the city of Chicago, in the county of Cook, in the said state of Illinois and in the district aforesaid, defendant, of a plea of trespass on the case.

For that whereas, the said plaintiff shows that for several years last past he has been engaged, at the said city of Rochester, in the manufacture and sale of a certain medicinal preparation known as "Warner's Safe Kidney and Liver Cure," which preparation has become widely known through the domain of commerce, and especially in all parts of the United States, as a valuable medicine for various kinds of diseases of human beings.

That in the introduction of said medicinal preparation, and to bring it to the attention of the public, he expended in advertising the sum of about five hundred thousand dollars (\$500,000), and in various ways has expended enormous sums of money to that end; that for a better protection of his right as proprietor, manufacturer and vendor of said medicine he has caused peculiar bottles to be manufactured to contain the same, which bottles have blown into the glass thereof the name of said medicine, and which name contains a word-symbol, to wit, the word "Safe," as the essential element of a trade mark, and also the symbolic "trademark" consisting of the representation of a fire-proof safe; which said "trademark" is his sole property, no other person, firm or corporation having a right to the use of the same, either in the

identical form or in any such near resemblance thereto as might be calculated to deceive, nor to affix to medicine or merchandise of substantially the same descriptive properties as his medicine aforesaid.

That being the owner of said "trademark," by virtue of priority of adoption, in connection with said medicine, this plaintiff caused the same to be recorded in the Patent Office of the United States, with a statement specifying his name, domicile, location and citizenship; the class of merchandise and the particular description of goods comprised in the class to which the particular "trademark" had been appropriated by him; also a description of the "trademark" itself with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods and the length of time during which the said "trademark" has been used by him for the purpose aforesaid.

Plaintiff further shows that he paid into the treasury of the United States the sum of twenty-five dollars (\$25.00) and complied with the regulations prescribed by the commissioner of patents as provided in the act of congress entitled "An act to authorize the registration of trademarks and protect the same," approved March 3, 1881, as will more fully appear by reference to the certificate of registry of said trademark, numbered 9597, dated the 8th day of August, 1882, signed by E. M. Marble, commissioner of patents, and attested by the seal of the Department of the Interior, which certificate is hereto attached and made part of this declaration.

Plaintiff further shows that said "trademark" is applied and affixed to goods by blowing it in the glass, as aforementioned, and by printing it on paper, which in the form of labels is afterwards pasted on the bottles containing the medicine, and it is also printed on wrappers, or otherwise affixed to packages to be used in any manner calculated to notify purchasers of the contents and to guard against fraud.

This plaintiff shows that he is the sole owner by right of priority of adoption and use of a certain other trademark consisting of a fac-simile of his firm signature, "H. H. Warner & Co.," which said latter-mentioned "trademark" is printed on a separate label, and pasted over the cork of each bottle, after the same has been filled with said medicine.

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trademark entitled "Book of \$2,000.00 Prize Enigmas," containing the representation of a man, representing a botanist standing beside a palm tree examining a plant through a magnifying glass, and other matters not necessary to be here mentioned, all the same being printed on the cover of a pamphlet.

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trademark representing the front of a fire-proof safe, in the central part of which is shown a negro, on one knee gathering herbs, above whom are the words, "Warner's Safe," and below him are the words, "Kidney and Liver Cure."

Plaintiff further shows that for the purpose of guarding against fraudulent imitations of his said medicine, and to authenticate the

genuineness of goods of his manufacture, he caused, and still causes, each bottle of the same to have wrapped about it a pamphlet bearing his said trademarks with loose circulars between the leaves of said pamphlet, and wrapped about the same another printed circular, printed in several different languages; which said pamphlet contained a great many testimonials of the intrinsic value of said medicine as a remedy for various diseases and disorders, and also fac-similes of the signatures of the signers of said testimonials; and said pamphlet containing, among other matters, a great many enigmas for the solution of which large prizes were offered by the plaintiff. That as a further precaution against fraud, and as a means of identification, the said medicine is packed in wooden boxes, which boxes contain each one dozen bottles of plaintiff's medicine labeled and wrapped as aforesaid, and bearing upon one side of the boxes the following printed words: "One Dozen Warner's Safe Kidney and Liver Cure, Manufactured by H. H. Warner & Co., Rochester, N.-Y."

And the said plaintiff further shows that he has ever since the dates of the adoption of the said trademarks been and now is solely entitled to all the rights, interests and privileges thereby so secured unto him; and that the said medicine with the accompanying trademark has been extensively introduced to public use, and that large quantities thereof, to wit, several millions of bottles, have been purchased and consumed by the public for which he has received several millions of dollars, and that he would but for the wrongful acts of the said defendant, Frank Roehr, have made further large gains, profits and advantages from the manufacture and sale of said medicine. And plaintiff further shows that heretofore, to wit, on or about the — day of October, A. D. 1883, at the city of Chicago, in the district aforesaid, the said defendant Frank Roehr, well knowing the premises, and the rights and privileges theretofore secured unto him the said plaintiff, and in order to deprive him of his profits, benefits and advantages which might and otherwise should and would have accrued to him at the said district, and elsewhere, unlawfully, unjustly, and wrongfully simulated the various aforesaid trademarks, circulars, labels, wrappers, packages and boxes, in which said genuine medicine of this plaintiff has been put up for the purposes of commerce, and for the purpose of carrying into execution his nefarious enterprise in that respect, the said defendant, F. R., employed large capital, and a large number of assistants, including printers, electrotypers, photographers, and other persons skilled in the arts necessary for the accomplishment of his unlawful purpose aforesaid, and did make exact representations of the genuine trademarks, labels, etc., hereinbefore described, so closely resembling the genuine as to be calculated to deceive purchasers, and which in many instances did actually deceive purchasers, who supposed that they were buying the genuine medicine manufactured as aforesaid by this plaintiff, when in fact the simulated packages contained only a base fluid, colored to resemble the genuine medicine of the plaintiff.

Plaintiff further shows that said defendant, F. R., manufactured

large quantities of packages made in exact representation of this plaintiff's genuine packages and containing inside thereof the simulated labels, wrappers, etc., hereinbefore described, and bottles filled with a fluid purporting to be this plaintiff's genuine medicine, but which in fact was not so, but only a base imitation thereof, and offered for sale at the district aforesaid and elsewhere, and did sell large quantities of the same, all of which said wrongful acts of said defendant, F. R., were done without the knowledge, consent or acquiescence of the said plaintiff, and with the intent to injure and defraud him, to the damage of this plaintiff of twenty-five thousand dollars (\$25,000), and therefore he brings this suit.

W. H. B.,

J. F. L.,

Plaintiff's Attorneys.

Indorsed: Filed Dec. 6, 1883, Wm. H. Bradley, Clerk,

BILL OF COMPLAINT.

(Taylor v. Carpenter, 3 Story, 458.)

To the Judges of the Circuit Court of the United States for the District of Massachusetts:

J. T. and W. T., of the borough of Leicester, in that part of the United Kingdom of Great Britain and Ireland called England, manufacturers, subjects of Victoria the First, queen of said kingdom, and aliens to each and all of the United States of America, and the territories and districts thereof, bring this bill of complaint against D. C. of F., in the said district of Massachusetts, manufacturer, a citizen of the said state of Massachusetts. And thereupon the said J. T. and W. T., complaining, say that for many years past they have been very extensively engaged in manufacturing cotton thread at Leicester aforesaid, and vending the same in large quantities, not only in England, but throughout the United States, and in particular in the city of B., in said district. That their said thread is, and for many years has been, put up for sale on spools, and labeled on the top of the spools "Taylor's Persian Thread" in a circle, in the center of which is the number of the thread, and on the bottom of some of the spools "J. & W. Taylor, Leicester," and on the bottom of others, "J. & W. Taylor," with the number of yards of thread on each spool, each spool usually containing two hundred yards or three hundred yards of thread, and the spools containing two hundred yards being black and labeled "200 yds." on the bottom of the spool, and those containing three hundred yards being red, and labeled "300 yds." on the bottom of the spools. And on the center of some of the said labels on the bottom of each spool is stamped the symbol or print of the head and forepart of a lion rampant. And on the center of other of said labels is stamped a coat-of-arms, the shield whereon contains a lion rampant, and over the same

three balls with the motto "In Deo Confido." And your orators further say that their spools so marked, stamped, colored, or labeled as aforesaid, are put up for sale in paper envelopes, each containing one dozen of spools; which said envelopes are prepared and stamped by your orators for said purpose, and some of said envelopes bear in raised letters stamped on them the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on the top of each spool, Taylor's Persian Thread, and on the bottom J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor." And on other of the said envelopes is stamped a coat-of-arms representing a shield, the upper division of which is gilt, and contains three red balls, and the lower division thereof is red and contains the effigy of a lion rampant, with the motto under the same, "In Deo Confido." Your orators further show unto your honors that their said thread has been and is manufactured of various sizes and numbers, to meet the wants of the trade; and by means of the care, skill and fidelity with which your orators have conducted the manufacture thereof for a series of years, their said thread has acquired a great reputation in the trade throughout the United States, and large quantities of the same are constantly required from your orators to supply the regular demand for the consumption of the country. And your orators have established agencies for the sale thereof to the wholesale dealers and jobbers in the cities of B., N. Y., P. and N. O., and in addition thereto your orators employ B. W., now residing in said city of N. Y., as their general agent for the United States, in relation to the sale of their said spool sewing cotton thread; and a mercantile firm of H. & C. are the agents of your orators for the sale of the same in the city of B.; and your orators further show unto your honors that their said thread is known and distinguished by the trade and the public as "Taylor's Persian Thread," and that your orators were the original manufacturers thereof, and the first who introduced the same to the public. That your orators' said general agent, on or about the first day of March last past, hearing that complaints were made of the quality of "Taylor's Persian Thread," proceeded to investigate the cause of said complaint and thereupon ascertained that a spurious article of spool sewing cotton thread was offered for sale by sundry jobbers in the said city of B., as and for your orators' "Persian Thread," and that such complaints had arisen from the fraudulent imposition of such spurious article on the public. Your orators further show unto your honors that their said agent further ascertained upon inquiry, and your orators charge the facts to be, that the said spurious thread so sold and offered for sale in the said city of B., or some of it, was furnished to the said jobbers by D. C., either by him personally or by one F. D. E., of B., his agent in that behalf, and your orators are informed and believe that the said D. C. has sold the said thread, put up, marked and designated as aforesaid, in the said city of B.; that the said D. C., disregarding the rights of your orators, and fraudulently designing to procure the

custom and trade of persons who are in the habit of vending or using your orators' said "Persian Thread," and to induce them and the public to believe that his said thread was in fact manufactured by your orators, had engaged extensively in the manufacture of sewing cotton thread, and caused the same to be put up for sale in envelopes and on spools similar to those used by your orators, and so colored and stamped and labeled as to resemble exactly the said spools and envelopes used by your orators. And the said spool sewing cotton thread, prepared by the said D. C. and sold by him, and which he is engaged in selling as aforesaid, is an exact imitation of the same article which your orators had been manufacturing as aforesaid, and selling in the United States for many years before the said D. C. commenced his said fraudulent imitation thereof. And the said spurious article, although inferior in quality to the genuine Persian Thread manufactured by your orators, can only be distinguished therefrom, so exact is the said D. C.'s imitation as aforesaid, by a careful examination of its quality, and by its falling short in the number of yards contained on each spool from the number marked thereon as the contents thereof. And that the general appearance of the spurious article is the same as that of your orators' genuine thread, and well calculated to deceive those dealing in the purchase and sale thereof. Your orators further show unto your honors that their said general agent has obtained specimens of the said spurious Persian Thread so sold by the said D. C. That in some of the specimens thus obtained, the thread is put upon black spools, and in other of said specimens the thread is put upon red spools, and said black and red spools are of the same size and appearance with those used by your orators, on the top of which spurious spools there is pasted a round paper label, partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center of the circle the number of the thread; and on the other end on the bottom of such spurious spools there is pasted a round paper label on some of which is printed in a circle the words, "J. & W. Taylor, Leicester," and on others. "J. & W. Taylor," with the number of yards of thread on the spools, and across others of the labels on said black spools the letters and figures "200 yds.," and on said red spools the letters and figures "300 yards" are printed, and in the center of the said label there is impressed the figure or symbol of the head and forepart of a lion rampant. And in other of said specimens the thread is put on spools corresponding in all particulars to those herein just before described, except that the labels on the bottom thereof bear a coat-of-arms, the center of the shield whereof contains a lion rampant, with three balls over the same, and with the motto under, "In Deo Confido." Your orators have also obtained specimens of the envelopes in which said D. C.'s spurious thread is put up and sold by him or his agents, which bear the same inscription, letters and stamps that those used and employed by your orators bear. And in all these particulars of the labels on each end of the said spurious spools of thread, and the envelopes in which they are put up, they are exactly

like the envelopes and the labels on the respective ends of the spools of your orators' genuine Persian Thread, as hereinbefore stated. Your orators further show unto your honors that they have not yet ascertained the extent to which the said D. C. has carried his said fraudulent imitation and sale of your orators' said thread. But your orators' said general agent has found the same offered for sale to the trade in at least six wholesale or jobbing houses in the city of B., as "Taylor's Persian Thread"—from which your orators believe, and they therefore charge, on their belief, that the said D. C. has been and is engaged in selling his said fraudulent and spurious imitation of your orators' "Persian Thread" to a large extent in various places in the United States, with intent that the same should circulate and be received and used by the public as Taylor's genuine "Persian Thread." And your orators further show unto your honors that the fraudulent and inequitable conduct of the said D. C. is not only injuring them in the sales of their said genuine "Persian Thread," and the profits which they would otherwise reasonably make thereon, but by the inferior quality and false measure the said spurious "Persian Thread" is greatly prejudicing the reputation of your orators' said "Persian Thread" in the market, and, unless the said imitation is discontinued or prevented, will ultimately destroy the character and standing of the genuine article. And your orators also charge that the said spurious article is a fraud and deception upon such of the citizens of the state of Massachusetts, and of the United States, as purchase the same, believing it to be the genuine article manufactured by your orators. And your orators further show unto your honors that in the month of March last past, having discovered a portion of the aforesaid fraudulent conduct of the said D. C., your orators did file their bill of complaint before the chancellor of the state of New York, wherein they set forth many of the facts which are in substance hereinbefore stated, and prayed for an injunction to restrain the said D. C. from the aforesaid fraudulent use of the name and trademarks of your orators, and the same was granted by the court; and the said D. C. having appeared and filed his answer to the said bill, did therein admit that he had used the name and trademark of your orators in manner set forth in the bill aforesaid; but denied that the article manufactured by him was of inferior quality to that manufactured by your orators; and afterwards an application was made to the chancellor to dissolve the injunction aforesaid, which last mentioned motion is now before the said chancellor, and by reason of the great number of causes depending before him, the aforesaid cause cannot be decided without great delay. And your orators are informed and believe it to be true that the said D. C., residing out of the jurisdiction of the chancellor of the state of New York, can, with impunity, disregard the injunction aforesaid, and that he has continued to make sales in the city of B. and elsewhere of the said thread, put up, labeled, and appearing precisely like that made, put up, and sold by your orators, and your orators continue to be greatly injured thereby.

In consideration whereof, and for as much as your orators are remediless in the premises at common law, and cannot have adequate relief save by the aid and interposition of this court, to the end, therefore, that the said D. C., if he can, show why your orators should not have the relief hereby prayed, and may upon his corporal oath, and according to the best and utmost of his knowledge, remembrance, information and belief, full, true, direct and perfect answers make to the several interrogatories hereinafter numbered and set forth; and the said D. C. and his attorneys, solicitors, counselors, agents and servants may be enjoined and restrained from manufacturing, selling or offering for sale, directly or indirectly, any spool cotton sewing thread manufactured by him or any person other than your orators, under the denomination of "Taylor's Persian Thread," or on spools with the words, "Taylor's Persian Thread," or "J. & W. Taylor, Leicester," or "J. & W. Taylor," printed, painted, written, or stamped, or attached or pasted thereon, or with your orators' said device of a lion rampant, or with their said coat-of-arms thereon; or on spools so made or having any label, printing or device thereon, in such manner as to be colorable imitations of your orators' said spool thread, usually known as "Taylor's Persian Thread," and that the said D. C. may be decreed to account to your orators for all the profits which he has made by the sale of his said fraudulent imitation of your orators' thread, and all the profits which your orators would have made on the sales of their genuine thread but for the said D. C.'s inequitable and wanton piracy of their said name, spools and labels; and that your orators may have their costs and charges in this behalf paid by the said D. C.; and that your orators may have such other and further relief in the premises as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

May it please your honors to grant unto your orators a writ of injunction, issuing out of and under the seal of this court, to be directed to the said D. C., his attorneys, solicitors, counselors, agents and servants, therein and thereby commanding and enjoining them, under a certain penalty in the said writ to be expressed, according to the foregoing prayer of your orators.

May it also please your honors to grant unto your orators a writ of subpoena, issuing out of and under the seal of this court, to be directed to the said D. C., commanding him on a certain day and under a certain penalty in the said writ to be inserted, personally to be and appear before your honors in this honorable court, then and there to answer the premises, and to stand to, abide by, and perform such order and decree therein as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

C. P. C., of Counsel.

C. P. and B. R. C.,
Solicitors.

J. & W. T.,

By W. B., their Agent
and Attorney.

United States of America, } ss.
 District of Massachusetts, }

Personally appeared before me the above-named B. W., on this second day of December, A. D. 1843, and made oath that this bill in equity by him signed, in as far as it states matters within his knowledge, is true to his knowledge, and in as far as it states matters within his belief, is true to his best belief.

W. W. S., Commissioner, etc.

Interrogatories to be answered by D. C.:

1. Whether or not have you manufactured and sold, in Massachusetts or elsewhere, thread put upon black spools, on one end of each of which spools is pasted, or otherwise fastened, a circular paper label partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center thereof the number of the thread, and on the other end of each of said spools is pasted or otherwise fastened a circular white paper label, on which is printed in a circle the words "J. & W. Taylor, Leicester," and across the same label "200 yds.," and in the center of the same label there is impressed the figure or symbol of a lion rampant?

2. Whether or not you have manufactured and sold, in Massachusetts or elsewhere, thread put upon red spools, corresponding in all respects to the black spools described in the preceding interrogatory, except in the color of the spool and in the quantity of thread thereon; and in the letters and figures "300 yds." printed across the said white paper label?

3. What number of each kind of the said spools of thread have you manufactured and sold? State the same accurately, and distinguish the kind and number of the thread, and the number of black spools and the number of red spools so sold by you since you commenced selling the same, and the times when and the places where the same have been sold.

4. What have been the profits made or realized by you on the manufacture and sale of thread put upon spools colored, decorated and fitted up in the manner described in the first and second interrogatories?

5. To whom and what persons in particular have you sold the said thread put up in the manner described in the first and second interrogatories?

6. Who is, and who has been, your agent in Boston for the sale of your thread put upon spools fitted up in the manner described in the first and second interrogatories?

7. Whether or not did you admit in an answer signed, sworn to and filed by you in the court of chancery in and for the state of New York, to a bill of complaint therein pending wherein the said J. T. and W. T. are complainants, and yourself is defendant, that you have engaged in the manufacture of sewing cotton thread, which you have caused to be put up for sale on spools similar to those used by

the complainants, and so colored, stamped and labeled as to resemble exactly or as nearly as the same could be done, the said spools used by the complainants, and the said spool sewing cotton, which has been prepared and sold by you, is an exact imitation of the same article which the complainants had been selling in the United States many years before you commenced manufacturing your thread?

8. Whether or not have you manufactured and sold in Massachusetts sewing cotton thread upon black spools and upon red spools, on one end of each of which is fastened a circular paper label, described as in interrogatory numbered 1, and on the other end is fastened a circular paper label on which is stamped a coat-of-arms, the shield whereof contains a lion rampant, and over the same three balls, with the motto under the shield, "In Deo Confido," and around said shield is printed in some of said labels, "J. & W. Taylor, Leicester," and in others, "J. & W. Taylor," with the number of yards on said spools?

9. Whether or not have you put up and sold your sewing cotton thread, colored, stamped and labeled in all or some of the modes described in this bill in envelopes or wrappers, some bearing in raised letters the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on top of each spool Taylor's Persian Thread and on the bottom J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor," and others bearing a coat-of-arms, the upper division of which is in gilt, and has three red balls thereon, and the lower division is red, and has a lion rampant thereon.

C. P. and B. R. C.

Solicitors.

BILL OF COMPLAINT.

(Carson v. Ury, 39 Fed. Rep. 777.)

In the Circuit Court of the United States for the Eastern Division
of the Eastern Judicial District of Missouri.

JAMES CARSON, Complainant,

vs.

HENRY URY, HARRIET URY, RICHARD
URY, ERSKINE MANSFIELD and A.
BELINER, Defendants.

} In Equity.

J. C., a resident and citizen of the city of New York, in the state of New York, files this his amended bill of complaint, under leave of court had and obtained, against the above defendants, H. U., H. U., R. U., E. M. and A. B., all of whom are citizens of the state of Missouri and residents of the city of St. Louis, in the eastern division of the eastern judicial district of the said state, and thereupon your orator complains and says:

First. That your orator for more than seven years has been and now is a member of the Cigar Makers' International Union of America; that the members of said union are severally cigar makers residing in the United States, and said union is a voluntary unincorporated association of practical cigar makers formed for the purpose of promoting the mental, moral and physical welfare of the members, by assisting them to obtain labor at remunerative wages, by affording them pecuniary aid in case of sickness and providing money in case of death, and generally to maintain a high standard of workmanship and fair wages of cigar makers.

Second. That the question which is the subject of this action is one of common and general interest to all members of the Cigar Makers' International Union of America, and that they are very numerous, being over twenty-five thousand in number, and that it is impracticable, therefore, to bring them all before the court in this action.

Third. That as your orator is informed and believes, for the purpose of designating the manufacturing of members of the Cigar Makers' International Union of America, the said union through its delegates in convention assembled in Chicago in the month of September, 1880, devised and adopted a trademark, or label to which they gave the name of "Union Label," a fac-simile of which is annexed hereto and marked "Exhibit A;" that prior to the adoption of said label the same had not been known or in use in this country or elsewhere, and ever since said adoption the members of the Cigar Makers' International Union of America have exclusively used said labels, and the same have been conspicuously posted on the outside of cigar boxes containing cigars made by the members of said Cigar Makers' International Union of America.

Fourth. That the members of said union are by the constitution and laws of said union allowed to make and sell cigars, and to use on such cigars so made and sold by them labels like said "Exhibit A," provided they do not employ others to make said cigars; and that your orator for about two years last past has been making and selling cigars in the city of New York aforesaid and has used there the labels like said "Exhibit A," and has built up a profitable trade for himself under said label, and that your orator was the owner of the cigars which he thus made and sold under said label to the public.

Fifth. That the said label affixed to cigar boxes is intended as a guaranty that the cigars therein contained are manufactured by members of the Cigar Makers' International Union of America, and that good and clean workmanship has thereby been secured; and that the cigars were not made in tenement houses or state prisons or by coolies, and for these reasons the cigars so labeled command a higher price in the market than cigars of similar appearance, but without such label, can command; that there is a large demand among the public for cigars having said label, which demand has been growing every year since the organization of said union, and the use of said label

has been and is a source of great profit and advantage to your orator and to the other members of said union.

Sixth. That it is the practice of said union to furnish gratuitously copies of the genuine label marked "Exhibit A" to all manufacturers of cigars in the United States who employ exclusively members of the said union, who themselves own and sell the cigars which they make.

Seventh. That the wages demanded and received by the members of said union, are about three dollars higher per one thousand cigars than the wages demanded and received by other workmen, and that union-made cigars, that is, boxes of cigars carrying the said labels, bring in the market about three dollars more per thousand than such cigars would bring without such labels; that this is the case because the cigars bearing said labels are known to the public to be made by competent workmen in clean and healthy shops.

Eighth. That by the use of said genuine labels as aforesaid, your orator and other members of said union have made great profits and the public is protected from impure and unhealthy cigars.

Ninth. That said union does not issue labels to manufacturers employing tenement house labor, or prison labor, or coolie labor, or who do not pay the required scale of wages demanded by said union, and that said union does not sell any such labels either to manufacturers or to the public.

Tenth. That as your orator is informed and believes, since the adoption and use of said label by said union, and since the time when your orator commenced to sell cigars bearing said genuine label, the said defendants have conspired and federated together to cheat and defraud your orator and the members of said union so using said label as aforesaid, and fraudulently impose upon manufacturers and dealers in cigars and upon the public by manufacturing and offering for sale and selling and giving away for use on cigar boxes, labels which are spurious and counterfeits of said genuine labels, and in furtherance of this fraudulent and illegal business have adopted the name "B. Alberts." That your orator is informed and believes that the said name of B. Alberts is fictitious and that there is no person of that name, but that the same was first adopted by defendant B.; but however this may be, your orator further says that said defendants under said name have manufactured, offered for sale and sold spurious and counterfeit labels for use as aforesaid—a copy of which said spurious and counterfeit label is hereto annexed, marked "Exhibit B." That the spurious label so offered and given away and sold by said defendants under the said name of B. Alberts is a close imitation and counterfeit of the genuine adopted by said union as aforesaid. That the said defendants have also lately inserted an advertisement in the United States Tobacco Journal, a newspaper published in the city of New York, state of New York, and in other publications, representing to the public that they had for sale copies of said genuine label, issued by authority of said Cigar Makers' Inter-

national Union of America, and containing a representation of such label. All of which acts of said defendants are done without the authority or permission of your orator or the officers and members of said union, and against its will and protest. That in furtherance of said fraudulent and illegal purposes, and with the intent to cheat and defraud as aforesaid, said defendants have published a fictitious address, in said name of B. Alberts as aforesaid, to wit: No. 222 Pine street, in the city of St. Louis, there being no person by the name of B. Alberts at said address, and have caused all mail there received in answer to their advertisements to be delivered to the place of business of said defendants, H. U. and H. U., with whom, as your orator is informed, the other defendants are associated at No. 304 North Main street, in the city of St. Louis.

Eleventh. That said wrongful and fraudulent acts of said defendants, and their continuation, are calculated to deceive and mislead and do deceive and mislead the public into the belief that said defendants have authority from said union to sell or give away said genuine labels, and further tend to deceive the public into the belief that the cigars thus labeled by the purchasers of said labels from the defendants are the cigars made and sold by your orator and such other makers of cigars as have authority to use the genuine label of said union; and they further tend to deceive the public into the belief that the false and spurious labels sold and offered for sale, or given away by said defendants, are the genuine labels of said union.

Twelfth. That your orator has, and the other members of said Cigar Makers' International Union of America have, a valued and pecuniary interest in the genuine labels issued by said union, and used by the members thereof, and that he has, and they have, suffered irreparable damage by the wrongful acts of said defendants, and that, if suffered to continue, the wrongful acts of said defendants will tend to produce further irreparable damage to your orator and to the other members of said Cigar Makers' International Union of America.

Thirteenth. That your orator has no adequate remedy at law for said injury.

Fourteenth. That said injury cannot be adequately compensated in money, but your orator alleges that the matters in dispute and injury to him, exclusive of interest and costs, exceed the sum of two thousand dollars.

Fifteenth. That as your orator is informed and believes, one or more of said defendants, prior to the commencement of said wrongful acts, were members of said union and well acquainted with its constitution, by-laws and practice, but are not now members of said union.

Sixteenth. And your orator further shows unto your honors on information and belief, that said defendants have made and sold, and caused to be made and sold, large quantities of said labels, and have large quantities on hand, which they are now offering for sale, and have made and realized large profits and advantages therefrom; but

to what extent and how much exactly your orator does not know and prays a discovery thereof; and that said labels have been used by many manufacturers of cigars in the sale of cigars which were not made by your orator or by any member of the Cigar Makers' International Union of America.

Seventeenth. And your orator further says that the use and sale of said labels by said defendants, and their preparation for and avowed determination to continue the same, and their other aforesaid and unlawful acts in disregard and defiance of your orator, have the effect to and do encourage and induce others to disregard your orator's rights in the premises.

And your orator prays that said defendants, H. U., H. U., R. U., E. M. and A. B., their servants, agents, attorneys and workmen, and each and every of them, may be restrained and enjoined provisionally and perpetually, by the order and injunction of this honorable court, from directly or indirectly making, using, vending, delivering or in anywise counterfeiting or imitating said genuine label of the Cigar Makers' International Union of America, or from making, selling or offering for sale or giving away any labels like or similar to those issued by said Cigar Makers' International Union of America, and that the defendant may be decreed to pay the costs of this suit, and that your orator may have such further or such other relief as to this honorable court shall seem meet and as shall seem agreeable to equity.

An answer under oath is hereby expressly waived.

May it please your honors to grant unto your orator the writ of injunction, as well provisional as perpetual, issuing out of and under the seal of this honorable court, commanding, enjoining and restraining said defendants, H. U., H. U., R. U., E. M. and A. B., commanding them by a certain day and under certain penalty to be and appear in this honorable court then and there to answer the premises and to stand to and abide such order and decree as may be made against them.

And your orator will ever pray, etc.

A. K., of Counsel.

B., S. & K.,
Complainants' Solicitors,
with whom are H. O. & J.

STATE OF NEW YORK, }
Southern District of New York, } ss.
City and County of New York, }

J. C., being duly sworn, says that he is the complainant named in the foregoing complaint, that he has read said complaint, and that the allegations contained therein are true except those which are stated therein to be alleged on information and belief, and as to those he believes said complaint to be true.

Sworn to before me this 23d day of March, 1889.

H. M. T.,

Notary Public of New York County.

BILL OF COMPLAINT.

(McLean v. Fleming, 96 U. S. 245.)

To the Judges of the Circuit Court of the United States within and for the District of Missouri.

C. F. of Pittsburg, in the State of Pennsylvania, a citizen of said State, brings this his bill of complaint against J. H. McL., of St. Louis, in the Eastern District of Missouri, and a citizen of the State of Missouri, and thereupon your Orator complains and says that he is now, and for the last sixteen months has been extensively engaged individually in the manufacture of a certain pill, designated and known in trade and by public advertisement, and by dealers and consumers as "Dr. C. McLane's Liver Pills," and that said pills have become very extensively known and used in the United States and in other countries.

Your Orator states further that said pills were first made and sold by Dr. Charles McLane, at Morgantown, Virginia, where said McLane resided—that said McLane was the original and exclusive inventor and proprietor of said pills, and first made and sold the same by the name and description of "Dr. McLane's Liver Pills," and by that name they were known and designated and were made and sold only by said Dr. Charles McLane, till June 19th, 1844, when said McLane, by bill of sale of that date, sold his interest therein to one J. K. of Pittsburg, Pennsylvania, giving said K. the right to make and vend the same in the United States, reserving only the privilege of making and vending the same himself in Morgantown, aforesaid, as will appear by said bill of sale, a copy of which is herewith filed marked A., and thereby said J. K. became the sole owner and proprietor thereof with the exclusive right to make and sell the same and to use the name thereof, excepting only the personal privilege reserved as aforesaid, and thereupon said K. began at Pittsburg, Pennsylvania, the manufacture and sale of said pills, according to the recipe of said Dr. McLane, and continued such manufacture at said place till about the 11th day of April, 1845, when said K. formed a partnership with one J. F. under the name and style of J. K. & Co., and said K. invested said firm with the full right to make and sell said pills, and to use the name thereof, and said firm engaged largely in the business of making and selling said pills, and in order to designate the same as an article of their own manufacture, and to prevent imposition and fraud upon the public and persons desiring to purchase the same, said firm, during or before the year 1847 commenced putting up said pills in wooden boxes of uniform size, shape and appearance, having perpendicular sides, with top and bottom of elliptical shape, said box containing twenty-two pills, and caused the words "McLane's Liver Pill" to be stamped in red wax upon the cover of each box; and in further pursuance of their said design to designate said pill as the genuine article so manufactured by them as aforesaid, said firm pro-

cured at their own expense certain plates, and caused to be made therefrom a certain token-label or trademark, consisting of a wrapper which was placed by them around each box of pills, and which was printed with ink of a light red color; the portion thereof covering the top of each box being engraved with a narrow border of scalloped pattern, surrounding a panel with background or wave line engraving, and with the words "Dr. McLane's Celebrated Liver Pills. In sick headache and in all bilious complaints surpassed by none—25 cts.," engraved thereon and appearing in white letters shaded by red lines; and on the portion of said wrapper covering the rear side of the box a panel of similar background surrounded by a border of dark red and white lines appearing interlaced or woven, and with the words following to wit: "In future my liver pills will have a red steel engraved wrapper, and my name in red wax on each box," appearing thereon in white letters shaded by red lines, and having also a facsimile of the signature of C. McLane engraved and printed in red ink at the bottom thereof; and upon the portion of the said wrapper covering the front side of the box a panel with a border and background similar to that last mentioned, having the words "Prepared for the proprietor by J. K. & Co., No. 60 Wood St., Pittsburg, Pa.," thereon in white letters shaded with red lines and also the words "None can be genuine without the signature of J. K. & Co." printed thereon in red ink the words "J. K. & Co." being a facsimile of said firm's signature. A copy of said label is hereto annexed marked "B," and made part hereof, one of which labels or trademarks was placed on and around each box of said pills made and sold by said firm.

The said firm being thus the sole and exclusive owners of said pills and of the recipe for making the same, and of the said token-label or trademark, and the plates for the same, exclusively made, put up and sold said pills and said label and trademark thereon, and brought the same into notice, and, by the expenditure of large sums of money in advertising and by the exercise of energy and skill, they gave to said pills a wide and enviable reputation, and they derived from the manufacture and sale thereof large profits.

Your Orator states further that on the 29th day of March, 1853, said J. K. died leaving the said J. F. the sole surviving partner of said firm of J. K. & Co., who continued the business of said firm, and on or about the 30th day of April, 1853, the executors of said J. K. for the sum of thirty-four thousand dollars, and other considerations, conveyed to said surviving partner, J. F. and to your Orator jointly, who formed a partnership under the name and style of F. Bros., all the right, title interest and claim of said J. K. in and to the goods, chattels, notes, accounts, claims, rights, and credits of every description belonging to the late firm of J. K. & Co. in the drug business in Pittsburg aforesaid, as will appear by bill of sale thereof dated April 30th, 1853, a copy of which is hereto annexed and marked "C."

Under said bill of sale, said J. F. and C. F., composing the firm of F. Bros., at once took possession of the business of making and selling

said "Dr. McLane's Liver Pills," and of said plates, tokens, labels and trademarks, and thereby became the exclusive owners of the same and of the right to make and sell the same with the said labels, tokens, and trademarks thereon, except the right reserved by the said Dr. Charles McLane as aforesaid. On or about January 11th, 1854, L. W. Jr., became a partner in the said firm of F. Bros. and afterwards said Dr. C. McLane relinquished to said F. Bros. all his right thereto, and further recognized and confirmed to said F. Bros. the full and exclusive right in said pills and said labels and trademarks, by contract dated January 8th, 1857, a copy of which is herewith filed marked "D."

Said firm of F. Bros. greatly enlarged the business of making and selling said pills until the year 1855, since which time until the year 1872, while putting them up in boxes of the same material size and shape as already hereinbefore described, and placing a seal with the words "McLane's Liver Pills" stamped in red wax upon the cover of each box containing said pills as before described, they folded around each box a circular containing remarks upon the nature and effect of said pills and the diseases for which they are recommended with directions for their use, printed in the English, German, French and Spanish languages, a copy of which circular is hereto attached and marked "E;" and in order to still further and more readily distinguish article of pills manufactured by them as aforesaid, as of their own manufacture, they procured new steel plates and caused to be printed therefrom labels or trademarks forming an external wrapper, consisting of a fine steel engraving with a facsimile of the signatures of C. McLane and said firm of F. Bros. engraved thereon, the ground work of said engraved wrapper on the top of the box being composed of fine lines crossing the box diagonally and at right angles with each other and the words "Dr. C. McLane's celebrated liver pills, in sick head-ache and in all bilious complaints surpassed by none. Price 25 cts." engraved thereon, showing the letters and figures in white, the said words "celebrated liver pills" being upon a scroll similar to a double ogee in form, with black back-ground. On said engraved wrapper covering one side of said boxes, said firm caused to be engraved and printed the words: "Prepared only by F. Bros. successors to J. K. & Co." all in white letters, also a facsimile of their signature in black, and the words "without whose signature none can be genuine" printed in black letters, and on the opposite side of said boxes are printed other words in white letters as follows: "In future my genuine liver pills will have a fine steel engraved wrapper, and my name in red wax on each box," with a facsimile of the signature of C. McLane in black script, a copy of which label is hereto attached marked "F."

The business of making and selling said pills with said labels, tokens, and trademarks thereon, was carried on by said firm of F. Bros. from the 30th day of April, 1853, in their said firm name, and said firm from said last mentioned date, owned and held among their

firm assets the right of making and selling said pills and using thereon said tokens, labels, and trademarks, notwithstanding the changes that were made from time to time from said 30th day of April, 1853, until the present time, in the individual members of said firm which were as follows:

On the 11th day of January, A. D. 1854, L. W. Jr. became a member of said firm, which was composed of said J. F., C. F. and said W., until the 12th day of October, 1857, when said L. W. Jr. withdrew from said firm, and in consideration of the sum of seventeen thousand dollars conveyed to said J. F. all his right, title and interest and claim of, in and to the property, assets and effects whatever of said firm of F. Bros. including the right to make and sell said pills, and to use said tokens, labels, and trademarks, as will appear by said W. bill of sale of that date, a copy of which is hereto attached, marked "F2," and from and after said 12th day of October, 1857, said firm composed of said J. F. and C. F. carried on the business of making and selling said pills, put up as aforesaid with said labels thereon, until the first day of July, A. D. 1865, when said C. F. withdrew from said firm, and in consideration of the sum of thirty-five thousand dollars, relinquished to said J. F. all his said C's. interest, right title or claim in and to all the property and assets of said firm of F. Bros., and said J. F. thereafter, under said firm name of F. Bros., continued to carry on the business of making and selling and putting up said pills as above described at Pittsburg, Pa., till about the 2nd day of November, 1870, when the said J. F. died, and by will, a copy of which is herewith filed marked "G" and made part hereof, bequeathed to your Orator the good-will and proprietorship of McLane's and other medicines, owned and controlled by him, which included said Liver Pills, and the right to make, put up and sell the same as described last aforesaid, upon certain conditions; in effect that your Orator should take charge of and carry on said business, and pay off the pecuniary legacies given in said will, all of which your Orator has done, and by his said will, said J. F. bequeathed to your Orator after payments of the legacies of said will, all the residue of his estate, and thereby your Orator became, and is now, the sole and exclusive owner and proprietor of said pills, and the recipe for making the same, and of said tokens, labels and trademarks, and the plates therefor, and has the sole and exclusive right to make and sell said pills and to use said labels, tokens, and trademarks, and as residuary legatee of said J. F., your Orator is entitled to recover all damages or profits, that accrued to him in his lifetime, or to said firm of F. Bros.

And your Orator has, since the death of said J. F., continued, and still continues the business of making and selling said pills and using thereon the said label and trademark under the said name of F. Bros., as hereinbefore described, and your Orator is now using said label as shown by Exhibit "F," with these exceptions only that within the last few months, he has used and now uses as a ground work on his labels shaded curved lines cutting and crossing each other in such a way as

to produce the effect of alternate light and shade crossing the top of the box diagonally, in place of straight lines crossing each other diagonally as hereinabove described, and he now omits on his labels as now used by him the words "Successors of J. K. & Co." and has also substituted "24" in place of "60" as the number of Wood street, as will appear in Exhibit "H" hereto annexed, and that both said firm of F. Bros. until the death of J. F., and from that time, your Orator doing business in said firm name as aforesaid, have, since the passage of the Act of Congress requiring the same, placed across the bottom and ends of each box of said pills when put up for sale, and over the folds of the external wrapper, their proprietary United States Revenue stamp. And your Orator says that being the sole and exclusive owner and proprietor of said pills and of the recipe for making the same and of said tokens, labels and trademarks, and the plates therefor as aforesaid, and having the sole and exclusive right to make and sell said pills prepared and put up as aforesaid, with said tokens, labels and trademarks thereon, your Orator hoped he might be permitted to exclusively manufacture and sell the same as put up, and to exclusively use, for the purpose of indicating the origin of said pills, said tokens, labels and trademarks, but the Defendant, with the intent to injure and defraud your Orator in the premises, and to reap the advantages, benefits and profits of the credit and reputation of said pills, is now engaged, and has been engaged for some time, to wit—a period unknown to your Orator, but believed by him to be several years, making and vending, and causing to be vended by others, a spurious, counterfeit and inferior article of pills, prepared in imitation of and calculated and intended to be sold as the genuine "Dr. C. McLane Liver Pills," of your Orator's own manufacture, and having thereon a false, forged and counterfeit token-label or trademark, made in imitation of and closely resembling that of your Orator, so as to enable the Defendant to reap the benefits and profits of the credit and reputation of the genuine pills made and sold by your Orator, and his predecessors in ownership, as aforesaid at great expense, and when thus prepared, the defendant has sold, and is now selling and causing to be sold, said spurious and counterfeit pills as the genuine article of your Orator's own manufacture, intending to deceive and thereby actually deceiving the public and customers of your Orator, and supplanting your Orator's trade and injuring him to a large amount, but which your Orator is unable to state or fix without a statement or account of the amount of sales made as aforesaid by said Defendant.

And the Defendant, for the purpose of more completely and effectually deceiving the public, and persons wishing to buy the genuine pills of your Orator's own manufacture, puts up his said false, counterfeit and spurious pills in boxes of the same material, size and shape as those used by your Orator as aforesaid, and places upon the cover of each box a seal in red wax of the same style, size, and appearance as the red seal used by your Orator as aforesaid, and which is specially used and referred to by your Orator in his circulars and advertisements,

and relied upon by him to indicate to the public and his customers, the genuine article of pills, made and sold by your Orator as aforesaid, and while endeavoring completely to deceive the public and those seeking the genuine pills of your Orator, by the use of the red seal so placed upon the cover of the boxes used by the Defendant, as aforesaid, he seeks to shield himself from the inevitable consequence of his attempt to injure and defraud your Orator by using a stamp impressing in faint and obscure letters on said red wax the words "J. H. McLean, St. Louis," which are yet as illegible as not to undeceive those who are cheated into supposing, from the mere pressure of the seal on the cover of the box, that the same contains the genuine pills manufactured by your Orator, and the Defendant places around the boxes of pills so put up by him, a circular printed in the English, German, French, Spanish and other languages, a copy of which is hereto attached marked "J," and encloses the whole with a wrapper consisting of a lithograph impression similar in general appearance to the outer wrapper used by your Orator, the body thereof being formed like that of your Orator, of lines crossing the box diagonally and at right angles to each other, with the words "Dr. J. H. McLean's Universal pills or vegetable liver pills, prepared only by Dr. J. H. McLean, No. 314 Chestnut Street, St. Louis, Mo." printed thereon across the top of each box in white letters; the words "Universal pills" being upon a background of black and on a strip or scroll circular in form; the whole presenting a general appearance similar to the label covering the top of the box used by your Orator as aforesaid, while upon the label covering the side of said boxes put up by Defendant, are printed the words, "To prevent counterfeiting I have changed the color of my label" in white letters upon a dark back ground, such as is used by your Orator, and with the Defendant's name "Dr. J. H. McLean" signed in black script, but in such obscured lettering as to be almost illegible; and on the label covering the other side of said box, the Defendant causes to be printed in white letters, in style and appearance resembling the label used by your Orator, the words "For the cure of liver complaint, head-ache, bilious diseases, etc." A copy of said counterfeit label is hereto attached marked "K."

And your Orator avers that the Defendant caused to be printed and uses said label as aforesaid, as your Orator believes and charges the fact to be, for the sole purposes of enabling him to defraud your Orator of trade and profit by selling his spurious and counterfeit goods as and for the goods so advertised, manufactured and sold by your Orator.

And your Orator further says that the illegal and wrongful acts set forth and complained of aforesaid, are but the carrying out of fraudulent designs of the Defendant, which he long ago conceived for the purpose of drawing your Orator's trade to himself by the wrongful use of fraudulent imitations of said tokens, labels and trademarks of your Orator, and in furtherance of the purpose, as your Orator believes and charges the fact to be, the Defendant did, prior to the year 1855 print or cause to be printed a certain false or counterfeit label, token or

trademark, in imitation of or closely resembling the token label and trademark then and for many years theretofore exclusively used and owned by J. K. & Co. aforesaid, being the label of a light red color hereinbefore fully described and referred to as Exhibit "B." And Defendant placed said false and counterfeit labels on boxes of pills of his own manufacture, which boxes were similar to the boxes then used by said J. K. & Co., and on the lid of each box of pills so put up and sold by him he placed a seal stamped in red wax in imitation of that used by said K. & Co. as aforesaid, and then wrapped each box of pills in one of the counterfeit labels last above described, which label consisted of an engraved wrapper printed with ink of a light red color, nearly resembling in shade and general appearance that used by said K. & Co. and with the words "Dr. McLean's Universal pills for cure of liver complaint, headache, bilious diseases, etc." printed on the portion covering the top of each box, in white letters shaded by a red line, and below the above, the words "Price (see directions inside) 25 cts." On the side of the box were printed on the wrapper the words "Dr. McLean's Universal pillen zur heilung von Leber Krankheiten Kopfweh bilosen Kraukheiten U. L. W." appearing in white letters shaded by red lines, as in the genuine label, and with the words "Vorschrift auf der innern seite" printed in red letters underneath, while on the portion of said wrapper covering the opposite side of said box are printed the words "Prepared by J. H. McLean, N. E. Corner 3rd and Pine Sts., St. Louis, Mo."

A copy of said label is hereto attached marked "L."

And your Orator believes and charges that the Defendant procured and used the said last described label solely for the purpose of deceiving the public and those wishing to buy the genuine pills made and sold as aforesaid by said J. K. & Co., but he says that Defendant's fraudulent designs were to some extent frustrated and the effects of his wrongful acts partially averted from the rightful proprietor of said label and trademark by the circumstances of the said firm of F. Bros. in the year 1855, having changed the label and wrapper used by them and by said J. K. & Co. prior to that time, and adopted the label lately used by your Orator as aforesaid, but your Orator says that after the adoption by him of said last named label as aforesaid, the Defendant continued for many years to use the red label procured and used by him in imitation of the trademark used by said firm of F. Bros. as aforesaid, but finding the carrying on of his said business unprofitable while he was using his said fraudulent red label, and your Orator was using the dark label above described, Defendant conceived the design of changing the color of his label, and adopting in place of the red label theretofore used by him, another dark label in imitation of the label or trademark of your Orator, which was done, as your Orator believes and charges for the purpose of wrongfully diverting the trade of your Orator to himself and enabling him to sell his goods as and for the goods manufactured and sold by your Orator, and not for the

purpose of preventing counterfeiting as Defendant falsely publishes on his own fraudulent label.

Your Orator states further that said Defendant was never authorized by him to make, put up, or sell said pills as of your Orator's own manufacture, or to use or make said tokens, labels or trademarks in imitation of or resemblance to those of your Orator as said Defendant is charged to have done above, nor to make or sell any such false or counterfeit pills with such false or counterfeit labels attached thereto, but said Defendant well knows that your Orator is now, and his predecessors were, the sole and exclusive proprietors of Dr. C. McLane's celebrated liver pills and of the said labels and trademarks, marked "B" and "F" as hereinbefore set forth, and said Defendant also well knows that said false and counterfeit labels or trademarks used by him are mere imitations of the labels and trademarks of your Orator and his predecessors, made, contrived and got up by said Defendant with the intent to deceive the public and purchasers thereof, and to defraud your Orator.

All of which said acts and things and pretenses are against equity and good conscience, and a great loss and damage to your Orator, and inasmuch as your Orator is without full redress at law, and can only obtain adequate relief in equity, and as he avers that a continuance of the acts aforesaid, will occasion irreparable loss and injury to him; to the end, therefore, that the said Defendant may, if he can, show why your Orator should not have the relief hereby prayed, and may upon his corporal oath, and according to the best and utmost of his knowledge, remembrance, information and belief, full, true and perfect answer make to all the allegations hereof, and to the several interrogatories hereinafter numbered and set forth; that is to say:

(Interrogatories and prayer for relief).

M. L. G. & D.,

Solicitors for Complainant.

BILL OF COMPLAINT.

(Richmond Nervine Co. v. Richmond, 159 U. S. 293).

To the Judges of the Circuit Court of the United States for the Southern District of Illinois:

The Dr. S. A. R. Nervine Co., of Saint Joseph, Missouri, a corporation duly incorporated and organized under and by virtue of the laws of the State of Missouri and a citizen of said State, brings this its bill of complaint against S. A. R., resident of the County of Douglas, State of Illinois, and a citizen of said state of Illinois, and for cause thereof your Orator complains and states that heretofore and prior to the 20th day of December, 1877, the said S. A. R. being then engaged in the business of making and selling a medicine known as "Samaritan nervine," a medicine for the relief of epileptic fits and all other ner-

vous diseases, adopted and used as his trademark on such medicine the figure of a man in an epileptic fit falling backward, with his arms extended and his cane and hat dropping to the ground, with the word "trade" printed in small capitals on the right of said figure and the word "mark" printed in small capitals on the left side of said figure. A copy or specimen of which said trademark, adopted and used by said S. A. R. in his said business and on his said medicine herein aforesaid, as registered in the United States Patent Office March 26th, 1878, is hereto attached, marked Exhibit "A," for the purpose of illustrating and explaining the said trademark, so used and adopted by the said S. A. R. as aforesaid.

Your Orator further represents to your Honors that after the said S. A. R. had used and adopted said device as and for his trademark in his business the "Dr. S. A. Richmond Medical Company" was incorporated and organized under and by virtue of the laws of the State of Missouri and succeeded the said S. A. R. in the business of manufacturing and selling the medicine aforesaid on which said trademark was used, and acquired all the right, title, and interest in and to said trademark theretofore owned and enjoyed by said S. A. R.

Your Orator further represents to your honors that the incorporation of the "Dr. S. A. Richmond Medical Company" about the latter part of the year 1883 or early part of the year 1884, the particular date of which your Orator is unable to state, said "Dr. S. A. Richmond Medical Company" adopted and used, in connection with the trademark aforesaid, an engraved portrait of Dr. S. A. Richmond, placed on the outside wrapper in which the bottle of medicine was encased, forming the front side of bottle, and on circulars and other mediums of advertising, and was also blown in the bottles and photographed on paper and pasted on opposite side of the bottles; the words "new style" printed in small capitals on the upper right hand corner of said outside wrapper, and the word "adopted" and figures "1884" printed in same manner in upper left-hand corner of said wrapper; also the portrait of said Dr. S. A. R., surrounded by four globes, was placed on outside wrapper on the back of said bottles.

A copy or specimen of said portrait and globes as used, as aforesaid, by said "Dr. S. A. Richmond Medical Company" is hereto attached and marked Exhibit "B" for the purpose of illustration and explanation.

Your Orator further represents to your honors that on or about the 13th day of May, 1884, the said "Dr. S. A. Richmond Medical Company" made an assignment for the benefit of its creditors under and pursuant to the laws of the State of Missouri. That said assignment was duly made, prosecuted and wound up according to law. A copy of the resolution of said company authorizing the president thereof to make such assignment is hereto attached, marked Exhibit "C," and made a part of this bill.

That by order of the court in said proceedings of assignment, the formula for compounding said medicine, the good-will of the business,

and the trademark and all other designs used by the said "Dr. S. A. Richmond Medical Company," including the portrait, and portrait connected with globes used by said company as herein aforesaid for the purpose of advertising said medicine, was duly and lawfully sold by the assignee of said "Dr. Richmond Medical Company," and that J. A. R. became the purchaser thereof; that afterwards your Orator, "The Dr. S. A. Richmond Nervine Company," was incorporated and organized under and by virtue of the laws of the State of Missouri, and by purchase of and transfer by said J. A. R., succeeded the "Dr. S. A. Richmond Medical Company," in the manufacture and sale of said medicine, the Samaritan nervine, and acquired all the right, title and interest in and to said personal property, formula, trademark and all devices used in connection therewith, as aforesaid, theretofore owned, adopted, used and enjoyed by the said "Dr. S. A. Richmond Medical Company," and that thereby your orator became and now is the sole, exclusive and rightful owner of said property, formula, trademark, and devices adopted and used in connection therewith, and is entitled to the sole and exclusive use and enjoyment of the same, and is now and for several years last past has been engaged in making and selling said Samaritan nervine and using thereon and in connection therewith the trademark and portrait of said Dr. Richmond and said other devices in connection therewith, as hereinbefore mentioned and set out.

Your Orator further represents to your honors that after your orator had succeeded to all of the rights of the "Dr. S. A. Richmond Medical Company" and had engaged in the business of making the said medicine aforesaid under said trademark, etc., and about May 1st, 1884, it was adopted as and for an additional trademark for medicine for relieving epileptic fits and other nervous diseases, said portrait of Dr. S. A. Richmond with the word "trade" printed in small capitals on the left side of said portrait, and the word "mark" printed in small capitals on the right of said portrait. A copy or specimen of which said trademark so used and adopted by your orator as registered in the United States Patent Office March 6th, 1888, is hereto attached, marked Exhibit "D," for the purpose of illustrating and explaining the said trademark so adopted by your orator.

That after your orator acquired the said trademark as aforesaid it has been extensively engaged in manufacturing and selling said medicine under said trademarks and said other devices used in connection therewith; that it has extensively advertised said medicine under said trademarks and devices used in connection therewith, and has spent large sums of money in so advertising said medicine and bringing it to the knowledge of the public; that said medicine under said trademarks, etc., has acquired an extensive and valuable reputation all over the United States and in foreign countries through the efforts and labors of your orator and its large expenditures of money in advertising and pushing the sale of said medicine under said trademarks, etc., and that your orator has acquired a valuable property interest in

and to said trademarks that makes their exclusive enjoyment in your orator of great pecuniary value and importance.

Your orator, in further complaint, further represents to your honors that notwithstanding the long use and enjoyment of said trademarks and the portrait, etc., used in connection therewith as aforesaid, which your orator charges and avers was used by the "Dr. S. A. Richmond Medical Company" and by the assignee thereof was sold to your orator and used by it continuously from thence to the present time with the knowledge and consent of the said Dr. S. A. R., and notwithstanding its rights to the exclusive use and enjoyment of said trademarks, etc., the said defendant, S. A. R., for the purpose of defrauding your orator, well knowing the premises and the rights and privileges secured to your orator by the use and adoption of said trademarks, and to appropriate to himself the profits, benefits and advantages which would have accrued to it from the exclusive use of said trademarks, etc., within the district aforesaid, has made what he styles "Samaritan nervine," and is now wrongfully engaged in making the same in Tuscola, county of Douglas and State of Illinois, unlawfully, wrongfully and deceitfully wrapped and packed such so-called "Samaritan nervine" similar to that used by your orator, and is now wrongfully making, and wrongfully and deceitfully wrapping and packing said so-called "Samaritan nervine" in packages similar to that used by your orator and have used thereon both the trademarks aforesaid and the devices connected therewith as aforesaid, in direct violation of the exclusive right to use the same vested in your orator, and that he has by means of said trademarks and devices sold large quantities of so-called "Samaritan nervine" throughout the United States and in said district where your orator is selling its nervine under said trademarks aforesaid in direct infringement of said trademarks. The fact that said defendant is engaged in the manufacture and sale of said medicine and using said trademarks and devices in connection therewith will more fully appear by defendant's affidavit filed in the Patent Office of the United States, a copy of which is hereto attached, marked Exhibit "E," and made a part of this bill.

Your orator further states that what amount of goods said defendant, S. A. R., has sold under said trademarks it is unable to state nor does it know but upon information and belief, but your orator avers that he has sold large quantities of the same, using said trademarks, is now making said so-called "Samaritan nervine" and using said trademarks thereon, and have received and are receiving for such sales great gains and profits, but to what amount your orator is ignorant and cannot set forth, except that it alleges that such gains and profits amount to more than five thousand dollars, exclusive of costs, and that your orator has been damaged to an amount exceeding five thousand dollars, exclusive of costs.

Your orator further represents to your honors that said S. A. R., the defendant herein, well knowing the exclusive right of your orator to make and vend said medicine, "Samaritan nervine," and the exclusive

right and privilege of your orator to use said trademarks and devices in the sale of said medicine and in connection therewith, and in the advertisement of the same, and the great benefit secured to your Orator by the use and adoption of said trademarks, intending to injure your said orator and appropriate to himself the profits, benefits, and advantages which would accrue to it from the exclusive use of said trademarks within the district aforesaid, has wrongfully and fraudulently applied to the Patent Office of the United States of America for registration of said portrait of said Dr. S. A. R. adopted and long used by your orator as its trademark aforesaid as and for his trademark; all of which will fully appear by copy of his statement and declaration filed in the Patent Office of the United States of America, which is hereto attached, marked Exhibit "F," and made part hereof; that said S. A. R. has no interest in the formula for compounding the medicine in suit nor is he entitled to adopt or use said portrait as his trademark.

Your orator further represents to your honors that said S. A. R. is wholly insolvent and worthless, and that he would be unable to pay any damages that your orator might sustain by means of the premises aforesaid; that your said orator has no speedy or adequate remedy at law in the premises, and it can only be protected in its several rights herein by the equitable interposition of this court.

Your orator prays that the defendant may be required to make a disclosure of all such sales and profits, and that they may be required to account with and pay over to your orator all the damages it may have sustained and profits which he has received from such unlawful use of said trademark, and that they may be enjoined provisionally and preliminarily pending a hearing herein.

Wherefore, the premises considered, your orator prays that upon a final hearing the defendant be enjoined and restrained by decree from in any manner making and selling said medicine, Samaritan nervine, under the name of Samaritan nervine or under any other name whatever, and from in any manner using said trademarks or devices enumerated therewith or either of them or any trademark or marks so nearly resembling them as will be calculated to deceive on any of their preparations and from infringing upon your orator's exclusive right to use the same; that the defendant be enjoined and restrained from the further prosecution of the registration of said portrait as his said trademark before the Patent Office of the United States, and that he be required to account with and pay over to your orator all damages sustained by it and profits by him received from such unlawful use of said trademarks.

That your orator may have such other and further relief in the premises as equity and good conscience will allow and as to this court shall seem meet; and may it please your honors to grant unto your orator a writ of subpoena of the United States of America under the seal of this honorable court, directed to the defendant, S. A. R., commanding him to appear in this honorable court, then and there to

answer all and singular the premises and to stand to and perform and abide such further orders, directions, and decree as may be made against him; and your orator will ever pray.

H. & P. and B. & B. & P.,
Solicitors for Complainant.

BILL OF COMPLAINT.

(Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19).

To the Honorable the Judges of the Circuit Court of the United States for the Southern District of New York:

Emilie Saxlehner brings this bill of complaint against Eisner & Mendelson Company, and thereupon your Orator complains and says, upon information and belief:

1. That your Orator is the widow of Andreas Saxlehner, deceased, and resides at the City of Budapest, in the Kingdom of Hungary, and is a subject of the King of Hungary.

2. That the defendant, the said Eisner & Mendelson Company, during the time when the acts hereinafter complained of were committed was, and now is, a corporation duly incorporated under the laws of the State of West Virginia, having an office for the transaction of its business in the City of New York, and is a citizen of the State of West Virginia.

3. That the said Andreas Saxlehner, late of the City of Budapest, in the Kingdom of Hungary, was at all the times herein mentioned, until the 24th day of May, 1889, the proprietor of a certain well situated at Orsöd, within the city limits of the city of Buda (otherwise known in the German language as the city of Ofen), which city has for about twenty-five years last past been, and is now, united with the city of Pest, under the name of Budapest, in said Kingdom of Hungary, the waters of which said well possess valuable medicinal properties.

4. That in or about the year 1863 said Andreas Saxlehner commenced to bottle the waters of said well and to sell the same in the market, and for the purpose of distinguishing his said bitter waters from other bitter waters then known and sold in the market, adopted the arbitrary and fanciful name or trademark of "Hunyadi Janos" for his said bitter waters.

5. That by reason of the great care exercised by him in the business of obtaining, caring for and bottling said waters and selling the same in the market, and the valuable properties of said water, said business soon increased and additional territory was thereafter acquired by said Andreas Saxlehner in which new wells, all giving forth the same water, were opened by him, all being situated near said first-mentioned well, and in a valley surrounded by considerable hills. the geographical name of which valley and territory contained in it is

Orsöd, and thereupon said Andreas Saxlehner applied said name of "Hunyadi Janos" to the bottled water of said spring sold by him in the market.

6. That at or about the time when said Andreas Saxlehner adopted said name of "Hunyadi Janos" as aforesaid, he also adopted a characteristic and novel style of bottles in which said water was sold by him in the market, the same being of a straight shape with a short neck to the top of which was attached a metal capsule bearing the inscription "Hunyadi Janos Budai Keseruviz" (meaning Hunyadi Janos bitter water of Buda) together with a portrait supposed to be a portrait of the mediæval Hungarian hero Hunyadi Janos stamped thereon, and a novel and peculiar label covering almost the whole body of the bottle, the characteristic features of which said label were a division of the same into three longitudinal fields, the middle field bearing said portrait in a medallion with the name "Hunyadi Janos" written in large letters on the top part of said label, the color of the middle field being red. That thence hitherto said natural mineral waters bottled and sold by said Andreas Saxlehner in Hungary and other European countries and in all markets of the world, have been known and called by said name and trademark of "Hunyadi Janos" water. That the said name "Hunyadi Janos" is in no way descriptive of the nature or quality of the water of the said well or wells, but was adopted by the said proprietor as a fancy or ideal name and as a trademark to distinguish the water of his said wells in commerce from all other waters.

7. That soon after said business of bottling and exporting said Hunyadi Janos water had been commenced by said Andreas Saxlehner in the year 1863, said water, named, bottled, and labeled as aforesaid, became popular and was exported to and sold in all the principal countries of Europe and also in the United States of America. That in the countries inhabited by the Latin races, the word "Janos" became the common appellation of said water, it being known as "Eau de Janos" or "Aqua di Janos," while in England and the United States of America the name "Hunyadi" became the common appellation thereof, it being known as "Hunyadi water." That in the month of March, 1876, said Andreas Saxlehner executed a contract to a corporation known as the "Apollinaris Company, Limited," of London, by which he granted to said company the exclusive right to sell his said natural "Hunyadi Janos" bitter water in Great Britain, its colonies and possessions and the United States of America, and other transmarine countries for the term of ten years, which contract was thereafter further extended and terminated on the 25th day of March, 1896.

8. That about the time when said contract was entered into a label was designed to be used on the bottles of such water which were to be sold through said "Apollinaris Company, Limited," of substantially the same contents and characteristic parts as the label theretofore used, but of a different color, the body of the label being of blue color, while the red color of the central field was substantially retained. That the name "Hunyadi Janos" together with the historical portrait

and the name of "Andreas Saxlehner" were retained on same label in the same manner as before, as was also the division into three longitudinal fields; and the general style of the bottles, as also the capsule and imprint thereon above described remained the same. That said label was substantially like the label used by your orator, the successor of Andreas Saxlehner in said business, as hereinafter referred to. That soon thereafter there was added to said blue and red label a small narrow strip on the top thereof, in the same blue color containing the printed words "Sole exporters: The Apollinaris Company, Limited, London," which strip has been since retained, the reading of the print being thereafter changed to "Proprietor: Firm of Andreas Saxlehner, Budapest, Hungary."

9. That ever since the adoption of said red and blue label, as aforesaid, in or about the year 1876, large quantities of such bitter water thus bottled and labeled were exported by the said Andreas Saxlehner through said Apollinaris Company, Limited, to the United States of America, and there sold to the public, and said water became known in the United States of America under the name of "Hunyadi water," and became known under the name as the property of said Andreas Saxlehner, and was ordered and sold under such name, the same being an abbreviation of the name "Hunyadi Janos." That a large traffic and business in exporting to the United States, and vending therein said water, was established and continuously carried on and is now carried on by your orator as successor in business of said Andreas Saxlehner.

10. That on May 24, 1889, said Andreas Saxlehner died, and your orator, his widow, thereupon succeeded him in said business of bottling and exporting said Hunyadi Janos water, and became and is the proprietor thereof.

11. That since the termination of said contract with said Apollinaris Company, Limited, your orator has continued said business of shipping to the United States, and selling therein said Hunyadi Janos water, commonly known as Hunyadi water, in bottles and with labels and capsules thereon substantially as hereinbefore last described, excepting that upon said labels the statement is contained, "Proprietor: Firm of Andreas Saxlehner, Budapest, Hungary," in place of an indication of the Apollinaris Company as exporters. That your orator is the sole proprietor of the firm of Andreas Saxlehner, and lawfully doing business in Austria-Hungary, under said firm name.

12. That on or about the 12th day of November, 1886, said Andreas Saxlehner duly made application to the United States Patent Office, according to the statute of the United States therefore provided, for registration of the name "Hunyadi" as his trademark for natural aperient waters, and such proceedings were thereafter had, that on or about the 5th day of April, 1887, a certificate of registration of said trademark "Hunyadi" was duly issued to him by said United States Patent Office, dated on said last-mentioned day, and numbered 14252,

to which certificate, or a certified copy thereof, ready in court to be produced, your orator refers for greater certainty.

13. That by reason of said sales by your orator and her predecessors in business, and his and your orator's agents as aforesaid, the said word "Hunyadi" on said label by her used and her predecessor as aforesaid, dealers in mineral water, and the purchasers and consumers of said water generally have come to know and have long known your orator's mineral water under the names and trademarks, "Hunyadi" or "Hunyadi Janos," and under the said label, and in the style of bottles, capsules and labels as before described, and that the water so furnished and sold by your orator in the United States is procured directly from the well or wells aforesaid, and, therefore, to rely upon the said label and trademark as an assurance and guarantee of the genuineness, strength and purity of the said water, and your orator alleges that said assurance and guarantee was and is of great value to your orator and to the dealers and consumers of said water. And that said water so sold by your orator has come generally to be known and designated by the trade so called, and by purchasers and consumers of the water in the United States of America by the first and characteristic word of said trademark, "Hunyadi," the "Janos" being comparatively seldom used in common parlance in this country.

14. And your orator further shows unto your honors that the defendant above named, well knowing the premises and the rights existing in and secured to your orator as aforesaid, but contriving to injure your orator and deprive her of the benefits and advantages which might and otherwise would accrue unto her from the enjoyment of such rights and to injure and impose upon the public, subsequent to the adoption of the said trademark, label, bottle and capsules by your orator and her predecessor, recently and before the commencement of the suit, as your orator is informed and believes, in the City of New York and elsewhere, without license or allowance and against the will of your orator, in violation of the rights of your orator and infringing the said trademark, did unlawfully and wrongfully import for sale and sell and offer for sale bitter water not coming from your orator's said wells in bottles of identical shape and size as those used by your orator and with certain capsules thereon stamped with a portrait in imitation of that impressed on your orator's capsules, surrounded by a circular inscription and the initials H. L. and with labels on said bottles bearing the name "Hunyadi Laszlo," Budai Keserüviz, and a portrait in the middle field of said label, set in a medallion, all in close and fraudulent simulation of your orator's trademark; and that defendant's said labels also further imitate your orator's labels by being divided in three longitudinal fields, covering almost the whole body of the bottle, the color of the middle field being red, and that of the body of the label being blue, and in many other particulars, all contrived to induce the public to take defendant's said water as and in place of your orator's water.

And that other bottles of such water, sold by said defendant, imitate

your orator's bottles in shape, size and color, capsule and label, being marked with the name "Hunyadi Matyas," and bearing a label designed in close and fraudulent simulation of your orator's said label in color, division into three panels and printed matter contained thereon, including a medallion portrait in the central panel and repeated on the capsule.

15. And your orator further shows that the similarity between the said bottles, capsules, labels and names used respectively by your orator and the defendant is so great that the public and consumers and purchasers are likely to be deceived thereby, and are in fact deceived to suppose the water so sold by the said defendant to be that sold by your orator and thereby to cause your orator great loss and damage.

16. That until the year 1890 your orator and her said predecessor in business did not enjoy adequate protection in Hungary in the use of her and his trademarks, tradenames and labels on account of the lack of statutes regulating such matter, by reason of which fact other persons used the name Hunyadi in connection with other names as trademarks for other bitter waters, and closely imitated your orator's labels, capsules and bottles, and your orator's predecessor was unable to stop such fraudulent practices. That since 1890, the law of Hungary has been changed, and your orator has succeeded in causing all these fraudulent marks and labels to be suppressed by proper proceedings brought for this purpose, including also the use of the name "Hunyadi Laszlo" and "Hunyadi Matyas," and the labels upon which said names were used by the proprietors of the springs from which said defendant's waters came, and that the further use of said names is now a criminal offense in Hungary.

That your orator has duly notified said defendant of her rights and claims in the premises and requested it to desist from such further sales, but said defendant has refused and still refuses so to do.

19. That the value of the matter in dispute between your orator and the defendant, exclusive of interest and costs, exceeds the sum of two thousand dollars.

20. That by reason of the said acts done or threatened and intended to be done by said defendant, all in defiance of the rights of your orator, as aforesaid, great and irreparable loss and injury has been, is and will be caused to your orator, and she has been and is and will be deprived of great gains, profits and advantages which might and otherwise would be obtained and enjoyed; and your orator is informed and believes that the said defendant by reason of the said sales of the said water under the names of Hunyadi Laszlo, and Hunyadi Matyas, and the said labels, capsules and bottles, has made and realized large profits and advantages, and now has in its possession or under its control, or subject to its order a large quantity of said waters so bottled, capsuled and labeled which it proposes to sell, but to what extent said sales have been made and how large profits have been derived therefrom, your orator does not know and prays a dis-

covery thereof. And your orator further says that such sales made by the said defendant, and the threats and intention of defendant to make such further sales and said unlawful acts in disregard and defiance of the rights of your orator have the effect to and do encourage and induce others to interfere with the said trademark and label, and to violate and disregard your orator's rights.

And, forasmuch as your orator can have no adequate relief except in this court, to the end, therefore, that the said defendant may, if it can, show why your orator should not have the relief hereby prayed and may, according to the best and utmost knowledge, remembrance, information and belief of its officers, full, true, direct and perfect answers make to the premises and to all the several matters hereinbefore stated and charged as fully and particularly as if severally and separately interrogated as to each and every of such matters, and may be compelled to account for and pay to your orator the profits by it acquired and the damages suffered by your orator from the aforesaid unlawful acts. But an answer under oath is hereby expressly waived.

Your orator prays that the said defendant, its officers, servants, agents, attorneys and workmen, and each and every of them, may be restrained and enjoined provisionally and permanently by the order and injunction of this honorable court from procuring, parting with, selling or attempting to sell within the United States of America any water or liquid not coming from the said wells of your orator under the name or designation of Hunyadi Laszlo or Hunyadi Matyas or any name or designation in which the word "Hunyadi" occurs, and also from procuring, parting with, selling or attempting to sell within the said limits any such water in any bottle or vessel imitating or resembling in form, color and general appearance those used as aforesaid by your orator and her predecessor in business, or bearing upon it any capsule stamped in any manner imitating or resembling the said capsules of your orator, or any label in form, color, design and general appearance imitating or resembling the said label of your orator on the said bottles of Hunyadi Janos water, and also from procuring, parting with or selling or attempting to sell within said limits any such water put up or contained in bottles resembling and bearing capsules, marks and labels resembling those of your orator or bearing the name "Hunyadi."

And your orator also prays that defendant may be decreed to deliver up unto your orator or to this honorable court any and all labels in its possession upon which the words "Hunyadi" or Hunyadi Laszlo and Hunyadi Matyas appear, or which are made in imitation of or resembling those adopted and used by your orator, and any and all bottles, whether filled or unfilled, and all capsules which imitate or resemble the bottles and capsules used by your orator for said "Hunyadi Janos" water, and to pay unto your orator all profits derived by the said defendant from the sale of any water under the said name Hunyadi Laszlo or Hunyadi Matyas, or any name or designation in

which the word "Hunyadi" appears, or any vessel upon which was or is affixed the label or capsules resembling those adopted and used as aforesaid by your orator, as well as the costs of this suit; and that your orator may have such further relief or such other or different relief as to this honorable court shall seem meet and as shall be agreeable to equity.

May it please your honors to grant unto your orator the writ of injunction, as well provisional as permanent, issuing out of and under the seal of this honorable court, commanding, enjoining and restraining the said defendant, its officers, servants, agents, attorneys and workmen, and each and every of them as is hereinbefore and in that behalf prayed.

May it please your honors to grant unto your orator the writ of subpoena issuing out of and under the seal of this honorable court directed to the said defendant, Eisner & Mendelson Company, by a certain day and under a certain penalty to be and appear in this honorable court, there and then to answer the premises and to stand to and abide such order and decree as may be made against it.

And your orator will ever pray, &c.

B. & K.,

Complainant's Solicitors.

BILL OF COMPLAINT.

(Hennessy v. Herrmann, 89 Fed. Rep. 669.)

In the Circuit Court of the United States for the Northern Judicial District of the State of California.

JACQUES RICHARD MAURICE HENNESSY,	} In Equity.
JACQUES FRANCIS HENRY HENNESSY,	
JAMES RICHARD CHARLES HENNESSY,	
ARMAND CASTILLON and EMMANUEL	
CASTAIGNE,	
<i>against</i>	
J. H. and C. S.	

To the Honorable Judges of the Circuit Court of the United States for the Northern Judicial District of California:

First. J. R. M. H., J. F. H. H., J. R. C. H., A. C. and E. C., all of Cognac in France, and citizens of the Republic of France, bring this their bill of complaint against J. H. and C. S., of the city and county of San Francisco, state of California, residents of the Northern Judicial District aforesaid, and citizens thereof, and thereupon your orators complain and say:

Second. Complainants state that at all the times hereinafter mentioned they were copartners under the firm name and style of James

Hennessy and Company. That the complainants are, and for a long time previous to the commission of the grievances hereinafter mentioned have been, exporters, bottlers and vendors of a cordial or liquor known as Hennessy brandy, which the complainants and their predecessors in the partnership business have for upwards of thirty years last past produced, bottled and sold.

Third. That said brandy when bottled by these complainants is put up in peculiar tall, dark colored bottles, to wit, twelve inches in height, bearing (a) a rectangular label bearing the inscription, "Jas. Hennessy & Co., Cognac," in gold letters on a white ground, encircled by a wreath of vine leaves and grapes, in gold, said wreath being surmounted by an arm bearing a battle axe, also in gold; (b) a small oblong label of white with gold border lines, bearing the word "France" in gold; (c) a crescent-shaped label; (d) a cork branded with the words "James Hennessy & Co."; (e) a metal capsule; all with their own proper devices and trademarks adopted by the complainants for that purpose the year A. D. 1870, and all encased in square wooden boxes holding twelve bottles each.

Fourth. That complainants' trademarks have been duly registered under the provisions of the statute of the United States in the year A. D. 1881. That by reason of the long experience and great care of the complainants in their said business, and the good quality of said brandy, distinguished as it was by its trademarks, tradenames, labels, corks, capsules, and the shape, size and color of its bottles, the same has become widely known in the community and throughout the world as a useful and valuable cordial and acquired a high reputation as such, and has commanded and still commands an extensive sale throughout the United States and Europe, which is and has been a source of great profit to these complainants. That your orators' tradename and trademarks are of a value of two thousand dollars and upwards. That said brandy when bottled by complainants is known as such brandy to the public, buyers and consumers thereof by the said name of James Hennessy & Company's brandy, or Hennessy brandy, or Hennessy cognac, together with the complainants' own proper devices, tradenames, and trademarks aforesaid, and by its straw wrappers or casings accompanying and enclosing said bottles, and by the peculiar shape and color of the bottles themselves.

Fifth. Complainants state that notwithstanding the long and quiet use and enjoyment by the complainants of said tradename and trademark and to the form, device and descriptive matter of said labels, the defendants, well knowing the premises and with the preconceived intention to injure the complainants, and with the purpose to defraud them, and with the purpose to deprive these complainants of the benefits and profits resulting from the great reputation acquired for said brandy, and the consequent demand therefor, and with the intent to acquire for themselves the benefits and profits of said reputation, and with the intent to assist others to palm off on the public brandy not being exported, sold or bottled by complainants, as the goods of

the complainants, and in wilful disregard of complainants' rights in the premises, kept, offered for sale and sold, and advertised for sale, and now keep, offer for sale and sell in the city and county of San Francisco and state of California, and elsewhere in the United States of America, counterfeit labels in imitation of complainants' labels under the name of "Hennessy & Co.," using fac-similes of complainants' tradename, devices and labels, which with intent to deceive and defraud the public and the buyers and consumers thereof they have caused to be sold to dealers engaged in counterfeiting the bottled brandy of your orators; that defendants sold said labels for the purpose and with the intent that they should so be used, and that in fact they have been so used, in fraud of your orators' rights.

Sixth. That such imitation labels are calculated to deceive the purchasers and consumers of said brandy, and are calculated to cause the public and the buyers and consumers thereof to believe that the brandy kept and offered for sale and sold by defendants' customers is the brandy exported, bottled and sold by the complainants.

Seventh. That such imitation is calculated to deceive and mislead the purchasers and consumers of the complainants' brandy, and has actually deceived and misled and still does mislead many of them to buy the brandy or liquor sold by the defendants' customers in the belief that it is the brandy exported and bottled by the complainants, to the great loss, injury and damage of the complainants. That the article so put up and sold by the defendants' customers is of greatly inferior quality to that of the complainants, and deleterious to the health of the consumer, and the general esteem and reputation of the brandy exported by the complainants has been and is now being injured and damaged thereby.

Eighth. Forasmuch as your orators can have no adequate relief except in this court, and to the end, therefore, that the defendants may, if they can, show why your orators should not have the relief hereby prayed, and may make a full disclosure and discovery of all the matters aforesaid, and according to the best and utmost of their knowledge, remembrance, information and belief, full, true, direct and perfect answer make to the matters hereinbefore stated and charged, but not under oath, an answer under oath being expressly waived.

And that the defendants may be decreed to account for and pay over adequate damages arising from their aforesaid acts in violation of your orators' rights, your orators pray that your honors may grant a writ of injunction issuing out of and under the seal of this honorable court, perpetually enjoining and restraining the said defendants, their clerks, attorneys, agents and servants from keeping, offering for sale, or selling any brandy not being the brandy exported and bottled by your orators, put up in bottles of the general form, shape and color of complainants' bottles, and wrapped with labels of the form, device and in the manner complained of, or in any other form and device which shall be a colorable imitation of complainants' brandy, or from applying to any such brandy the name "Hennessy

Brandy," or from using upon or in connection with said brandy or any counterfeit of your orators' labels or cases the name "Hennessy," or any combination of such name or name of like sound, and that the defendants deliver up to your orators all bottles having thereon said false label, and also all such false labels in their possession or under their control, to the end and purpose that the same may be destroyed.

And that your honors upon the rendering of the decree above prayed may assess, or cause to be assessed, the damages your orators have sustained by reason of the premises.

May it please your honors to grant unto your orators not only a writ of injunction conformable to the prayer of this bill, but also a writ of subpoena of the United States of America, directed to the said J. H. and C. S., commanding them on a day certain to appear and answer unto this bill of complaint, and to abide and perform such order and decree in the premises as to the court shall seem proper and required by the principles of equity and good conscience.

J. L. H., of Counsel.

A. L. P. and J. L. H.,
Solicitors for Complainants.

UNITED STATES OF AMERICA,
Northern Judicial District of California, ss.

J. L. H., on behalf of the said complainants, Jacques Richard Maurice Hennessy, Jacques Francis Henry Hennessy, James Richard Charles Hennessy, Armand Castillon and Emmanuel Castaigne, and duly authorized to act for them herein, being on his oath sworn, deposeth and says that he has read the above bill of complaint, and that the matters therein set forth are true to his best knowledge, information and belief.

Subscribed and sworn to before me, this 19th day of July, 1898.

S. H.,
Clerk U. S. Cir. Ct., N. D. C.

ANSWER.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the Circuit Court of the United States in and for the Ninth Circuit
and District of California.

WILLIAM J. BENKERT, Complainant,	}	No. 3507.
<i>vs.</i>		
MORRIS ROSENTHAL and SAMUEL FEDER, Defendants.		

The answer of M. R. and S. F. to the bill of complaint of W. J. B., complainant.

These defendants, saving and reserving to themselves all right of exception to said bill of complaint on account of the many errors therein contained, for answer thereto or to so much and such parts thereof as they are advised by counsel it is necessary or important for them to make answer unto, answering, say:

That they have no knowledge or information other than from said bill of complaint as to the partnership or business of the complainant and Casper Benkert, or the continuance thereof, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the sale by Casper Benkert to complainant of his interest in said alleged business and the carrying or ownership and proprietorship thereof, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the business of the partnership of C. Benkert & Son and of complainant, or of the boots and shoes manufactured and sold by them or either of them, or of the quality, quantity and price of such boots and shoes, or the mark or other designation thereof or thereon, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the placing as a trademark upon said boots and shoes, and to indicate the ownership and origin thereof, the words "C. Benkert & Son," and to the knowing of said boots and shoes by the name of "C. Benkert & Son," and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the name of "C. Benkert & Son" being a trademark, or the ownership of said name, or the right to use and place the same upon boots or shoes, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

These defendants and each of them deny that they have for more than five years last past been partners in trade as set forth in said bill of complaint, except as follows: for the four years previous to the month of March, 1884, they, with one Bromberger, were partners in trade under the firm name of Rosenthal, Feder & Co., and in said month said Bromberger retired from the copartnership formed by them; since said month these defendants have been partners in trade as set forth in said bill of complaint.

These defendants and each of them deny that within five years or at any time or times whatsoever they or either of them had manufactured or sold, or are now manufacturing or selling, large or any quantities of boots and shoes or boots or shoes, or each or either, on any of which they have placed in plain or conspicuous letters, or at all, the name of "C. F. Benkert & Son," in imitation of the name of "C. Benkert & Son," as alleged in said bill of complaint, or at all.

Defendants and each of them deny that they or either of them have

stamped in sole-leather or buttons or any other part of said boots and shoes, or any boots or shoes whatsoever, in plain conspicuous letters or otherwise, the name or words "C. F. Benkert & Son, Phila."

Defendants deny that they have manufactured or are still manufacturing said boots and shoes or any boots or shoes marked with the name of "C. F. Benkert & Son" in San Francisco, Hawaiian Islands, other domestic or foreign markets or elsewhere, and admit and show to this court that they have sold in San Francisco and elsewhere a small quantity of boots and shoes marked "C. F. Benkert & Son," comprising not more than two hundred and fifty dozen pairs thereof; and further state and show that the boots and shoes so sold were of an entirely different class, style, nature and grade from the boots and shoes alleged in said bill of complaint to be manufactured by the complainant and as such were recognized by and sold to the customers and patrons of these defendants.

Defendants say they have no knowledge or information other than from said bill of complaint as to the relative quality, cost of manufacture and prices of sale of said boots and shoes and the boots and shoes made by the complainant, and cannot admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants and each of them deny that they have had manufactured for them as set forth in said bill of complaint large or any quantities of boots or shoes or any boots or shoes whatever on which was printed the name "C. F. Benkert & Son" or stamped "C. F. Benkert & Son, Phila.," as set forth in said bill of complaint, excepting not more than three hundred and twenty-one dozens thereof, and the defendants and each of them deny that they have sold or are still selling boots and shoes with said words printed or stamped thereon in San Francisco or elsewhere, excepting that they have heretofore sold not more than the two hundred and fifty dozens thereof aforesaid.

The defendants and each of them deny that they have placed or caused to be placed on said boots or shoes alleged to have been sold by them or upon any other boots or shoes whatsoever said words, to wit, "C. F. Benkert & Son," for the purpose of deceiving the public or purchasers generally, or any other person, or causing them or any of them to believe the said boots or shoes were manufactured by the complainant or at all. They deny that the public or purchasers generally or any of them have been deceived or have believed on account of said names being on said boots or shoes that the same were genuine or other boots or shoes manufactured by the complainant, and that being deceived as alleged in said bill of complaint, or being deceived at all, have purchased or are now purchasing, or these defendants have sold or are now selling, said boots or shoes as or for genuine or other boots or shoes manufactured by the complainant. They deny that by any of the acts and doings set forth in said bill of complaint they or either of them have unlawfully or otherwise greatly or at all injured or depreciated the complainants' trade in fine or other boots

or shoes, or the good or other reputation or standing of said boots or shoes, alleged in said bill of complaint to have been had by them.

Defendants and each of them deny that, unless restrained by injunction, they by using said name on the boots and shoes sold by them will infringe on the alleged name and trademark of the complainant and deny that they have already at any time been doing the same.

The defendants state and show that they have sold not more than two hundred and fifty dozens of boots and shoes marked "C. F. Benkert & Son," and have realized therefrom a profit of about and not more than five hundred (500) dollars.

The defendants and each of them deny that by reason of the said alleged infringement, or of any other act or doing of these defendants or either of them, the complainant has suffered loss or damage to a very large or other amount or any loss or damage whatsoever.

Without this that there is any other matter, cause or thing in the said bill of complaint contained material or necessary for these defendants or either of them to make answer unto and not herein and hereby well and sufficiently answered, confessed, traversed and avoided is true to the knowledge or belief of these defendants; all of which matters and things these defendants are ready and willing to aver, maintain and prove as this honorable court shall direct, and humbly pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

I. S. B.,
Of Counsel for Defendants.

M., B. & M.,
Solicitors for Defendants.

ANSWER.

(Brown Chemical Co. v. Meyer, 139 U. S. 540.)

THE JOINT ANSWER OF CHRISTIAN F. G. MEYER, et al. to the
Bill of Complaint of the BROWN CHEMICAL COMPANY.

These defendants now and at all times hereafter saving and reserving unto themselves all benefit and advantage of exception which can or may be had or taken to the many errors, uncertainties and other imperfections in the said bill contained for answer thereto or to so much and parts thereof as these defendants are advised it is material or necessary for them to make answer unto, say, etc.

These defendants have no information sufficient to form a belief as to whether or not said complainant has for a period of many years last past been engaged in the preparation and sale of a certain medicine at the city of Baltimore and therefore call for strict proof of same although defendants are informed and believe that complainant has been engaged in the preparation and sale of a medicine, but these defendants on information and belief deny that said medicine has acquired or long enjoyed a very high or any particular reputation

as a remedy for the prevention or cure of many or any diseases, but whether it is sold in immense or any considerable quantities to complainant's great profit these defendants have no information sufficient to form a belief although defendants believe that complainant has sold enough of said medicine to make some profit.

These defendants further answering said bill of complaint admit, on information and belief, that said complainant as alleged in said bill has adopted, applied and used, and is using a certain label with the words and representations as described and set forth in said bill, but as to whether or not as set forth in said bill said label has been used since about the year 1879, or as to whether or not said complainant devised or originated said label, these defendants have no information sufficient to form a belief, and therefore calls for strict proof of said allegations.

These defendants further answering said bill of complaint admit on information and belief that the designation "Browns Iron Bitters" has come to be associated with complainant's medicine or product, but whether or not to the exclusion of all others, defendants cannot say as matter of law, but defendants say as matter of fact, no other Brown Iron Bitters are known to these defendants, and that those desiring complainant's medicine are in the habit of using the designation "Browns Iron Bitters" with the understanding that it means complainant's medicine alone since there are no other Browns Iron Bitters made up or sold to the trade as defendants are informed and believe; and that whenever the said designation, Browns Iron Bitters are used, it means a medicine prepared and put up by complainant at the city of Baltimore, in the State of Maryland.

These defendants further answering said bill of complaint say they have no information sufficient to form a belief as to whether or not said complainant has spent large sums of money in advertising amounting to hundreds of thousands annually, although defendants believe complainant has advertised extensively. Defendants admit that complainant's output has been of great magnitude, amounting to many thousands of bottles annually, but as to whether or not said bottles have all borne a label consisting in part of the words "Browns Iron Bitters," these defendants do not know, but believe and suppose it is so.

These defendants admit on information and belief that the said designation "Browns Iron Bitters" has come to be identified with said complainant's product, but not to the exclusion of all others as matter of legal right, although as before stated, these defendants know of no other "Browns Iron Bitters" in the trade. Defendants do not know whether or not said designation is known and is now used in all parts of the United States by consumers generally when they desire to obtain the said preparation of complainant, although these defendants know of no other preparation of the same designation.

These defendants further answering said bill of complaint say they have no information sufficient to form a belief as to whether or not

said designation has ever been employed in connection with any other preparation or remedy, and therefore calls for strict proof of the same; but these defendants deny that the said designation is to all intents and purposes, or to any intent or purpose complainant's tradename or trademark, or that said complainant now has or has ever had the exclusive right to the use of said designation as a tradename or trademark for a medicinal preparation or otherwise, or that no one except complainant has had, or now has any right to use said designation as a tradename or trademark for a medicinal preparation or otherwise; and these defendants further answering deny that they have done anything which is fraudulent or which will be restrained by this Honorable Court.

These defendants further answering said bill of complaint admit that they were engaged in business as wholesale druggists at the city of St. Louis, in the State of Missouri, but deny that they have been long or at all cognizant of the high reputation or any particular reputation of complainant's medicine, but admit that for some time they have known of the said designation "Browns Iron Bitters."

These defendants further answering said bill of complaint admit that prior to the commencement of this suit and as well since they had and have sold medicine put up in bottles to which have been attached and applied labels containing the words "Browns Iron Tonic," but these defendants explicitly deny that such sales or any of them were or have been made in order to injure complainant by diverting any profits of complainant in the sale of its medicine or otherwise, or that such sales were fraudulently made, or that the bottles or the labels thereon containing the words "Browns Iron Tonic," were intended by these defendants or any of them to indicate that the medicine contained in said bottles was prepared and put up by complainant; and these defendants deny that they ever have fraudulently offered or caused to be offered or sold or that they still fraudulently offer or cause to be offered or sold in large or any quantities the said medicine so as aforesaid labelled "Browns Iron Tonic," although these defendants admit that they have, as of right they might, offered and sold and still offer for sale said "Browns Iron Tonic"; as they have bought and sold complainant's said medicine, but without loss or injury to said complainant.

These defendants further answering said bill of complaint, deny that large or small, or any quantities or quantity of said Browns Iron Tonic have been, through any act of these defendants, or any of them, or through any use by them of said designation of "Browns Iron Tonic" at any time sold as or for complainant's "Browns Iron Bitters" or mistaken therefor in any instance, or that said Complainant has lost anything or been injured thereby.

These defendants further answering said bill of complaint, deny that it was their purpose to offer or sell said "Browns Iron Tonic" upon any reputation established by complainant or as or for complainant's said alleged celebrated "Browns Iron Bitters"; and defend-

ants deny that any of their acts in the premises have been or are contrary to equity or good conscience, or that they ought to be enjoined from the further sale of said "Browns Iron Tonic."

These defendants further answering said bill of complaint state that while they claim and allege that the words "Browns Iron Bitters" are not the subject of trademark or tradename, and that defendants or anybody else might legally use the same words especially if as in this case, the entire designation is not used but is changed so as to exclude the idea of any misleading or fraudulent purpose; yet these defendants have as good right as complainant possibly could have to the use of the entire designation "Browns Iron Bitters" and as ground of this claim and as further answer to said bill of complaint, these defendants aver on information and belief, and charge the truth to be that in or near the summer of 1881, one E. L. B. in connection with one C. J. L. commenced putting up and selling the said preparation "Browns Iron Tonic" at Little Rock, Arkansas, as a wholly distinct preparation from "Browns Iron Bitters", and without any intention or purpose to imitate complainant's said preparation, which at that time had not been advertised or sold to any great extent, as these defendants on information and belief aver. Subsequently to this date, as these defendants on information and belief, aver, said B. sold out his interest in said preparation to said C. J. L., who has since that time been putting up, at Little Rock, Arkansas, said medicine, and offering it to the public, and these defendants have bought some of it and sold some of it, viz: Four gross bottles before March 24th, 1886, and since that date about seven gross bottles.

These defendants further aver that the said preparation "Browns Iron Tonic" as offered and sold by him, as well as by said B. & L. and since by said L., has been put up in cartons and bottles wholly differing in size, color and appearance from said complainant's bottles and with labels adapted and applied to the bottles wholly differing in size, color, appearance and details from complainant's labels, which are enclosed in wrappers wholly different from said cartons of "Browns Iron Tonic", so that the public could not be misled or the complainant injured, which has always been very far from these defendants' purpose or object, and as well very far from said B. and L.'s purpose or object as these defendants believe; these defendants exhibit and file with this answer a bottle of "Browns Iron Tonic" with its carton and label marked exhibit "C" and as well a label, wrapper and bottle of complainant's preparation, marked Exhibit "D", and pray that the Court will consider them as part of this answer.

These defendants further answering said bill of complaint, on information and belief, aver and charge the truth to be that early in 1882, the said complainant entered into a correspondence with said L. & B. with respect to said "Browns Iron Tonic", and said L. & B. sent complainant a sample bottle of their Tonic, wrapper and label. Whereupon as a result of said correspondence and examination, said complainant in a letter to said L. & B. expressed themselves as

satisfied that said "Browns Iron Tonic" did not conflict with said "Browns Iron Bitters", which letter was and is in words and figures as follows:—

Baltimore, August 28th, 1882.

Mess. C. J. Lincoln & Co.,

Little Rock, Ark.

Gentlemen:—Inclosing your invoice thank you for your kind and satisfactory letter. We wish the Browns Iron Tonic a success as upon examination we cannot see where it can conflict with us except in the multiplicity of the Brown family.

Your fr'ds,

Brown Chemical Co.

Said complainant has, as these defendants are informed and believe, ever since the date of said letter, with full knowledge of all the facts and after examination with respect to same, made no complaint of or objections to the putting up and sale of said "Browns Iron Tonic" until just before this suit was brought, and so by its said letter and its long silence and acquiescence in the manufacture and sale of said "Browns Iron Tonic" said complainant ought not in equity and good conscience, if for no other reason, to be granted in a court of equity any relief in the premises.

These defendants further answering said bill of complaint, deny that the complainant has suffered by the acts of these defendants, damage to the extent of Ten Thousand Dollars, or any other sum, or that said complainant has been done any wrong by these defendants or is entitled to any relief in the premises.

And these defendants deny all and all manner of unlawful combination and confederacy, wherewith they are by the said bill charged, without this, that any other matter, cause or thing in the complainant's said bill of complaint contained, material or necessary for these defendants to make answer unto, and not herein and hereby well and sufficiently answered, confessed, traversed and avoided or denied, is true, to the knowledge or belief of these defendants; all which matter and things these defendants are ready and willing to aver, maintain and prove, as this Honorable Court shall direct; and pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

B. A. & McK.,

Solicitors for Defendants.

APPENDIX K.

FORMS OF INJUNCTION.

INTERLOCUTORY DECREE.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the United States Circuit Court, Northern District of
California, Ninth Judicial Circuit.

WILLIAM J. BENKERT, Complainant,	} No. 3507.
vs.	
SAMUEL FEDER and AURELIA ROSENTHAL,	
Executrix of the Last Will and Testa-	
ment of MORRIS ROSENTHAL, Deceased,	
Defendants.	

At a stated term, to wit, the February term, 1888, of the circuit court of the United States of America of the ninth judicial circuit, in and for the northern district of California, held at the court room thereof, in the city and county of San Francisco, on Monday, the 1st day of June, A. D., 1888.

Present: The Honorable Lorenzo Sawyer, circuit judge.

This cause having come on to be heard upon the bill of complaint herein, the answer of the defendants, and replication of the complainant, the bill of revivor, the stipulation of the parties in regard thereto, and the proofs, documentary and written, taken and filed in said cause, and having been argued by counsel for the respective parties and submitted to the court for consideration and decision:

Now, therefore, on consideration thereof, it is ordered, adjudged and decreed, and the court doth hereby order, adjudge and decree, as follows, to wit:

That the name of "C. Benkert & Son" has been a tradename and also a trademark upon boots and shoes for upwards of twenty-five years last past, and as such tradename and trademark is good and valid in law.

That the complainant, William J. Benkert, is, and ever since the year 1876 has been, the exclusive owner of said tradename and trademark, and during all said time, at the city of Philadelphia, in the state of Pennsylvania, has carried on the business, under the said tradename, of manufacturing and selling boots and shoes, and during all said time has stamped and printed, and used upon all the said boots

and shoes so made and sold by him, the said words "C. Benkert & Son" as a trademark.

That the original defendants herein, Samuel Feder and Morris Rosenthal, have infringed upon the said tradename and trademark and upon the exclusive rights of the complainant under the same—that is to say, by manufacturing and selling within the ten years last past, and prior to the commencement of this suit, large quantities of boots and shoes upon each of which they have placed in plain, conspicuous, printed letters the name "C. F. Benkert & Son" in imitation of the name "C. Benkert & Son" as charged in the bill of complaint.

And it is further ordered, adjudged and decreed, that the complainant do have and recover of and from the defendants, Samuel Feder and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, the profits, gains and advantages which the said defendants or either of them have received or made, or which have arisen or accrued to them, or either of them, from the infringement of the said tradename and said trademark of "C. Benkert & Son" by the making, using and selling, or the making, using or selling of said boots and shoes having placed thereon the name "C. F. Benkert & Son" or any other name in imitation of complainant's tradename and trademark of "C. Benkert & Son."

And it is further ordered, adjudged and decreed, that the said complainant do recover of the defendants his costs and charges and disbursements in this suit to be taxed.

And it is further ordered, adjudged and decreed, that it be referred to S. C. Houghton, Esq., the standing master in chancery of this court, residing in the city and county of San Francisco, northern district, and state of California, to ascertain and take, and state, and report to this court, an account of the number of pairs of boots and shoes manufactured and sold or manufactured or sold by the original defendants, Samuel Feder and Morris Rosenthal, or either of them, and also the gains, profits and advantages which the said original defendants or either of them, or the estate of said Morris Rosenthal, have received, or made, or which have arisen or accrued to them or either of them, or it, from infringing the said exclusive rights of the said complainant by the manufacturing and selling, or manufacturing or selling, of boots and shoes having stamped and placed upon them the infringing trademark in imitation of the trademark of "C. Benkert & Son."

And it is further ordered, adjudged and decreed, that the complainant on such accounting have the right to cause an examination of the defendants, Samuel Feder and Aurelia Rosenthal, and each of them, and their and each of their agents, servants, or workmen or other witnesses as may be necessary to take said accounting, and also the production of the books, vouchers and documents of which said defendants, Samuel Feder or Aurelia Rosenthal, and their and each of their attorneys, servants, agents and workmen may be possessed, and cause

them to attend for such purposes before said master from time to time as such master shall direct.

And it is further ordered, adjudged and decreed, that a perpetual injunction be issued in this case, against the said defendants, Samuel Feder and Aurelia Rosenthal, restraining and perpetually enjoining them and each of them, and their and each of their servants, agents, clerks and workmen, and all persons claiming or holding under or through them, from manufacturing or using or selling, or in any way disposing of, boots and shoes or boots or shoes having stamped, or printed, or in any way marked thereon the name "C. F. Benkert & Son," or any other name in imitation or simulation of the said trademark "C. Benkert & Son," pursuant to the prayer of the said bill of complaint.

LORENZO SAWYER,
United States Circuit Judge, Ninth
Judicial Circuit.

WRIT OF INJUNCTION.

In the Circuit Court of the United States for the Ninth Judicial Circuit in and for the Northern District of California.

BOORD & SON, Complainant, <i>vs.</i> E. G. LYONS COMPANY, Respondent.	}	In Equity.
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The President of the United States. To E. G. Lyons Company, its clerks, agents, servants and employees, Greeting:

Whereas, It has been represented to us in the circuit court of the United States for the northern district of California that Boord & Son, a corporation, of London, England, have a valid trademark in a device consisting of a cat standing upon a barrel, as applied to bottled gin, and that you, the said E. G. Lyons Company, have infringed said right by dealing in bottled gin bearing an imitation of said trademark:

Now, therefore, you, the said E. G. Lyons Company, your clerks, agents, servants and employees, are strictly commanded and enjoined under the pains and penalties which may fall upon you, and each of you, in case of disobedience, that you forthwith and until the further order, judgment and decree of this court, desist from dealing in any gin bottled in imitation of complainant's gin and bearing the device of a cat standing upon a barrel.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, this 14th day of October, in the year of our [SEAL] Lord one thousand eight hundred and ninety-eight, and of our Independence the 123d.

SOUTHARD HOFFMAN, Clerk.

FINAL DECREE.

(Royal Baking Powder Co. v. Royal Chemical Co.,
Price & Steuart, 1.)

This cause having been tried at a special term of this court, before the Hon. Hooper C. Van Vorst, one of the justices thereof, without a jury, and the proofs and allegations of the parties having been heard, the said court gave its decision in writing in favor of the plaintiffs, and against the defendants, with costs; which decision has been filed with the clerk of this court:

Now, in pursuance thereof, it is hereby adjudged that the plaintiffs are entitled to judgment on all the issues, and judgment is hereby rendered in favor of the plaintiffs, and against the defendants thereon, and it is hereby also adjudged that the plaintiffs are entitled to the exclusive use of the term "Royal," as their trademark, on labels attached to baking powder manufactured by them, and in connection with the words "baking powder." And it is further adjudged, that the use by the defendants of the word "Royal" on labels affixed to baking powder, made by the defendants, or printed or written on boxes, labels or otherwise howsoever, in connection with baking powder made by them, was in violation of the plaintiff's rights.

And it is further adjudged, that the defendants, their agents, clerks, workmen, servants and attorneys, perpetually refrain, and they are hereby perpetually enjoined and restrained, from using the term or designation "Royal" on, or around, or in connection with, any cans, boxes or other packages, of any nature or kind whatever, containing baking powder, or in any sign, invoice, billhead, card, circular, advertisement, in connection with baking powder, and from using the name "Royal Baking Powder," and from selling and disposing of any baking powder with the word "Royal" attached thereto, except on such baking powder as is obtained from the plaintiffs.

And it is further adjudged, that the plaintiffs recover of the defendants their costs and disbursements in this action.

INJUNCTION.

(Gillis v. Hall, 2 Brewst. 342.)

Defendants enjoined "from making and selling any preparations as and for the preparations specified in plaintiff's label, and from using the name of Hall, or R. P. Hall, or Reuben P. Hall, either singly or in connection with others, upon any such preparation; or from making or using any trademark, label or wrapper in imitation of those now in use by plaintiff."

(Colton v. Thomas, 2 Brewst. 308.)

Injunction against defendant "restraining the further use of the cards and signs complained against in the bill; and also to restrain the employment by him of any device by which the patients and patrons of the plaintiff, without the exercise of excessive care, will be induced to suppose that the defendant's place of business is the place of business of the Colton Dental Association."

(Gillott v. Esterbrook, 47 Barb. 455.)

"Ordered and adjudged that the said defendants, R. E., R. E., Jr., J. C., Jr., and J. B., and each of them, their agents and servants, do absolutely and perpetually desist and refrain from infringing or using the said trademark of the plaintiff, and from making or selling pens with said numerals '303' impressed on the boxes or packages containing steel pens."

(Jurgensen v. Alexander, 24 How. Pr. 269; Cox, 298.)

Ordered: (1) "That the defendant, his agents, clerks, servants and all others employed under or in connection with him be perpetually enjoined and restrained from disposing of, selling, or causing to be disposed of or sold, any watches bearing the false, simulated and spurious stamp or mark, 'Jules Jurgensen, Copenhagen.'"

2. "That the defendant do produce before Nathaniel Jarvis, Esq., appointed herein referee for such purpose, the said watches, which at the time of the commencement of this suit were in defendant's possession, and had upon them the said false, simulated and spurious trademark, to be erased or obliterated therefrom, by or under the direction of the said referee, at the cost and expense of the said defendant."

(Coffeen v. Brunton, 4 McLean, 516; Cox, 82.)

"To enjoin the defendant from using the label or directions accompanying the liniment he sells as aforesaid, or other labels or directions, or any advertisements or handbills respecting the same words which are used by the complainant on his label or directions, and which tend to produce an impression on the purchaser and the public that the liniment sold by the defendant contains the same ingredients as the 'Chinese Liniment,' and is, in effect, the same medicine."

(N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869.)

Defendant enjoined from putting up and selling or offering for sale "The particular form of packages which has been referred to in the bill and put in evidence as 'defendant's second package,' or any other form of package which shall, by reason of the collocation of size, shape, colors, lettering, spacing and ornamentation, present a general appearance as closely resembling the 'complainant's package,' referred to in the bill and marked in evidence, as does the said 'defendant's second

package.' This injunction shall not be construed as restraining defendant from selling packages of the size, weight, and shape of complainant's package, nor from using the designation 'Buffalo soap powder' nor from making a powder having the appearance of complainant's 'Gold Dust,' nor from using paper of a yellow color as wrappers for its packages, provided such packages are so differentiated in general appearance from said 'complainant's package' that they are not calculated to deceive the ordinary purchaser."

MANDATE OF CIRCUIT COURT OF APPEALS, AFFIRMING
DECREE OF INJUNCTION.

(Feder v. Benkert, 76 Fed. Rep. 613.)

UNITED STATES OF AMERICA—SS.

THE PRESIDENT OF THE UNITED STATES OF AMERICA, To the Honorable the Judges of the Circuit Court of the United States for the Northern District of California, Greeting:

WHEREAS, lately in the circuit court of the United States for the northern district of California, before you, or some of you, in a cause between William J. Benkert, complainant, and Samuel Feder, and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, respondents, a decree was duly entered in favor of the said complainant, which said decree is of record in the office of the clerk of the said circuit court, to which record reference is hereby made and the same is hereby expressly made a part hereof, and as by the inspection of the transcript of the record of the said circuit court, which was brought into the United States circuit court of appeals for the ninth circuit, by virtue of an appeal agreeably to the act of congress, in such cases made and provided, fully and at large appears.

AND WHEREAS, in the year of our Lord one thousand eight hundred and ninety-five, the said cause came to be heard before the said circuit court of appeals, on the said transcript of record, and was argued by counsel:

On consideration whereof, it is now here ordered, adjudged and decreed, that the decree of the said circuit court in this cause be, and the same is hereby, affirmed, with costs.

You, therefore, are hereby commanded that such further proceedings be had in said cause as according to right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, the 16th day of November, in the year of our Lord one thousand eight hundred and ninety-five.

F D. MONCKTON,
Clerk of the United States Circuit Court
of Appeals for the Ninth Circuit.

APPENDIX L.

CLASSIFICATION OF TRADEMARKS.

The following classification of registered trademarks has been published in connection with the rules of the Patent Office. It is understood to be a classification of pre-existing registrations rather than as a guide to the classification to be observed in filing application:

Agricultural Machines and Imple- ments.	Games and Toys.
Baking Powder and Yeast.	Glassware.
Beltings, Hose, and Packings.	Gloves.
Beverages.	Headwear.
Blackings and Leather Dressings.	Household Articles.
Boots, Shoes, and Lasts.	Inks.
Brooms and Brushes.	Jewelry and Plated Ware.
Buttons.	Lamps, Lanterns, etc.
Canned Goods.	Lard and Tallow.
Carpets, etc.	Laundry Machines and Articles.
Cement, Plaster, and Bricks.	Leather and Saddlery.
Cleaning and Polishing Prepara- tions.	Locks and Hardware.
Coffee and Tea.	Lumber and Manufactures.
Conductors and Insulators.	Machines and Devices.
Confectionery.	Malt Liquors.
Corsets.	Matches.
Cured Meats.	Medical Compounds.
Dairy Machines and Products.	Metals and Manufactures.
Dentistry.	Miscellaneous.
Drugs and Chemicals.	Musical Instruments.
Dry Goods.	Needles and Pins.
Electrical Apparatus and Sup- plies.	Oils and Lubricants.
Fancy Goods.	Optics and Measuring Instru- ments.
Fertilizers.	Paints and Painters' Supplies.
Firearms, Ammunition, and Ex- plosives.	Paper and Envelopes.
Fire Extinguishers.	Poisons for Animals.
Flour.	Publications.
Foods and Relishes.	Receptacles.
Fuel.	Rope, Cord and Twine.
Furniture.	Rubber Goods.
	Seeds, Plants and Trees.
	Sewing Machines and Attach- ments.

Sewing Silk, Cotton, and Thread.	Surgical Instruments and Appli-
Shirts, Collars, and Cuffs.	ances.
Soap.	Tailoring and Clothing.
Spices, Mustard, and Salt.	Time-keeping Instruments.
Spirituous Liquors.	Tobacco and Tobacco Products.
Starch, Cornstarch, and Products.	Toilet Articles and Preparations.
Stationery Miscellany.	Tools and Cutting Instruments.
Steam and Plumbing Supplies.	Umbrellas, Parasols, and Canes.
Stoves and Furnaces.	Underwear and Furnishings.
Sugar, Syrup, and Molasses.	Vehicles.
	Wines.

APPENDIX M.

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APPENDIX N.

INTERNATIONAL ARRANGEMENTS.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

(Signed at Paris, March 20, 1883. Ratifications exchanged at Paris, June 6, 1884.)

(Official Translation.)

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure by mutual agreement complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say: [Here follow the appointments of the plenipotentiaries.]

Who having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:

ARTICLE I.

The governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia and Switzerland constitute themselves into a union for the protection of industrial property.

ARTICLE II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trademarks and tradenames, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

ARTICLE III.

Subjects or citizens of states not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the states of the union, shall be assimilated to the subjects or citizens of the contracting states.

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trademark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval; either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trademark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trademarks. A month longer is allowed for countries beyond sea.

ARTICLE V.

(Relates only to patents.)

ARTICLE VI.

Every trademark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union.¹

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.

The nature of the goods on which the trademark is to be used can, in no case, be an obstacle to the registration of the trademark.

ARTICLE VIII.

A tradename shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trademark.

¹ No effect can be given to this or any other article of the convention by the courts of Great Britain, except so far as it is embodied in section 103 of the Patents Act, 1883. Re California Flg Syrup Co., 40 Ch. D. 620. And to be registered in Great Britain, a foreign mark must contain one of the essential particulars defined in section 64 of said act. Re Carter Medicine Co., L. R. (1892), 3 Ch. D. 472.

ARTICLE IX.

All goods illegally bearing a trademark or tradename may be seized on importation into those states of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a tradename of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trademarks, for articles exhibited at official or officially recognized international exhibitions.

ARTICLE XII.

Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trademarks.

ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the contracting states, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the union.

ARTICLE XIV.

The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting states by delegates of the said states. The next meeting shall take place in 1885 at Rome.

ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

ARTICLE XVI.

States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present convention.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.

The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing state, the convention remaining in operation as regards the other contracting parties.

ARTICLE XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Dated at Paris the 20th March, 1883.

(Signed by the Plenipotentiaries.)

FINAL PROTOCOL.

(Official Translation.)

On proceeding to the signature of the convention concluded this day between the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. (Relates only to patents.)

3. The last paragraph of article II does not affect the legislation of each of the contracting states, as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of article VI is to be understood as meaning that no trademark shall be excluded from protection in any state of the union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of article VI.

5. The organization of the special department for industrial property mentioned in article XII shall comprise, so far as possible, the publication in each state of a periodical official paper.

6. [After providing for the common expenses of the international office, continues:]

The Swiss government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the states of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations, or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the service of members of the union, in order to supply them with any special information they may need on questions relating to the internal system of industrial property.

The administration of the country in which the next conference is

to be held will make preparation for the transactions of the conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present protocol.

(Signed by the Plenipotentiaries.)

ACCESSION OF GREAT BRITAIN AND IRELAND TO THE CONVENTION.

The undersigned, ambassador extraordinary and plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by article XVI of that convention to states not parties to the original convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said international convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to co-operate on her part in the execution of the stipulations contained in the convention and protocol aforesaid.

The undersigned makes this declaration on the part of Her Britannic Majesty, with the express understanding that power is reserved to Her Britannic Majesty to accede to the convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's government.

In witness whereof the undersigned, duly authorized, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(Signed) LYONS.

[L. S.]

DECLARATION OF ACCEPTANCE OF ACCESSION OF
GREAT BRITAIN.*(Official Translation.)*

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the protection of industrial property, concluded at Paris, March 20th, 1883, together with a protocol dated the same day, by the declaration of accession delivered by her ambassador extraordinary and plenipotentiary to the government of the French Republic; the text of which declaration is word for word as follows:

[Here is inserted the text of the declaration of accession in English.]

The President of the French Republic has authorized the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties to assist in the accomplishments of the obligations stipulated in the convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

It witness whereof the undersigned, duly authorized, has drawn up the present declaration of acceptance and has affixed thereto his seal.
Done at Paris, the 2d April, 1884.

(Signed) JULES FERRY.

[L. S.]

This convention is not self-executing, but requires legislation to make it effective in the United States. Opinion of Miller, Attorney-General, 47 Off. Gaz. 397; Ex parte Zwack & Co., 73 Off. Gaz. 1855.

For a list of the existing treaties and conventions between the United States and foreign nations see *post*, p. 807.

APPENDIX O.

Section 4 of the Act of January 5, 1905, incorporating the American National Red Cross, is as follows:

* * * * *

Sec. 4. That from and after the passage of this Act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

* * * * *

Approved, January 5, 1905.

APPENDIX P.

The trademark laws of several of the foreign nations have been published from time to time in the Official Gazette of the Patent Office. The references are to the volume and page of that publication.

COUNTRY.	VOLUME.	PAGE.	DATE.
Argentine Republic	42	383	Jan. 24, 1888
Austria-Hungary	52	1539	Sept. 2, 1890
Do	59	1611	June 14, 1892
Bulgaria	65	137	Oct. 3, 1893
Brazil	45	235	Oct. 9, 1888
China	112	2095	Oct. 25, 1904
Cuba	100	1114	July 29, 1902
Do	108	800	Jan. 19, 1904
Denmark	54	1419	Mar. 10, 1891
Ecuador	93	361	Oct. 9, 1900
England	25	90	Oct. 2, 1883
Do	46	1395	Mar. 12, 1889
Germany	31	1447	June 23, 1885
Do	71	145	Apr. 2, 1895
Greece	69	126	Oct. 2, 1894
Guatemala	93	360	Oct. 9, 1900
Italy	24	102	July 3, 1883
Japan	48	1402	Sept. 3, 1889
Do	70	1503	Mar. 12, 1895
Do	78	1744	Mar. 16, 1897
Do	83	598	Apr. 26, 1898
Do	88	1899	Sept. 5, 1899
Mexico	51	809	May 6, 1890
Netherlands	23	1334	Apr. 3, 1883
Do	66	174	Jan. 2, 1894
Do	66	321	Jan. 16, 1894
Panama	115	1852	Apr. 18, 1905
Portugal	70	279	Jan. 8, 1895
Roumania	55	1653	June 23, 1891
Servia	75	1035	May 12, 1896
Switzerland	23	2237	June 5, 1883
Transvaal (British)	101	3110	Dec. 30, 1902
Victoria	33	501	Oct. 27, 1885

APPENDIX Q.

The United States has entered into conventions with the several governments named below for the reciprocal registration of trademarks of citizens of, or persons domiciled in the respective countries.

COUNTRY.	DATE PROCLAIMED.	REPORTED.
Austria-Hungary	June 1, 1872.	17 Stat. at L. 917, 2 Off. Gaz. 418.
Belgium (now obsolete)	July 30, 1869.	16 Stat. at L. 765.
Belgium	July 9, 1884.	29 Off. Gaz. 452.
Brazil	June 17, 1889.	21 Stat. at L. 659.
Denmark	Oct. 12, 1892.	61 Off. Gaz. 571.
France	July 6, 1869.	16 Stat. at L. 771, 2 Off. Gaz. 416.
Germany	June 1, 1872.	17 Stat. at L. 921, 2 Off. Gaz. 418.
Great Britain	July 17, 1878.	14 Off. Gaz. 233.
Italy	March 19, 1884.	27 Off. Gaz. 304.
Japan	March 9, 1897.	78 Off. Gaz. 1744.
Luxemburg	March 15, 1905.	115 Off. Gaz. 1332.
Netherlands	Feb. 16, 1883.	23 Off. Gaz. 1334.
Russia	Oct. 15, 1868.	16 Stat. at L. 725, 2 Off. Gaz. 416.
Russia	Nov. 28, 1874.	Revision Committee Report, p. 336.
Servia	Dec. 27, 1882.	22 Stat. at L. 966, 28 Off. Gaz. 1191.
Spain	April 19, 1883.	25 Off. Gaz. 98.
Switzerland	May 16, 1883.	23 Off. Gaz. 2237.



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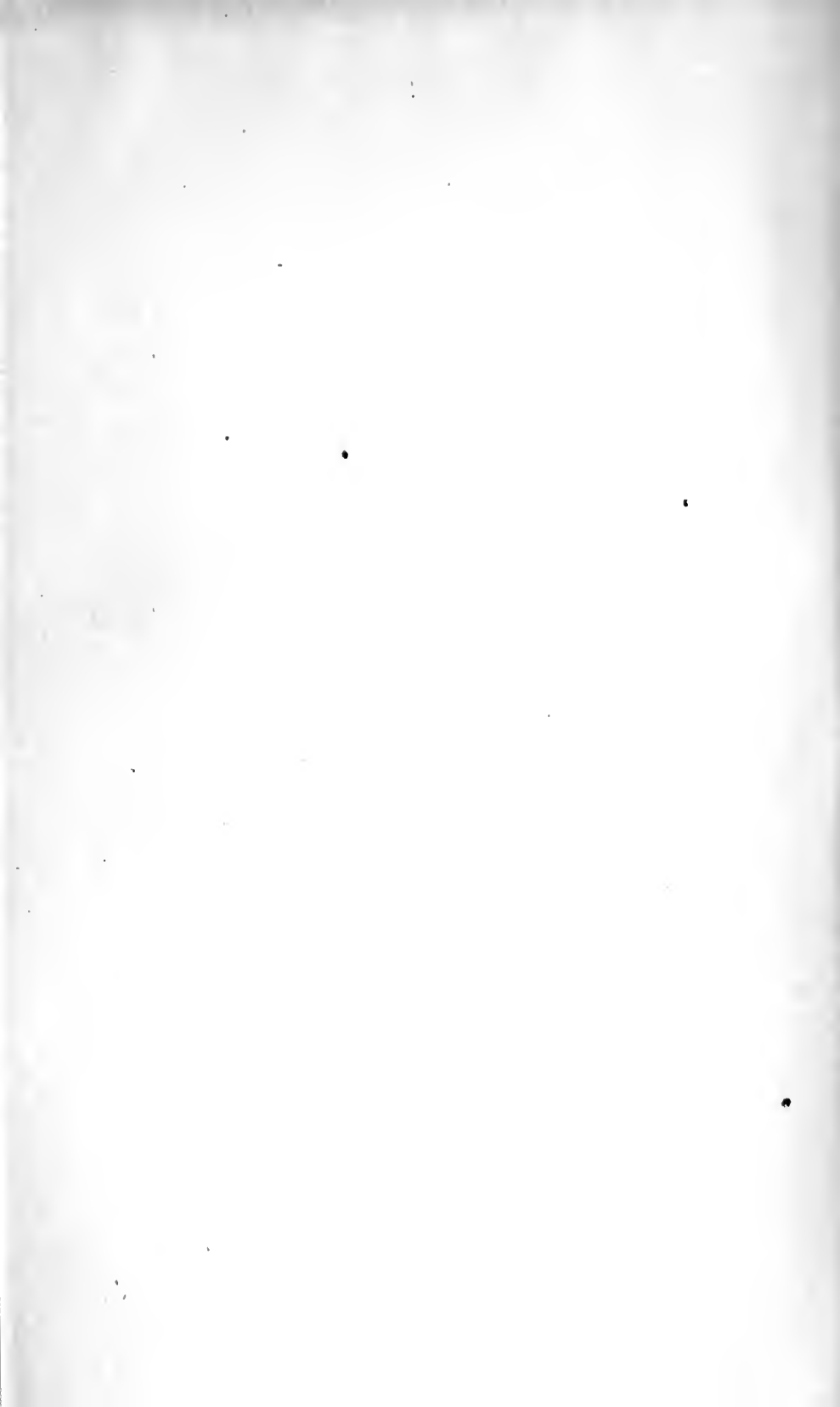
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